89-114

No. _____

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1989

LEONARD M. FREEMAN, M.D.,

Petitioner,

—v.—

HEIDI WEISSMANN, M.D.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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QUESTIONS PRESENTED

1. Whether allowing a junior member of an established and eminent team of medical researchers to convert a continually evolving teaching syllabus from an admitted joint work to an individually owned derivative work, merely by the addition of material (some of which itself was jointly authored), would have a chilling effect on medical or other scientific collaborative research to the serious detriment of the scientific community and the public?

2. Under the circumstances set forth above, under the Copyright Act
   (a) Can the unilateral intent of one joint author to convert a joint work to a derivative work ignore the intent of the other would-be joint author, whose authorship appears substantially in the work in question, in determining whether the work is joint?

   (b) Can the existence of an "intent" that a revised version of an existing joint work not be a joint work, which is not communicated to the other author, suffice to render the revised work derivative rather than joint?

3. Whether the Court of Appeals' rejection of Fair Use, predicated on erroneous findings such as lack of good faith and no joint work, completely eviscerates the well-established principles of Fair Use to the extent of stifling the very creativity which that law is designed to foster?

4. Whether a sharply divided Court of Appeals' direct assault on the "clearly erroneous" rule, totally ignoring the bench trial Judge's comprehensive findings of fact, *inter alia*, with respect to the credibility and intent of the parties, the nature of the collaborative efforts of the parties, the lack of new material substantial enough to create a derivative work and to the analysis of Fair Use factors, has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a course by a lower court, as to call for an exercise of this Court's power of supervision?

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—v.—

HEIDI WEISSMANN, M.D.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

The Petitioner, Leonard M. Freeman, M.D., respectfully prays that a Writ of Certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Second Circuit, entered in the above-entitled proceeding on February 23, 1989, as well as the Order of the United States Court of Appeals for the Second Circuit denying a Petition for Rehearing, filed on April 14, 1989.

OPINIONS BELOW

The opinion of the Court of Appeals for the Second Circuit is reported at 868 F.2d 1313 (2d Cir. 1989) and is reprinted in Appendix A hereto, pp. A 1-33, *infra*.

The opinion of the United States District Court for the Southern District of New York (Pollack, D.J.) is reported at

684 F.Supp. 1248, and is reprinted in Appendix B hereto, pp. B 1-27, *infra*.

The Order of the Court of Appeals for the Second Circuit denying the Petition for Rehearing has not been reported. It is reprinted in Appendix C hereto, p. C 1, *infra*.

JURISDICTION

Invoking federal jurisdiction under 28 U.S.C. § 1338(a) and 17 U.S.C. § 501(b), the respondent brought this suit in the Southern District of New York. On May 3, 1988, the Southern District, after a bench trial, dismissed the complaint on the merits. *See*, p. B 26, *infra*.

On respondent's appeal, the Second Circuit reversed the judgment of the District Court and remanded the case with directions that judgment be entered in favor of respondent. *See*, p. A 30, *infra*.

On a Petition for Rehearing, with a suggestion for a rehearing en banc, the Second Circuit on April 14, 1989, denied the Petition for Rehearing and declined to rehear en banc. *See*, p. C 1, *infra*.

The jurisdiction of this Court to review the judgment of the Second Circuit, is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. Whether allowing a junior member of an established and eminent team of medical researchers to convert a continually evolving teaching syllabus from an admitted joint work to an individually owned derivative work, merely by the addition of material (some of which itself was jointly authored), would have a chilling effect on medical or other scientific collaborative research to the serious detriment of the scientific community and the public?

2. Under the circumstances set forth above, under the Copyright Act
   (a) Can the unilateral intent of one joint author to convert a joint work to a derivative work ignore the intent of the other would-be joint author, whose authorship appears substantially in the work in question, in determining whether the work is joint?
   (b) Can the existence of an "intent" that a revised version of an existing joint work not be a joint work, which is not communicated to the other author, suffice to render the revised work derivative rather than joint?
3. Whether the Court of Appeals' rejection of Fair Use, predicated on erroneous findings such as lack of good faith and no joint work, completely eviscerates the well-established principles of Fair Use to the extent of stifling the very creativity which that law is designed to foster?
4. Whether a sharply divided Court of Appeals' direct assault on the "clearly erroneous" rule, totally ignoring the bench trial Judge's comprehensive findings of fact, *inter alia*, with respect to the credibility and intent of the parties, the nature of the collaborative efforts of the parties, the lack of new material substantial enough to create a derivative work and to the analysis of Fair Use factors, has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a course by a lower court, as to call for an exercise of this Court's power of supervision?

STATEMENT OF THE CASE

Respondent alleged the copyright infringement of a Nuclear Medicine refresher course syllabus (P-1), the most recent version of an evolving paper used by the parties since 1980 to accompany their continuing medical education lectures on the subject of radionuclide imaging, wherein respondent primarily sought injunctive and declaratory relief.

Following a bench trial, the District Court issued a comprehensive opinion, in which it carefully analyzed the evidence,

weighed the credibility of the parties [pp. B 16-17, *infra*], and determined that there had been no infringement, finding, *inter alia*,

> That P-1 is a joint work, of which petitioner is a joint author, written in execution of the parties' common design of research and writing with respect to an imaging agent known as "IDA" [pp. B 19-21, *infra*].
>
> That with respect to any matters newly added to P-1, petitioner was an active participant in researching and reporting [pp. B 12-14, *infra*] and that he also was the sole author of the "False-Positive Studies for Acute Cholecystits" and the preparer of the accompanying false-positive slides [pp. B 14-15, *infra*].
>
> That the parties had agreed that either of them might use P-1 for lecture purposes in both names or in the individual lecturer's name [p. B 11, *infra*], and that there was evidence of a practice that the name on the paper identified the lecturer rather than the author [pp. B 11-12, *infra*].
>
> That respondent had commenced the action not for reasons of copyright, but for personal reasons based upon employment-related grievances [p. B 18, *infra*]. Issues of credibility were also resolved in favor of petitioner and against respondent [pp. B 16-17, *infra*].
>
> That P-1 is not a derivative work, finding that its newly added matter is not sufficiently original to merit copyright protection [pp. B 21-23, *infra*], and that petitioner's contemplated use of P-1 would have been a fair use [pp. B 23-25, *infra*].

A sharply divided panel of the Second Circuit (Cardamone, J., with Pierce J., concurring in the result but disagreeing with an important aspect of the rationale) reversed in material part, remanding for entry of judgment in favor of respondent [pp. A 1-32, *infra*], while Judge Lumbard voted "to affirm the judgment of the district court in all respects, for the reasons

stated in Judge Pollack's thorough and reasoned opinion" [p. A 33, *infra*].

Judge Cardamone's view of the law as to joint authorship was a minority view, with which both Judge Pierce and Judge Lumbard disagreed. Yet, on the ground that the District Court applied the wrong legal standard [p. A 8, *infra*], the Majority opinion substituted its own findings for those made below even though none of the findings below had been adjudged clearly erroneous as required by Fed. R. Civ. P. 52(a).

The Majority opinion found that respondent terminated the parties' collaborative efforts with respect to IDA in 1984 [pp. A 13-15, *infra*] despite the reference in her 1987 vitae to two works jointly authored with petitioner as "submitted for publication" and five works with petitioner as "in preparation."

The Majority opinion ignored the compelling objective evidence of the intent of both parties that P-1 be a joint work, just as its predecessors were joint works. Disregarding this evidence of mutual intent, the touchstone of a joint work under the Copyright Act, the Majority opinion focused instead on the physical preparation of the manuscript for P-1: "as a non-contributing party to P-1, Dr. Freeman's intent . . . is not relevant to claimed joint authorship of P-1." [p. A 15] This erroneous view, from which even the concurring opinion disassociated itself, fails to recognize that P-1's minimal new matter was in substantial part the product of petitioner.

Under the majority's convolution, every up-date of the syllabus aid could have been a derivative work which either contributor could have registered surreptitiously in his or her name alone years after the fact so as to sue the other for infringement. It is only the ongoing collaborative nature of the research and authorship collaboration of petitioner and respondent that preclude such a bizarre result. But under the Second Circuit result respondent necessarily repeatedly infringed prior versions created by petitioner along the way to creating P-1! The absurdity of the result suggests the error of the logic leading to it.

Finally, the Second Circuit majority's analysis of Fair Use, predicated on erroneous findings such as lack of good faith and no joint work, completely eviscerates the well-established principles of Fair Use.

REASONS FOR GRANTING THE WRIT

I

THE SECOND CIRCUIT MAJORITY OPINION FUNDAMENTALLY MISAPPLIES THE LAW OF JOINT AUTHORSHIP BY IGNORING THE DISTRICT COURT'S UNCONTROVERTED FINDINGS REGARDING THE PARTIES' INTENTION TO CREATE A JOINT WORK

In concluding that P-1 was a joint work, the District Court pointed to overwhelming evidence that this syllabus was merely the latest update in a series that constituted a single, evolving "stock piece" upon which the parties had collaborated since April, 1980 [p. B 10, *infra*] and that the parties' course of conduct over this period led to the conclusion that petitioner and respondent had formed an agreement whereby "the stock piece could be used as a handout by either of them, in their individual or joint names, to accompany the teaching review course lecture in which the individual was the assigned lecturer" [p. B 12, *infra*]. Additionally, the District Court based the conclusion that P-1 was intended as a joint work upon the content of the work itself: aside from containing much material which had been prepared solely by petitioner, the text expressly attributes a recommendation concerning a technique for administering IDA to "we," which the District Court found was "clearly a reference to Weissmann and her collaborator" [pp. B 12-14, *infra*].

Petitioner's intent that his contributions were to an evolving joint work cannot be disregarded. Certainly, respondent could not defeat that intent without communicating the change to her long-time collaborator.

The Second Circuit majority opinion for the divided panel, failed to give the District Court's findings of fact the deference which they are due under Fed. R. Civ. P. 52(a). On the contrary, the *de novo* review of the evidence, improperly substituting selective evaluation of the facts for the express findings made after careful review by the District Court, directly contravened Rule 52(a)'s injunction that "[f]indings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses." *See* Point IV, *infra*.

This *de novo* review resulted in a highly distorted analysis of the evidence in this case, and a wholly unfounded interpretation of its legal significance. The majority's repeated and erroneous statements that petitioner made no contribution to P-1 are strikingly refuted by the District Court's findings that P-1 consisted primarily of material jointly written by the parties for previous syllabi and other works or written individually by petitioner alone. Even the new matter in P-1 had in substantial part originated with petitioner's participation [pp. B 16-19, *infra*].

In addition to fundamentally misapprehending critical evidence in this case, the majority opinion, in effect, refashions the law of joint authorship by disregarding objective evidence of the parties' intent to create a joint work, and relying upon the self-serving, subjective and uncommunicated "intent" of one of the authors. As correctly noted in the concurring opinion, petitioner need not have "contributed to each incremental addition to the work" in order to be deemed a joint author. A view of the law that is firmly established in the Second Circuit, recognizing that contributors to a joint work need not "work in concert or even . . . know each other; it is enough that they mean their contributions to be complementary in the sense that they are to be embodied in a single work . . .". *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944). Although there was ample evidence of petitioner's substantial contributions to P-1, the majority not only misapplied the law with its suggestion that the parties must work contemporaneously, but rode roughshod over the District

Court's fact findings as to the parties' intent without any of those findings having been adjudged clearly erroneous.

In order to create a joint work, authors need only have "the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." 17 U.S.C. § 101. Rejecting the district court's findings, which had been based upon compelling, objective evidence of the parties' long-standing intent to have created an evolving joint work, the majority opinion relies instead upon its own speculative conclusion that P-1 followed a 1984 termination of this collaboration. However, any suggestion that respondent intended to sever their collaboration even as of 1985 is directly contradicted by her 1987 vitae, discussed above. In drawing this conclusion, the majority relies, in large measure, upon respondent's use of her own by-line as evidence of her intent to establish individual authorship. But this rewrites another finding of the District Court regarding the parties' long-established practice of using the syllabus with the by-line of only one of the authors [p. B 12, *infra*] with "some indication of a practice that, rather than designating the authorship, the by-line name . . . was utilized as an identification of the reviewer or lecturer who was to appear before the audience" [p. B 11, *infra*]. If the by-line alone is determinative of intent, the majority's reasoning allows the conclusion that petitioner's 1984 Harvard syllabus was an individual work, and that respondent's whole use of it at Mount Sinai later in 1984 was an infringement.

II

THE SECOND CIRCUIT FUNDAMENTALLY MISAPPLIES THE LAW REGARDING DERIVATIVE WORKS BY OVERLOOKING THE LACK OF ORIGINALITY OF RESPONDENT'S CONTRIBUTIONS TO P-1

In order to qualify for protection as a derivative work under 17 U.S.C. § 103, a work must contain "some substantial, not merely trivial originality." *L. Batlin & Son, Inc. v. Snyder*, 536

F.2d 486, 490 (2d Cir.) (*en banc*), *cert. denied*, 429 U.S. 857 (1976).

As the District Court made clear, the material added by respondent to P-1 consisted of four new references: two citing illustrations "originally prepared" by petitioner, "one citing to a work jointly authored by the parties, and one citing to a work that reported a procedure disfavored by the parties" [p. B 15, *infra*]. Moreover, the District Court found that a large portion of petitioner's individual writing on false-positives had been incorporated into P-1 [p. B 12, *infra*]. The finding that petitioner had "originally prepared" those two illustrations signifies the District Court acceptance of petitioner's testimony [pp. B 13-14, *infra*] that he had prepared all of the illustrations in P-1—a fact borne out by the permission references under all but one of the illustrations. Despite this pervasive presence of petitioner's contributions, the Majority erroneously concluded that respondent's "selection of subject matter . . . and rearrangement" constituted sufficient "originality" to qualify P-1 as a derivative work under 17 U.S.C. § 103.

The Majority's analysis is clearly mistaken. First, new matter cannot make the new version a "derivative work" rather than a joint work where the new matter is itself jointly authored. Since the false-positive studies and all illustrations were of petitioner's authorship, this in itself was a joint contribution to a pre-existing joint work and, as a matter of law and logic, the result *must* be a joint work! Further, new matter cannot make the new version a "derivative work" where the new matter is no more substantial than variations between prior versions of the work, all of which were concededly joint.

The degree of modification involved in assembling P-1 was found by the District Court to be at least as trivial as those required by the parties' previous up-dates of the stock piece [p. B 15, *infra*]. This comparative finding was not even addressed by the Second Circuit. Thus there is no basis for concluding that P-1 is any more "original" a work than any of the previous stock pieces.

More disturbingly, the Second Circuit decision could make each up-date of a continuing joint work a derivative work and enable Mr. Funk to add minimal material (some of which material was written by Mr. Wagnall) to the 47th edition of Funk & Wagnall, register the new edition solely in the name of Mr. Funk (evidencing unilateral intent to cease the age-long collaboration) and subsequently sue Mr. Wagnall for publishing the 48th edition. Such a practice would be grossly unfair and would fundamentally undermine authors' incentives to enter into such collaborative arrangements in the first place.

III

THE SECOND CIRCUIT MAJORITY'S DECISION MISCONSTRUES AND EVISCERATES THE DEFENSE OF FAIR USE

"The doctrine of fair use . . . permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." *Iowa State University Research Foundation, Inc. v. American Broadcasting Cos.*, 621 F.2d 57, 60 (2d Cir. 1980). The Second Circuit majority decision unjustifiably restricts the application of this "entirely equitable" doctrine. *Time, Inc. v. Bernard Geis Associates*, 293 F. Supp. 130, 144 (S.D.N.Y. 1968).

The Majority opinion properly acknowledges that the statutory factors for evaluating a fair use defense under 17 U.S.C. § 107 may be supplemented by considering the "underlying equities" of each case. However, its characterization of the equities of this case is grossly inaccurate. According to the Majority opinion, petitioner's use of his by-line on P-1 amounted to "appropriating another's work without crediting the author," and thus "severely undermined his right to claim the equitable defense of fair use." This indictment of petitioner is entirely unfounded given the District Court's uncontravened finding that the parties routinely attached one or the other's by-line to syllabi containing the work of both of them. [p. B 11, *infra*]. Thus, petitioner's use of his by-line was not evidence of

bad faith but only another example of the parties' established mutual practice.

Moreover, the Second Circuit Majority opinion overlooks the virtually dispositive evidence of petitioner's good faith, his immediate withdrawal of P-1 from his review course handouts upon receiving word of respondent's protest. [p. B 2, *infra*].

The Majority analysis of the four statutory "fair use" factors is at odds with the settled case law interpreting 17 U.S.C. § 107, and substantially rewrites that law. The first statutory factor requires consideration of the "purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit education purposes . . . ". The Majority's discussion of this factor overlooks the fact that Dr. Freeman's use of P-1 represented virtually a paradigmatic example of the sort of activity which the fair use doctrine was designed to protect. *See* 3 Nimmer § 13.05 at 13-72 (". . . defense of fair use will more readily be recognized where defendant's work is used for educational, scientific, or historical purposes . . .").

The Second Circuit majority opinion also distorts the significance of the non-commercial nature of petitioner's use of P-1. The Supreme Court has declared that "every commercial use of copyrighted material is presumptively an unfair exploitation. . .". *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984). Flouting the basic purpose of the fair use doctrine, the Second Circuit majority extends the same adverse presumption to petitioner's non-commercial use. Petitioner's $250 lecture honorarium clearly was not dependent upon the submission of a hand-out).

The second statutory factor, "the nature of the copyrighted work," was initially acknowledged by the lead opinion to be favorable to petitioner because of the firmly established legal recognition of the need to disseminate factual works. This factor undoubtedly deserved greater weight in the Court's decision. Moreover, the fact that P-1 had already been published, a point entirely ignored by the majority opinion, was another aspect of the work's "nature" that should have been weighed in petitioner's favor. *Salinger v. Random House, Inc.*, 811 F.2d

90, 95 (2d Cir.), *cert. denied*, 108 S. Ct. 213 (1987). The majority opinion essentially nullifies the favorable effect of this factor by suggesting that the encouragement of factual research does not permit "wholesale appropriation of scientific works. . .". *Id.*

The unfounded suggestion that petitioner appropriated large quantities of respondent independent work also mars the discussion of the third statutory factor, "the amount and substantiality of the portion used in relation to the copyrighted work as a whole. . .". The majority opinion weighs this factor strongly against petitioner because of his use of P-1 in its entirety. Yet this approach ignores the critical fact that P-1 consisted almost entirely of preexisting material which petitioner had every right to use, as the copyright in a derivative work does not extend to "preexisting material." 17 U.S.C. § 103(b). Thus, the majority's consideration of this factor flouts the basic principle that only original material in a derivative work is protected. *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 909 (2d Cir. 1980).

The fourth statutory factor calls for consideration of "the effect of the use upon the potential market for or value of the copyrighted work." The majority opinion disregards both the clear language of the statute and case law in his discussion of this "single most important element of fair use." *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 566 (1985). Instead the Majority imports to its discussion of this factor non-economic considerations concerning the effect of petitioner's use of P-1 on respondent's reputation. Such an analysis, more appropriate to a claim of trademark infringement, clearly has no place in an evaluation of the alleged impairment of P-1's market value. As to that issue, the Second Circuit's majority opinion provides no refutation of the District Court's finding that petitioner's use of P-1 "would in all likelihood only increase the 'marketability' " of the paper. [p. B 25, *infra*]. In the absence of any such refutation, the majority evaluation of this factor fundamentally neglects the relevant factual and legal questions.

The cumulative effect of the Second Circuit majority's misapplication of each factor of the fair use doctrine is to reduce that doctrine to a nullity.

IV

THE SECOND CIRCUIT'S DIRECT ASSAULT ON THE "CLEARLY ERRONEOUS" RULE CALLS FOR AN EXERCISE OF THIS COURT'S POWERS OF SUPERVISION

Rule 17.1(a), Rules of the Supreme Court of the United States, specifies that consideration might be called for where ". . . a federal court of appeals has rendered a decision [which] has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court, as to call for an exercise of this Court's power of supervision."

The bench trial lasted four days, during which time the District Court had the opportunity to "consider the proofs and observe the demeanor of the parties as witnesses with respect to many critical issues in controversy, including but not limited to:

1) The extent to which petitioner participated in the underlying research,

2) The extent to which petitioner had participated in the prior syllabi and other works published in the names of both parties,

3) Whether petitioner ever had himself listed as an author where he had not contributed to the work,

4) Whether respondent ever exacted from petitioner conditions upon his use of "her" work,

5) Whether petitioner had participated in the contents of P-1, and

the District Court concluded that "based upon the parties' testimony and demeanor, illumined by the documentary evidence and the testimony of non-party witnesses, the Court resolves

the issues of credibility in favor of [petitioner] and against the [respondent]." [p. B 17, *infra*].

Notwithstanding these findings of fact by the District Court, the Second Circuit Majority opinion blithely ignores the clearly erroneous standard under Fed. R. Civ. P. 52(a) without reversing a single fact determined by the District Court. The Second Circuit's rationale for so doing is ostensibly that Rule 52 is inapplicable where the district court's findings are premised on an erroneous view of legal standard, citing, *United States v. Parke, Davis & Co.*, 362 U.S. 29, 44 (1960). This is an incredible quantum leap, concluding out of the whole cloth that the District Court did not make any specific findings regarding P-1 itself and surprisingly found P-1 to be a joint work "despite [petitioner's] concession that he had no hand in P-1 preparation." The District Court specifically found that petitioner had in fact participated in the contents of P-1 and that respondent's contentions to the contrary were incredible. Accordingly, it was not the District Court that made findings of fact "predicated upon an incorrect legal standard"; it was the Second Circuit that wrongfully applied a legal standard based upon a misconception of the facts.

It is this very misapplication of Rule 52 *de novo* review that "has so far departed from the accepted and usual course of judicial proceedings" and has "so far sanctioned such a course by a lower court" so as to invoke this Court's power of supervision. Even proponents in favor of a more searching review of findings by a district court based solely on documentary evidence do not adhere to this position when the findings rest on the trial court's assessment of credibility of witnesses. There is a great public interest in maintaining the ability of a trial court to be the finder of facts. Any contrary result would undermine the powers of the district courts and foster proliferated appeals. This Court has not clearly resolved this issue (*see Bose Corp. vs. Consumers Union of the United States, Inc.*, 466 U.S. 485 (1984)), but it is respectfully submitted that this Court should resolve this issue in favor of petitioner.

V

THE SECOND CIRCUIT'S DECISION IS ERRONEOUS, REPRESENTS A GROSS MISCARRIAGE OF JUSTICE, IS UNDULY HARSH IN ITS IMPACT AND WILL HAVE A CHILLING EFFECT ON SCIENTIFIC RESEARCH

While the factors of erroneousness and harshness do not themselves require review by this Court, the gross miscarriage of justice occasioned by the Second Circuit Majority opinion will have a chilling effect on medical and other scientific collaborative research to the serious detriment of the scientific community and the public. Most important medical and other scientific discoveries have been the result of collaboration between two or more eminent practitioners in a particular scientific field. If we engender a fear that one collaborator can unilaterally usurp the efforts of another, we will be tearing down the ability of brilliant minds to work together for the benefit of mankind.

It is extremely unfortunate that this action, sounding in copyright, dangerously interferes with the very purpose of copyright: "to promote the progress of science and useful arts." U.S. Constitution, Article I, Sec. 8, Cl. 8.

CONCLUSION

For the foregoing reasons, this petition for certiorari should be granted. The United States Court of Appeals for the Second Circuit, in a fragmented one-to-one-to-one opinion has reached a wrong conclusion by applying wrong procedure to misinterpreted facts, to the detriment of the medical research community and the public.

July 13, 1989

Respectfully submitted,

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APPENDICES

Appendix A

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

Nos. 225, 353—August Term 1988

(Argued October 20, 1988 Decided February 23, 1989)

Docket Nos. 88-7435, 88-7465

HEIDI S. WEISSMANN, M.D.,

Plaintiff-Appellant, Cross-Appellee,

—v.—

LEONARD M. FREEMAN, M.D.,

Defendant-Appellee, Cross-Appellant.

Before:

LUMBARD, CARDAMONE, and PIERCE,
Circuit Judges.

Heidi S. Weissmann, M.D., appeals from a judgment of the United States District Court for the Southern District of New York (Pollack, J.) entered on May 11, 1988, dismissing after a bench trial appellant's claims against Leonard M. Freeman, M.D., for copyright infringement.

Defendant cross-appeals from the denial of his request for attorney's fees and sanctions.

Reversed in part and affirmed in part.

Judge Pierce concurs in the result and files a separate opinion; Judge Lumbard dissents in a separate opinion.

ROGER L. ZISSU, New York, New York (Cowan, Liebowitz & Latman, New York, New York, of counsel), *for Plaintiff-Appellant.*

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CARDAMONE, *Circuit Judge*:

This appeal presents the paradigm of the problems that arise when a long relationship between accomplished professor and brilliant assistant comes to an end. Together the two had researched and co-authored scholarly scientific works. When the appellant—the younger assistant—individually wrote what she considered a new work, the appellee—the mentor—believing himself a co-author of the new piece, used his assistant's work, styling it as his own, and thereby precipitated the instant litigation.

Heidi S. Weissmann, M.D. appeals the dismissal after a bench trial in the Southern District of New York (Pollack, J.), of her copyright infringement suit against Leonard M.

Freeman, M.D. Among the issues presented on appeal is the novel question of whether a medical paper derived from the parties' prior jointly authored works is itself a joint work, or whether it is a copyrightable individual derivative work, the infringement of which gives rise to a cause of action under the Copyright Act, 17 U.S.C. § 101, *et seq.* (1982 & Supp. III 1985).

FACTS

The parties are both accomplished scientists in the field of nuclear medicine. Appellant Weissmann is an Associate Professor of Radiology and Nuclear Medicine at the Albert Einstein College of Medicine (Einstein), and is an attending physician specializing in nuclear medicine at the Montefiore Medical Center (Montefiore). She has received numerous awards in the area of radionuclide imaging, and published more than 80 scholarly articles. Appellee Freeman is also a prolific author, and a noted lecturer in the fields of nuclear medicine and diagnostic radiology. He has served as President of the Society of Nuclear Medicine, and currently is a professor of Radiology and of Nuclear Medicine at Einstein, where he has taught since 1964. He is the Director of the Nuclear Medicine Service at Montefiore and Vice-Chairman of the Department of Nuclear Medicine at Einstein.

The parties' professional association began in 1977 when Dr. Weissmann was in her fourth year of residency at Montefiore and Dr. Freeman was Chief of the Division of Nuclear Medicine at that hospital. In early 1977 appellee was researching the application of the derivatives of a certain radiopharmaceutical, iminodiacetic acid (IDA). IDA is a substance labeled with a radioactive isotope that is injected into the bloodstream and, when picked up by

the liver, permits diagnosis of certain liver and biliary disorders. In the late 1970's drug manufacturers producing IDA analogs needed scientists to develop a patient data base to obtain approval of their Food and Drug Administration applications in order to market the isotopes in the United States. One selected scientist was Dr. Freeman, who began using the IDA analogs in his research efforts. As a fourth-year resident, appellant worked on these initial studies under Dr. Freeman's tutelage. The parties' first jointly authored article on IDA derivatives was published in January 1979. Over the next several years a series of articles on the use of IDA scanning in diagnosing biliary diseases were published in the names of Freeman, Weissmann, and other scientists.

Beginning in 1980 the parties worked together as researchers and co-authors of a number of papers focusing on various aspects of nuclear medicine, particularly IDA imaging. Prior versions of the work alleged to have been infringed in the instant litigation were first written in 1980 for a nuclear medicine review course sponsored by the Harvard Medical School. The district court found that the work in which appellant claims a copyright (Plaintiff's exhibit 1 or P-1) is a "syllabus," that is, a paper reviewing the state of the art of hepatobiliary imaging techniques, prepared to accompany lectures, and used by medical residents to study for specialty boards. From 1980 to 1985 prior versions of P-1 were constantly revised and updated by the parties in an ongoing cooperative effort.

In 1985 Dr. Weissmann authored the article that precipitated the present copyright suit. It was entitled "Hepatobiliary Imaging" (P-1), and reported on a relatively new diagnostic technique employing radioactive analogs of the agent IDA. The work was prepared as a chapter for the

Radiological Society of North America's book entitled "Syllabus: A Categorical Course in Nuclear Medicine," printed and published in 1985. The publication listed Dr. Weissmann as the article's sole author.

Appellant's creation admittedly was derived from previous papers jointly written by the parties during the course of their professional relationship that extended from 1977 to 1984. An examination of the relevant documents reveals that portions of P-1 were taken virtually verbatim from prior jointly authored pieces that had been presented at Einstein and at the Mount Sinai School of Medicine (Mount Sinai) in 1983 and 1984 respectively. Although P-1 appears to restate the central propositions asserted in the prior works, Weissmann's exhibits includes the following new elements: (1) a new selection of photo illustrations and associated captions; (2) references to four recent reports in the pertinent literature; (3) new textual additions; and (4) reorganization of previous material. Appellee conceded at trial that this material in P-1 was created solely by appellant.

In the summer of 1987 Dr. Freeman was invited to give a review course on nuclear medicine at Mount Sinai. He prepared P-1 to use in giving the course by deleting Dr. Weissmann's name from P-1 and replacing it with his own, and by adding three words to the title. Fifty copies of the article were made. Before the date set for the course, appellant obtained one of the copies, and through counsel requested that her revised article not be circulated, and that all those who had received copies be informed that she claimed sole authorship of it. The article was removed from the packet of course materials. Dr. Freeman delivered his lecture without the use of his version of P-1.

After this incident, Weissmann filed the instant suit alleging copyright infringement in violation of 17 U.S.C. § 501 (1982 & Supp. 1985). In her prayer for relief she sought a declaration that Freeman had committed actionable infringement, an injunction permanently restraining him from infringing, and an award of actual damages and profits. Appellant consented to the dismissal of her claim for attorney's fees because the copyright she obtained covering P-1 was not registered before the suit was commenced, and such is a statutory prerequisite to a claim for attorney's fees.

PROCEEDINGS BELOW

After a four-day bench trial, Judge Pollack in a written decision concluded that Dr. Freeman's use of P-1 did not violate the copyright law. 684 F. Supp. 1248 (S.D.N.Y. 1988). In support of its determination that Freeman had not infringed any legally cognizable rights that appellant may have had in P-1, the district court found that appellee was a joint author, and therefore a co-owner of any copyright Weissmann acquired in the article. 684 F. Supp. at 1260. The trial court also determined that P-1's new matter was too trivial to qualify for protection as a derivative work under the copyright statute. *Id.* at 1261. Additionally, it ruled that even were Freeman not a joint author of the allegedly infringed work, and even were P-1's new matter copyrightable, Freeman's purported use of P-1 was a fair use within the purview of § 107 of the Copyright Act. *Id.* at 1261-62.

In the course of the proceedings the district court denied appellant's two substantive motions. The first was pursuant to Rule 15(b) for leave to amend the pleadings to conform to the proof. Appellant sought to have the court

evaluate and consider claims arising from appellee's allegedly publishing another verbatim copy of P-1 under his name for a December 1986 symposium in the Republic of China (the Taiwan Publication), and the supposed proof that Freeman's conduct constituted misrepresentation of origin under § 43(a) of the Lanham Act and under the common law. The second motion made under Rule 60(b) sought reconsideration by the trial court of its finding that the Taiwan Publication had not been proven to be connected with Dr. Freeman. Appellee's request for attorney's fees and for sanctions was denied. Appellant appeals from the dismissal of her copyright infringement suit, and appellee cross-appeals from the denial of attorney's fees and sanctions against appellant.

DISCUSSION

On appeal appellant argues that the district court erred in (1) determining that appellee was a joint author of P-1 within the meaning of §§ 101 and 201 of the Copyright Act, (2) concluding that P-1 did not contain sufficient new matter to qualify for copyright protection as a derivative work under §§ 101 and 103(b), and (3) deciding that, even if appellee was not a joint author and the article therefore did qualify for protection as a derivative work, appellee's use of P-1 constituted a fair use under § 107, and (4) denying appellant's 15(b) and 60(b) motions.

I *Joint Authorship*

Before discussing whether P-1 was a joint work, we set forth the standard of review to be applied to the district court's determination that P-1 was such a work. Ordinarily the clearly erroneous standard under Fed. R. Civ. P.

52(a) would govern. But, when a district court makes findings of fact predicated upon an incorrect legal standard such findings are not binding on an appellate court. *See United States v. Parke, Davis & Co.*, 362 U.S. 29, 44 (1960) (Rule 52 inapplicable where district court's findings premised on erroneous view of legal standard).

Here the district court determined that the entire series of the parties' works on the subject of radionuclide imaging—including the work alleged to have been infringed—constituted a single evolutionary joint work. It discussed the conceded joint authorship in the preexisting works. Without making any specific findings respecting P-1 itself, the court found that Dr. Freeman was a co-owner of P-1 and that P-1 was a joint work. The trial court made this surprising finding despite Dr. Freeman's concession that he had no hand in P-1's preparation. The finding was made based on the district court's mistaken view that joint authorship of the prior existing works automatically makes the two joint authors co-owners of the derivative work. Such a ruling stands copyright law on its head. It flies in the face of the Copyright Act which affords protection to each work at the moment of its creation. Thus, § 101 provides for those works prepared over time that "the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work."

Of greater significance is that the trial court's view would convert all derivative works based upon jointly authored works into joint works, regardless of whether there had been any joint labor on the subsequent version. If such were the law, it would eviscerate the independent copyright protection that attaches to a derivative work

that is wholly independent of the protection afforded the preexisting work. *See* § 103(b). Hence, it was a plain error for the district court to rule, as a matter of law, that Dr. Freeman's joint authorship of the prior works made him a joint author with appellant in the derivative work.

The district court also made a finding of fact that Dr. Freeman was a joint author with Dr. Weissmann of P-1. Section 201(a) of the Act provides: "Copyright in a work protected under [the Copyright Act] vests initially in the author or co-authors of the work." Section 101 defines a "joint work" as one "prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." In a joint work each author "automatically acquires an undivided ownership in the entire work" including any portion of it. 1 M. Nimmer, *Nimmer on Copyright* § 6.03, at 6-6 (1988). Thus, an action for infringement between joint owners will not lie because an individual cannot infringe his own copyright. The only duty joint owners have with respect to their joint work is to account for profits from its use. *See Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429, 430 (S.D.N.Y. 1974).

A review of the meaning of §§ 101 and 103(b) and of their legislative history reveals two basic criteria that must be satisfied before one is a joint author of a derivative work. First, each putative author must have "contributed" to the work. Second, each must intend to contribute to a joint work at the time his or her alleged contribution is made. Because § 103(b) extends independent protection to derivative works, an intent to contribute or an actual contribution to previous works does not serve as proof of ownership in the derivative work. *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess. 103, 120, *reprinted in* 1976

U.S. Code Cong. & Admin. News 5659, 5736 (*House Report*). We consider these two criteria.

A. Contribution to Derivative Work

The statute envisions that each author contribute to a joint work. "Under the [§ 101] definition a work would not be 'joint' unless its authors collaborated among themselves or unless each of the authors knew, at the time the work was being written, that his contribution would be integrated as an 'inseparable' or 'interdependent' part of a 'unitary whole.' " *Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*: 1965 Revision Bill, 89th Cong., 1st Sess., Copyright Law Revision Part 6, at 65 (House Comm. Print 1965), *reprinted in* 1 Copyright Law Revision (1964-1965).

In enacting the definition of a joint work set forth in § 101, Congress endeavored to "make[ ] plain that copyright in a derivative work is independent of, and does not enlarge the scope of rights in, any pre-existing material incorporated in it. There [was] thus no need to spell this conclusion out in the definition of 'joint work.' " *House Report* at 120. The legislative history clearly indicates that one cannot be deemed to be a joint author without actually collaborating in the work's preparation. Critical therefore "is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit." *Id.* That intention must be with respect to the work in which a copyright is claimed, not with respect to the prior works from which it is derived. *See MCA, Inc. v. Wilson*, 425 F. Supp. 443, 455 (S.D.N.Y. 1976) (owner of underlying work obtains no property rights in derivative work), *aff'd*, 677 F.2d 180 (2d Cir. 1981).

In the case at hand, because Dr. Freeman conceded that he had not participated in drafting the new matter included in P-1, it follows as a logical corollary, therefore, that he acquired no interest in or right to use P-1 beyond those rights which he had as co-author in the prior joint material incorporated into P-1. Even though one co-author has the right to revise a joint work in order to create an individual derivative work, the other co-author acquires no property rights in the newly created work prepared without his involvement. *See Dynamic Solutions, Inc. v. Planning and Controls, Inc.*, 646 F. Supp. 1329, 1338-39 (S.D.N.Y. 1986) (even sole author/owner of pre-existing material contained in derivative work has no property right in new matter created for the derivative work added without his participation); *see also Weinstein v. University of Illinois*, 811 F.2d 1091, 1095 (7th Cir. 1987); *House Report* at 120; 1 Nimmer § 6.06[B], at 6-15.

B. Intent to Contribute to Derivative Work

The second point upon which inquiry is focused is Dr. Weissmann's intent. The district court made no express finding on this critical issue. It simply stated in conclusory fashion that because the parties had intended P-1's predecessors to be used jointly as a "stock piece" to accompany their review lectures, they had somehow impliedly agreed that all future works on the subject of radioactive analogs of IDA, including P-1, would also be a joint work.

In order for a work to be deemed a joint work, the parties must evince "the *intention* that their contributions be merged," § 101 (emphasis added), "at the time the writing is done," *House Report* at 120, not at some later date. *See* 1 Nimmer § 6.03, at 6-7. The law on this point is set forth in *Edward B. Marks Music Corp. v. Jerry Vogel Music*

Co., 140 F.2d 266 (2d Cir. 1944) (L. Hand, J.). There it was observed that a finding of joint authorship requires that each author intend his or her contribution, at the time that it is created, to become part of a unitary work to which another will make or already has made a contribution. Or, as Judge Hand stated it, "when both plan an undivided whole . . . , their separate interests will be as inextricably involved, as are the threads out of which they have woven the seamless fabric of the work." *Id.* at 267; *see also Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, ("*Melancholy Baby*"), 161 F.2d 406, 409 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947).

Marks was a case in which one individual had written the lyrics for a song and another had written the music. Neither party knew the other, but both were aware that their individual efforts would not stand alone. In holding that the resulting song was a joint work, the critical fact was that both parties were equally aware that their individual authorship efforts would have to be combined in order to create the final integrated product—a commercially viable song. *See Marks*, 140 F.2d at 267. From this, the rule has evolved that an author who intends to create a joint work must clearly demonstrate his or her intent in that regard. Although such an intent may, as in *Marks*, be inferred from the circumstances surrounding the creation of the work, in the absence of such a showing, the work is presumed to be the product of an individual author and is the sole property of its creator. *See, e.g., Gilliam v. American Broadcasting Cos., Inc.*, 538 F.2d 14, 22 (2d Cir. 1976) (Lumbard, J.) (reservation of rights by one party inconsistent with joint authorship and work not therefore joint); *Picture Music, Inc. v. Bourne, Inc.*, 314 F. Supp. 640, 645 (S.D.N.Y. 1970) (declining to find joint authorship where a "common design to create a single work" not

shown to exist), *aff'd on other grounds*, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997 (1972); *cf. Community for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1497 (D.C. Cir. 1988), *cert. granted*, 109 S. Ct. 362 (1988).

In the present case, Drs. Weissmann and Freeman collaborated in the preparation and publication of the works from which P-1 was derived. Yet, there is no evidence that they intended their joint product to be forever indivisible like the finite whole of the completed single song in *Marks*. The facts point to a contrary conclusion. Scientific research is a quest for new discoveries and the preexisting joint works by definition were continually evolving. Dr. Weissmann believed she had a new and better approach and decided to author her research alone. Section 103(b) of the Copyright Act gives her that right when it extends independent protection to derivative works. The joint authorship of the underlying work does not confer any property right in the new work, save those rights which the co-author (here Dr. Freeman) of the previous works retains in the material used as part of the compilation of the derivative work. The district court opinion reveals a fundamental misunderstanding of these principles. This misconception is reflected in its discussion of Dr. Weissmann's intent to merge her efforts with Dr. Freeman based only on P-1's predecessors, and not on P-1 itself.

C. Appellant's Intent to Create a Derivative Work

The remainder of discussion of joint authorship concerns the substantial and uncontroverted evidence that Dr. Weissmann intended P-1 to be her own individual work. As a preliminary matter, it is important to note that of the 88 articles, abstracts, and book chapters listed on her curriculum vitae, 71 credit Dr. Freeman as a co-author.

Appellant's having deviated from that pattern in submitting P-1 for publication as a chapter in the Radiological Society of North America's book under the name "Heidi S. Weissmann" is persuasive proof of the fact that she intended this particular piece to represent her own individual authorship. Appellant's use of her own by-line on P-1 constitutes *prima facie* proof that this work was not intended to be joint. Appellee failed to produce any evidence to rebut appellant's showing. In fact, Dr. Freeman lectured at the same meeting at which P-1 was first presented, and made no objection to the omission of his name from it.

Again, had the trial court separately considered P-1, it would have concluded that appellant's article was the only work with respect to which it was repeatedly conceded that appellee had played no role. Yet, the trial judge found that "plaintiff did almost all of the writing" for the works listed on her resume of which Freeman was a "co-author" and that she routinely "submitted drafts to Dr. Freeman before publication." 684 F. Supp. at 1254. It also found that "[s]he would always make sure to leave a copy of a manuscript on his desk if he was not in town or busy with other commitments; she did not always get comments back, but often she did." *Id.* Hence, it is significant on the issue of appellant's intent that P-1 was one of those few works that was not submitted for Dr. Freeman's review and on which she did not receive his comments. These facts—found by the district court—strongly evidence appellant's intent that P-1 be solely her own work.

The district court found that Freeman's participation in the preparation of P-1 was "strikingly illustrated" by Weissmann's inclusion in P-1 of a section entitled "False-Positive Studies for Acute Cholecystitis" which Dr. Free-

man had independently composed for a 1984 Harvard review course. The incorporation of this material into P-1 is irrelevant to the question of whether or not the parties intended P-1 to be a joint work. Appellant correctly points out that the inclusion of the "False Positive" section is not proof of any intention on Dr. Freeman's part to make a contribution to P-1 because, prior to 1985, he could not have formed an intent to contribute his efforts to her then nonexistent work.

In sum, the evidence presented at trial fully supports appellant's contention that the work alleged to have been infringed was solely the product of her authorship efforts. Although her work derived from preexisting jointly authored material, appellee played no role in P-1's creation. As a non-contributing party to P-1, Dr. Freeman's intent regarding his contributions to the underlying preexisting work is not relevant to claimed joint authorship of P-1. The district court's conclusion that P-1 was a joint work because the entire series of the parties' articles on IDA, including P-1, was one evolutionary joint work disregards the copyright protection accorded derivative works, independent of the preexisting works under § 103(b). As a consequence of its plain error of law in this regard, the district court's finding of fact that Freeman's co-authorship of the preexisting works also made him a joint author of P-1 is clearly erroneous.

II *Derivative Work*

We now turn attention to whether P-1 qualifies for protection as a derivative work as that term is defined by the Copyright Act. To establish a claim of copyright infringement, plaintiff must prove ownership of a valid copyright and copying by the defendant. With Dr. Freeman's copy-

ing admitted, the only question is whether Dr. Weissmann owned a valid copyright in a so-called derivative work. Although her certificate of registration "constitute[s] prima facie evidence of the validity of the copyright and of the facts stated in the certificate," 17 U.S.C. § 410(c), it is not conclusive on the issue of copyrightability; it merely creates a presumption of validity. *See, e.g., Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980); *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435, 1440 (S.D.N.Y. 1986) (certificate shifts burden to defendant to disprove copyright's validity).

Section 101 of the Copyright Act defines a "derivative work" as one that is based on "preexisting works." In addition, § 103(b) provides as follows

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such a work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

Section 101 of the statute further defines a derivative work as "[a] work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship . . . ." Thus, it is clear that "the manner of expression, the author's analysis or interpretation of events, the way he structures his material and marshals facts, his choice of words, and the emphasis he gives to particular developments" are protected under the copyright laws. *Wainwright Securities,*

Inc. v. Wall Street Transcript Corp., 558 F.2d 91, 95-96 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978).

The principle of derivative work protection is subject to two important limitations, both of which were purportedly recognized by the district court. To support a copyright, a derivative work must be more than trivial, and the protection afforded a derivative work must reflect the degree to which the derivative work relies on preexisting material, without diminishing the scope of the latter's copyright protection. *Durham Indus.*, 630 F.2d at 909. This rule is premised on the notion that " 'the one pervading element prerequisite to copyright protection regardless of the form of work' is the requirement of originality—that the work be the original product of the claimant." *L. Batlin & Son v. Snyder*, 536 F.2d 486, 489-90 (2d Cir.) (*en banc*) (quoting 1 Nimmer § 10, at 32 (1975)), *cert. denied*, 429 U.S. 857 (1976). Originality is and always has been rightly prized. Dostoevsky, for example, insisted that the measure of a person's worth in pre-Revolutionary Russia did not depend so much on money or position, as it did on one's originality. F. Dostoevsky, *The Idiot*, Part I (Garrett Trans. 1958). Mill wrote that "nothing was ever yet done which someone was not the first to do, and . . . all good things which exist are the fruits of originality . . . ." J.S. Mill, *On Liberty* 271 (Harv. Classics, Eliot ed. 1909).

In the law of copyright only an unmistakable dash of originality need be demonstrated, high standards of uniqueness in creativity are dispensed with. In deciding whether the originality of the matter added in P-1 is sufficient to qualify for protection as a derivative work, the standard enunciated in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951) (Frank, J.), remains the law in this Circuit: "All that is needed to satisfy both

the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.' " *Id.* at 102-03. The originality requirement for a revised version is a "minimal" or "modest" one. *See, e.g., Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 35 (1982); *Durham Indus.*, 630 F.2d at 910; *Puddu v. Buonamici Statuary, Inc.*, 450 F.2d 401, 402 (2d Cir. 1971); *Millworth Converting Corp. v. Slifka*, 276 F.2d 443, 445 (2d Cir. 1960).

The district court here concluded that P-1 and its predecessors had evolved over an extended period of time and that Weissmann's additions were minuscule, demonstrating little originality. 684 F. Supp. at 1261. Although recognizing that the selection and arrangement of data may merit copyright protection, *see Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984), the trial judge believed that "the update was done as part of the evolution of the stock piece" and that appellant's modifications of the preexisting joint works did not warrant copyright protection. 684 F. Supp. at 1261.

It was formerly our rule that where, as here, the originality of a work could be determined entirely by reference to documentary evidence, we were in as good a position as the district court to evaluate originality. *See Eden Toys*, 697 F.2d at 34 n. 6 and 35 (2d Cir. 1982); *Taylor v. Lombard*, 606 F.2d 371, 372 (2d Cir. 1979); *Jack Kahn Music Co. v. Baldwin Piano and Organ Co.*, 604 F.2d 755, 758 (2d Cir. 1979). *But see Apex Oil v. Vanguard Oil & Service Co.*, 760 F.2d 417, 424 (2d Cir. 1985) (Oakes, J. concurring) (suggesting that "appellate courts must not exercise *de novo* review over findings . . . based . . . on documents or objective evidence"). In 1985 Rule 52(a) of Fed.

R. Civ. P. was amended so that findings of fact based upon documentary—along with oral—evidence are not to be set aside unless clearly erroneous.

In our view the district court implausibly overlooked the fact that appellant's 1985 selection of subject matter and content drawn from prior works and their rearrangement in P-1 is sufficiently the product of original authorship to warrant copyright protection. It failed to give detailed consideration to the new matter that Weissmann added to the parties' prior works in her authorship of P-1. Its main discussion of P-1's content is a passing reference to the addition of "only" four new sources from the relevant scientific literature. Although the credibility of the parties as witnesses was fully discussed, the relevance of such an inquiry is problematic when the evidence upon which the derivative work determination must be based is solely documentary. Credibility might have been relevant, for example, had the question of who actually authored the new material been contested. But it is scarcely pertinent to determining whether the newly-added matter satisfies the statutory requirements for protectability. Research has not revealed a single case in which credibility has been deemed significant—let alone dispositive—on the question of whether there is a sufficient level of originality in a given work to render it copyrightable. While the district court's findings based on the credibility of witnesses is entitled to deference, the trial judge cannot insulate his findings on originality from appellate review by calling them credibility determinations. *Anderson v. City of Bessemer*, 470 U.S. 564, 575 (1985).

Our examination of the relevant documents reveals that Weissmann's additions and modifications in P-1 extend well beyond the mere addition of "four sources." A thor-

ough review of P-1 and of the works from which it is derived demonstrates that Dr. Weissmann added the following new elements to the existing prior joint work: (1) a selection and arrangement of photo illustrations and associated captions; (2) references to recent reports in the pertinent literature; (3) selection, condensation, and description of additional source material; (4) several new textual additions; (5) substantial rearrangement of the manner and order of presentation of material contained in the parties' prior joint works; and (6) the addition of a section on "congenital disorders," a revised treatment of "chronic cholecystitis," and the incorporation of Dr. Freeman's "false positive" studies.

The district court found that many of the foregoing additions and revisions repeated verbatim portions of prior works and, from that finding, concluded that P-1 was neither new nor copyrightable. This finding wholly ignores the statutory scheme that expressly protects the selection of subject matter and content from underlying works, as well as the rearrangement of preexisting material taken from those works. *See* 17 U.S.C. § 101 (defining derivative work as an "abridgment, condensation or any other form in which a work may be recast, transformed, or adapted"). Further, a comparison of the parties' prior works—including P-1's most recent predecessor—at once demonstrates numerous differences, and highlights the fact that P-1 gave IDA imaging new and original treatment. Moreover, Dr. Freeman's copying and distributing P-1 as his own work is further evidence of the nontriviality of Dr. Weissmann's work, since copying without regard to a plaintiff's rights is probative on the issue of the originality of a work. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252 (1903) (Holmes, J.) (that

works have worth is sufficiently shown by desire to copy them "without regard to the plaintiff's rights").

We conclude therefore that the district court's holding that Weissmann could not acquire a copyright in a derivative work based upon a jointly authored work was an error of law that disregarded the provisions of § 103(b) and the protection it extends to derivative works. Moreover, Dr. Freeman failed to rebut the *prima facie* showing of copyrightability appellant obtained by her certificate of copyright registration. As a consequence, we hold that Dr. Weissmann's additions and modifications to the preexisting joint work satisfy the modest requirements set forth in § 103(b) and in the relevant case law sufficiently to make P-1 entitled to copyright protection as a derivative work. The district court's findings—upon which it reached a contrary legal conclusion--were clearly erroneous because they have left us, after a thorough review of all the evidence, with a firm conviction that the district court was mistaken. *See United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948).

III *Fair Use*

The next question to be addressed is whether Dr. Freeman's use of P-1 can be characterized as a "fair use" within the meaning of the Copyright Act, thus absolving him of liability as an infringer. Section 107 of the that Act codifies the so-called "fair use" doctrine. It creates a privilege for others to use the copyrighted material in a reasonable manner despite the lack of the owner's consent. *See Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 306 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967). The doctrine balances the exclusive right of copyright owners against "the public's interest in the dissemi-

nation of information affecting areas of universal concern, such as art, science and industry." *Wainwright Securities*, 558 F.2d at 94.

The four statutory factors considered in making the fair use determination are: "(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work." 17 U.S.C. § 107. Congress established these nonexclusive factors as a guide to courts considering fair use. Determining whether the doctrine applies requires that each case be individually examined. *See Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 549 (1985).

Analysis begins not by elevating the statutory guides into inflexible rules, but with a review of the underlying equities. *See Financial Information, Inc. v. Moody's Investors Service, Inc.*, 751 F.2d 501, 508 (2d Cir. 1984) (fair use requires "sensitive balancing of interests," and the statutory factors are not hurdles over which an infringer may leap safely from liability). Thus, in *Sony Corporation of America v. Universal City Studios*, 464 U.S. 417, 448 (1984), the Supreme Court emphasized that the doctrine necessitates an "equitable rule of reason" analysis to determine whether an alleged infringer may shield himself from liability. *See also House Report* at 65 (stating that "since the doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts"). In short, to make use of another's copyright

material fairly presupposes that the actor acted fairly and in good faith. *See Marcus v. Rowley*, 695 F.2d 1171, 1175 (9th Cir. 1983); *see also Roy Export Co. v. Columbia Broadcasting System, Inc.*, 503 F. Supp. 1137, 1146 (S.D.N.Y. 1980) (good faith and fair dealing required), *aff'd*, 672 F.2d 1095 (2d Cir.), *cert. denied*, 459 U.S. 826 (1982).

Hence, before undertaking a discussion of fair use, we consider the equitable considerations that exist in the case at bar. In this case, it cannot be ignored that Dr. Freeman not only neglected to credit appellant for her authorship of P-1, but actually attempted to pass off the work as his own, substituting his name as author in place of hers. Adding insult to this injury, he then distributed copies of her work, but modified the title slightly to one of his own devising. Even if, as Dr. Freeman claims, P-1 was a stock piece to be used by both parties to accompany their lectures, such use hardly justifies entirely appropriating another's work without crediting the author. Dr. Freeman's conduct severely undermines his right to claim the equitable defense of fair use. No case was cited—and we found none—that sustained such defense under circumstances where copying involved total deletion of the original author's name and substitution of the copier's. *See Rowley*, 695 F.2d at 1176 (failure to credit original author weighs against a finding of fair use).

Determining fair use is a mixed question of fact and law. The Supreme Court instructs that where the district court has found facts sufficient to allow evaluation of each of the statutory factors, appellate review may determine fair use as a matter of law. *Harper & Row*, 471 U.S. at 560. With that in mind, we focus on the factors enumerated in § 107.

1. *The Purpose and Character of the Use*

In examining this factor, the district court recognized that " 'the crux of the profit/non-profit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.' " 684 F. Supp. at 1261 (quoting *Harper & Row*, 471 U.S. at 562). The trial judge then concluded that because Dr. Freeman received only a $250 honorarium and did not "stand to profit," the first factor cut in his favor. We think that conclusion misses the point of the above-quoted passage. Monetary gain is not the sole criterion. Dr. Freeman stood to gain recognition among his peers in the profession and authorship credit with his attempted use of Weissmann's article; he did so without paying the usual price that accompanies scientific research and writing, that is to say, by the sweat of his brow. Particularly in an academic setting, profit is ill-measured in dollars. Instead, what is valuable is recognition because it so often influences professional advancement and academic tenure. The absence of a dollars and cents profit does not inevitably lead to a finding of fair use. *See Rowley*, 695 F.2d at 1175.

Further, where, as here, appellee's use is for the same intrinsic purpose as Dr. Weissmann's, that is, as an adjunct to lectures delivered in professional symposia, such use seriously weakens a claimed fair use. *Id.*; *see also Iowa State Research Foundation, Inc. v. American Broadcasting Cos., Inc.*, 621 F.2d 57, 61 (2d Cir. 1980) (suggesting that scope of the doctrine constricted when original and copy serve the same function).

Thus, the relevant evidence bearing upon the first factor does not support invocation of the doctrine. The district

court's contrary conclusion is clearly erroneous. The trial court's statement that Freeman's use was entirely for non-profit purposes misapprehends the central proposition that the profit/non-profit distinction is context specific, not dollar dominated. Although the Supreme Court has observed that the fair use doctrine—particularly the first statutory factor—is not rigidly circumscribed by the so-called "productive use requirement," *Sony Corp.*, 464 U.S. at 455 n.40 (1984), an unproductive use "may be helpful in calibrating the balance." *Id.* Again, Dr Freeman's use of P-1 for the intrinsic purpose for which it was prepared moves the balance of the calibration on the first factor against appellee.

2. *The Nature of the Work*

With respect to the second factor, the district court, again quoting *Harper & Row*, stated that "[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy." 471 U.S. at 563. From that, it found that because P-1 was a scientific work, this factor weighed heavily in appellee's favor. 684 F. Supp. at 1262.

Concededly, the scientific nature of P-1 tilts this factor toward appellee. Yet, the nature of the work is not the only matter considered. The Supreme Court instructs that "[t]he rights conferred by copyright are designed to assure contributors to the store of knowledge a fair return for their labors." *Harper & Row*, 471 U.S. at 546; *see also Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). In *Mazer v. Stein*, 347 U.S. 201, 219 (1954) the Court explained that by establishing a right to the use of one's expression—whether in the nature of fiction or

fact—copyright provides the economic incentive to research and disseminate ideas.

Encouraging authors to use their talents by holding out a promise of reward for their efforts is the surest way to advance the public welfare. *Id.* at 219. In this case it is necessary to keep in mind the danger that allowing wholesale appropriation of scientific works presents. The personal gain sought by Dr. Weissmann may not be directly related to immediate financial gain, but the copyright protection extended to her work nevertheless provides her with an incentive to continue research—an endeavor that, if successful, would and has led to professional and monetary benefits. Hence, while recognizing that fair use finds greater application in a factual scientific context, that recognition should not blind a court to the need to uphold those incentives necessary to the creation of works such as P-1. The district court's failure to consider incentives when weighing this factor was an error of law that led to its clearly erroneous finding regarding the "nature of the work" factor. Here, the incentive interests, in our view, balance the equitable scales so that the nature of the work factor does not tip decidedly in favor of either party.

3. *The Amount and Substantiality of the Use*

Pursuant to the third factor, "whatever the use, generally it may not constitute a fair use if the entire work is reproduced." 3 Nimmer § 13.05[A], at 13-80. On this point the district court concluded—consistent with its finding that P-1 was not a copyrightable derivative work—that Dr. Freeman's copying of Dr. Weissmann's "slight additions" to the underlying joint work reduced the copying to a "*de minimis*" violation. We disagree.

We have previously held that the fair use privilege is grounded upon reasonableness, which may not be found in cases where there has been extensive verbatim copying or paraphrasing of another's material. *See Rosemont Enterprises*, 366 F.2d at 310. The subject work was impermissibly photocopied word-for-word with the only changes being the modification of the title and the substitution of credit for authorship; such use is patently not reasonable and the trial court's finding that it was *de minimis* is clearly erroneous.

4. *The Effect on the Market for or Value of the Work*

The fourth factor is the most important one in determining fair use. With respect to it, the district court held that Freeman's use of P-1 would not impair its market value, and stated that "dissemination of the results of the research being done at Montefiore would in all likelihood only increase the 'marketability' of a paper emanating from that department." 684 F. Supp. at 1262. Although it is self-evident that publication may increase marketability of departmental papers generally, we disagree with the district court's conclusion that this factor weighed in favor of Dr. Freeman. Dissemination in appellant's name, or in the names of both parties, would have had exactly the same effect in the market.

The Senate Report on the § 107 codification of the fair use doctrine states that "[w]ith certain special exceptions . . . a use that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement." S. Rep. No. 473, 94th Cong., 1st Sess. 65 (1975). In our view, the particular market at issue here—namely, the world of scientific research and publication—functions in such a way as to encourage the creation and

dissemination of papers such as P-1. *See Harper & Row*, 471 U.S. at 566 n.9. Because a copyright is used as a stimulant to creative effort, *see Sony Corp.*, 464 U.S. at 450-51, it undercuts the congressional copyright scheme to rule in a manner destructive of this creativity.

The rewards that Congress planned for copyright holders of scientific works to reap arguably include promotion and advancement in academia, where tenure decisions are often based on a "publish or perish" approach. In scholarly circles such as, for example, the small community of nuclear medicine specialists involved in this suit, recognition of one's scientific achievements is a vital part of one's professional life. The fact that Dr. Freeman's planned use of P-1 was for the same intrinsic purpose as that intended by Dr. Weissmann not only undermines Dr. Weissmann's ability to enjoy the fruits of her labor, but also creates a distinct disincentive for her to continue to research and publish in the field of nuclear medicine. Hence, to rule that this was a fair use would tend to disrupt the market for works of scientific research without conferring a commensurate public benefit. The district court's error on this fourth factor was in focusing on sales or dollars received, rather than upon the realities of promotion and tenure in an academic setting.

As earlier noted, the fair use doctrine is a flexible one that must be viewed in light of the particular circumstances of each case. When all of the statutory factors are considered in the context of scholarly scientific research and publication, they weigh against Dr. Freeman's right to invoke the fair use defense in Dr. Weissmann's infringement suit against him.

IV *Denial of 15(b) and 60(b) Motions*

Dr. Weissmann also appeals the denial of her post trial motions under Fed. R. Civ. P. 15(b) and 60(b). At the close of the trial, she moved under Rule 15(b) for leave to amend her complaint to conform to the proof and to add certain factual allegations concerning Dr. Freeman's submission of the so-called Taiwan Publication, and to add causes of action for copyright infringement, Lanham Act violations, and common law unfair competition. Essentially, appellant alleged that the trial evidence established that appellee's assertion of joint authorship violated § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1982), and supported her common law claims based on a theory of false designation of origin. *See, e.g., Eden Toys*, 697 F.2d at 37 (incorrect attribution actionable under § 43(a)); *Smith v. Montoro*, 648 F.2d 602, 604-07 (9th Cir. 1981). Judge Pollack denied the motion ruling that it was not timely asserted, insufficiently litigated, and based on unestablished premises.

Weissmann's second motion under Rule 60(b) contained a newly obtained declaration of Professor Chien Chung who served as director of the Taiwan symposium in which an infringing version of P-1 was allegedly published. On the basis of this declaration appellant sought to correct the trial court's supposed factual error in having ruled that the Taiwan Publication has not been proven to be connected with Dr. Freeman. This motion was denied on the grounds that it was not newly discovered evidence and, even if credited, would not alter the result on either the motion to amend or on the merits.

The district court's rulings on both of these motions is reviewable only for an abuse of discretion. *See Grand Light & Supply Co. v. Honeywell, Inc.*, 771 F.2d 672, 680

(2d Cir. 1985); *Altman v. Connally*, 456 F.2d 1114, 1116 (2d Cir. 1972). Because we cannot say on this record that the district court abused its discretion, we affirm its denial of appellant's post-trial motions.

V *Attorney's Fees*

As a cross-appellant, Dr. Freeman argues that the district court erred in denying an award of attorney's fees and sanctions. He also seeks sanctions and attorney's fees in this court arguing that Weissmann's appeal is frivolous. Obviously, we disagree with the latter assertion, and an award of attorney's fees to appellee is inappropriate in light of our holding. Their denial in the district court is also affirmed. *See Roth v. Pritikin*, 787 F.2d 54, 57 (2d Cir. 1986) (award of attorney's fees lies within sound discretion of court); *Diamond v. Am-Law Publishing Corp.*, 745 F.2d 142, 148-49 (2d Cir. 1984) (same).

CONCLUSION

For the reasons stated, we hold that P-1 was an individually-authored, copyrightable, derivative work created by appellant and that Dr. Freeman's use cannot be said to be a fair use of it. Accordingly, we reverse the judgment of the district court and remand the case to it with directions that judgment be entered in favor of appellant Weissmann. The judgment otherwise appealed from is affirmed.

Reversed in part and affirmed in part.

PIERCE, *Circuit Judge*, concurring:

I join in Parts II-V of the court's opinion. I join only in the result in Part I.

As to Part I, I agree that we must reverse and remand because Dr. Freeman failed to rebut appellant's claim (evidenced by her registration of P-1 as a derivative work) that she did *not* intend the new material to be "merged" with the prior joint work. *See generally* 1 M. Nimmer, *Nimmer on Copyright* § 6.03 (1988). Appellant's certificate of registration served as "prima facie evidence of the validity of the copyright and of the facts stated in the certificate." 17 U.S.C. § 410(c) (1982). For Dr. Freeman to claim that his use was not an infringement, but rather that the work was "joint," was a defense much like any other under the Copyright Act. *See* 3 M. Nimmer, *supra*, § 13.04. Therefore, it was incumbent upon Dr. Freeman to rebut appellant's prima facie evidence that the work (P-1) was derivative, not joint. Appellee failed to meet his burden, however, for he failed to present sufficient evidence to demonstrate appellant's intent to create a joint work.

The district court appears to have applied the opposite presumption. Rather than focusing on the appellant's intent at the time of creating the derivative work, the court dwelt primarily on the parties' long-standing and close professional relationship. From that, it seems to have presumed that P-1—a by-product of that professional collaboration—was a "joint" work. That presumption, however, in effect placed the burden on the putative author to show that the work was derivative, rather than on the putative infringer to show that the work was joint. The district court's approach was therefore at odds with

the statutory scheme of burdens of proof, and must be reversed as a matter of law.

I differ, though, with Judge Cardamone's reasoning in Part I. The fact that Dr. Freeman was not the author of any of the new material that went into P-1 did not, of itself, preclude that work from being "joint." Of course, as Judge Cardamone notes, one cannot be found to be a joint author of a work without actually having contributed to that work. *See* 1 M. Nimmer, *supra*, § 6.07. However, that does not mean that an author, to be a "joint" author, must have contributed to each incremental addition to the work. Thus, in this case, had Dr. Weissmann's intent been otherwise—had she intended the work to be joint—Dr. Freeman could have been deemed a joint author simply by virtue of his contributions to the earlier work, into which Dr. Weissmann's material would have been "merged." *See, e.g., Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944); 1 M. Nimmer, *supra*, § 6.03, at 6-7.

Further, I do not agree that the earlier incorporation of Dr. Freeman's "False Positives" study into the evolving syllabus was irrelevant. Though not dispositive, the parties' past willingness to have their works absorbed into the syllabus was relevant to the question of appellant's intent when she reshaped the syllabus into P-1.

On balance, however, I agree with the court that the evidence relied upon by appellee was not sufficient to show that appellant intended to create a joint work. Therefore, I join the conclusion of the court, and would reverse and remand, with judgment to be entered for appellant.

LUMBARD, *Circuit Judge*, dissenting:

I dissent, and vote to affirm the judgment of the district court in all respects, for the reasons stated in Judge Pollack's thorough and reasoned opinion. 684 F. Supp. 1248 (1988).

Appendix B

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

87 Civ. 6069 (MP)

HEIDI S. WEISSMANN, M.D.,

Plaintiff,

—v.—

LEONARD M. FREEMAN, M.D.,

Defendant.

DECISION AND OPINION

APPEARANCES:

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MILTON POLLACK, *Senior United States District Judge*

In an uncommon controversy, the issues presented are whether a medical paper represents joint or individual authorship and whether it may ground an infringement claim under the Copyright Act, 17 U.S.C. § 101, et seq. The action was tried to the Court at a Bench trial.

The parties are both nuclear medicine physicians. The plaintiff, Heidi S. Weissmann, M.D. ("Weissmann") charges infringement by the defendant, Leonard M. Freeman, M.D. ("Freeman"), of a syllabus entitled "Hepatobiliary Imaging"

which she presented at a nuclear medicine refresher course sponsored by the Radiological Society of North America ("RSNA") in 1985. A booklet containing the syllabus compiled the papers submitted by the physicians lecturing at the RSNA course and was copyrighted by RSNA.

Two years later, Freeman planned to utilize a copy of the same syllabus at a nuclear medicine review course ("the review course"), where he was to be the lecturer at a seminar scheduled for August 24-27, 1987, at the Mount Sinai School of Medicine ("Mount Sinai"). Only two changes were made in the syllabus: 1) plaintiff's name, which appeared at the upper right corner of alternate pages in the 1985 syllabus, was deleted from the Mount Sinai 1987 review course syllabus and replaced with defendant's name; and 2) the title "Hepatobiliary Imaging" used on the earlier syllabus, was changed in the 1987 syllabus to "Gastrointestinal Nuclear Medicine Hepatobiliary Imaging".[1]

Prior to the date for the Mount Sinai review course, plaintiff obtained a copy of the syllabus which was to be handed out to the attendees. On August 19, 1987, she inquired from RSNA whether it had given permission for the use described above. The RSNA told plaintiff that no permission had been sought by anyone for such use.

Plaintiff thereupon requested the director of the review course not to circulate the syllabus and to inform all recipients that she claimed sole authorship thereof. The administrator at Mount Sinai was similarly advised. It was quickly decided that the material would be removed from all copies of the review course handouts and the nine copies already distributed to employees were retrieved. Freeman had no objection to the removal of the disputed material from the lecture hand-outs and went on with the review course lecture without it.

Nonetheless, on the next day, August 20, 1987, this suit was filed, alleging copyright infringement in violation of 17 U.S.C. § 501 and seeking a preliminary injunction. In her prayer for

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1 This work describes a technique involving the injection of radioactive isotopes into the blood, their uptake in the liver and their subsequent secretion in the bile. The areas outlined by the injected substance are then photographed to permit the diagnosis of liver and biliary disorders.

relief, plaintiff sought: a declaration that Freeman had committed actionable infringement; an order permanently restraining him from infringement; an award of actual damages and profits; and full costs and attorneys' fees.

Plaintiff then amended the complaint to seek, in addition to declaratory and injunctive relief, damages only with respect to defendant's economic gain from the alleged infringement and statutory costs and attorney's fees. The claim for attorneys' fees was dismissed at the close of plaintiff's case, with plaintiff's consent, because the copyright was not registered before this suit was commenced and registration is a statutory prerequisite to such a claim. 17 U.S.C. § 412.[2] Jurisdiction herein is based upon 28 U.S.C. § 1338(a) and 17 U.S.C. § 501(b).

Several months after inception of this suit, plaintiff obtained a registration of a copyright in her name covering the same syllabus she had used in 1985 at RSNA. The registration was issued to her on November 9, 1987 and states her contention to the Register of Copyrights that the copyrightable material in the syllabus consists of "amplification, revision and reorganization of pre-existing material; review and update of relevant literature to add new references; substantial new textual material and compilation of photographs." Plaintiff relies on the registra-

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2 Copyright registration is a prerequisite to the filing of an infringement suit. 17 U.S.C. § 411. Plaintiff herein commenced this action by filing a complaint on August 20, 1987. Plaintiff's copyright registration is dated November 9, 1987; thus, she was technically not entitled to have instituted this action at the time. Plaintiff amended the complaint nunc pro tunc, however, to allege registration of the copyright. The parties agreed to the amendment of the complaint by stipulation dated March 8, 1988. Plaintiff was thus entitled to maintain this action. *See Conan Properties, Inc. v. Mattel, Inc.*, 601 F. Supp. 1179, 1182 (S.D.N.Y. 1984) (a defect "can be cured simply by filing a second amended complaint, which relates back to the commencement of the action, and which includes a recitation that the registration requirement has been satisfied"); *Frankel v. Stein and Day, Inc.*, 470 F. Supp. 209, 212-13 n.2 (S.D.N.Y. 1979) (permitting amendment of the complaint, especially in light of the fact that the defendant did not object to this), *aff'd*, 646 F.2d 560 (2d Cir. 1980); *Eden Toys, Inc. v. Florelee Undergarment Co.* 697 F.2d 27, 33 (2d Cir. 1982) (permitting amendment of the complaint even though plaintiff apparently did not register the copyright until after defendant's alleged infringement).

tion issued to her as well as the registration of the RSNA booklet.

Defendant denied liability for infringement and asserts that the syllabus was the product of lengthy collaborative research and joint authorship, largely copied verbatim from earlier papers created either solely by him or in whole or in part in his role as principal investigator, collaborator, writer and chief of the nuclear medicine department in which plaintiff was employed; that he was entitled to use the paper as stemming from his own contribution to the syllabus, for lecture, teaching and study purposes; that it was a fair use; and that the content was in the public domain. Further, in his Answer, defendant seeks 1) a declaration that he and plaintiff are joint authors of the allegedly infringed work, 2) a dismissal of the amended complaint and 3) costs and a reasonable attorney's fee.

I. *Background*

To place the dispute in focus, it is necessary to consider: the origin and development of the syllabus in light of the parties' relationship, the stature of the defendant in the medical profession and in the field of nuclear medicine in particular, the development of the plaintiff's career in the field under defendant's supervision, guidance and control as defendant's junior associate, and the parties' use of radioactive substances on humans in imaging of the gall bladder and liver under authorizations issued to defendant alone.

From the inception of the parties' professional association in 1977 to plaintiff's termination in 1987, defendant was the Chief of the Division of Nuclear Medicine at Montefiore Medical Center ("Montefiore") and plaintiff, starting as a fourth-year radiology resident under defendant, was the developing junior member of the association. Their work was laid down in papers, syllabi and articles, in evolutionary stages, jointly conceived and executed. Each had a hand in propelling that evolution. To a large extent it was plaintiff's part of the joint enterprise to write down the results of their activity, with defendant always on top of what was in progress, by actually supervising the investigations, writing portions of papers, reviewing

drafts, commenting on the scripts and lending credibility thereto and to the project by his standing, reputation, knowledge, perception, and experience.

The item presently under consideration ultimately evolved in that manner. The writing at issue here was no more than a stock piece of what the parties had already worked up, nothing new or newly communicated, merely freshened up to take in evolutionary detail on what had already been compiled; it did not report any new studies.

In those circumstances, in August 1987, when invited to speak at a review course at Mount Sinai, the defendant felt comfortable in planning to hand out the syllabus at the course. He placed his name on the hand-out rather than plaintiff's, since she was not scheduled to give any part of the review lecture on that occasion. Plaintiff's sensitivity to this conduct, which to her was a seeming by-pass of her participation in the work, galvanized this suit, with its highly emotional overtones and accusatory concepts. Suffice it to say the piece was not used by the defendant and he delivered the lecture without a syllabus hand-out.

II. *In More Detail*

A. *The Parties*

1. The Defendant—Freeman

In the order of seniority, we discuss the defendant first—the Chief of the Department of Nuclear Medicine at Montefiore. Freeman is Board Certified in Radiology, Nuclear Medicine and Diagnostic Radiology, with special competence in Nuclear Radiology. He is a professor of Radiology and of Nuclear Medicine at the Albert Einstein College of Medicine ("Einstein"), where he has held faculty appointments since July 1964, is an attending physician in Radiology and Nuclear Medicine at Montefiore and also serves as Director of the Nuclear Medicine Service at Montefiore and Vice-Chairman of the Department of Nuclear Medicine at Einstein.

Freeman was President of the Society of Nuclear Medicine in 1979-80, President-Elect of the Society in 1978-79 and its Vice-

President in 1977-78. He holds editorships in specialty publications: co-editor of "The Seminars in Nuclear Medicine," now in its 18th volume; co-editor of "Nuclear Medicine Annual"; co-editorial consultant of the *Physicians' Desk Reference for Radiology and Nuclear Medicine*; medical editor of "Current Concepts in Diagnostic Nuclear Medicine"; and editor of a textbook called *Freeman and Johnson's Radionuclide Imaging*. Freeman is well-published in diverse areas of nuclear imaging, including hepatic (liver), renal (kidney), and bone imaging, especially using Rose-Bengal, the forerunner of the radioactive material referred to as the IDA compounds. It is evident from Freeman's curriculum vitae and list of major presentations that Freeman is a prolific author on a broad range of organ systems susceptible of diagnosis by radionuclide imaging, a much sought-after speaker at national and international meetings and before professional societies and medical institutions and an esteemed physician and researcher in the field of nuclear medicine and radiology.

2. The Plaintiff—Weissmann

Plaintiff is a graduate of Mount Sinai School of Medicine and licensed to practice medicine in the State of New York. At the time plaintiff commenced this action, she held appointments as an associate professor of Nuclear Medicine and Radiology at Einstein and as an attending physician employed by Montefiore.

Weissmann began her professional association with the defendant in the fourth year of her residency in radiology at Montefiore in July 1977. Weissmann spent the following year at New York Hospital-Cornell Medical Center for a fellowship in ultrasound and in July 1979 returned to Montefiore as an adjunct attending physician and to Einstein as an instructor in Radiology. Although Weissmann's specialties are Nuclear Medicine and Radiology, she is not Board Certified in either. She has taken only the written portion of the certification examination.

In 1979, Weissmann received the President's Award of the American Roentgen Ray Society for a paper of which she was

the first-named of four authors. Weissmann was honored in 1980 as a recipient of the Distinguished Alumnus Award of the Mount Sinai School of Medicine. In 1982, she received the Tetelman Award of the Society of Nuclear Medicine, awarded annually to an outstanding investigator in the field of nuclear medicine under thirty-five years of age. Her curriculum vitae lists as published, or in press, 34 journal articles, 33 abstracts, and nine book chapters, of which Weissmann is author or co-author. Virtually all of her published works relate to radionuclide imaging of the biliary tract. Weissmann has been enthusiastically received at numerous meetings where she lectured on the subject and her expertise has been recognized.

B. *The Radiopharmaceutical "IDA"*

From 1966 to 1973, Freeman published in the areas of hepatobiliary problems. In the latter part of 1976 and early 1977, he became involved with the application of derivatives of a radionuclide, iminodiacetic acid ("IDA"), a substance labelled with the isotope technetium and injected into the blood so that it can be picked up by the liver and simulate the flow of bile, allowing diagnosis of liver and biliary disorders. Merck-Frosst, the Canadian manufacturer of an IDA analog known as HIDA, was interested in obtaining American investigators with the appropriate tools, laboratories and reputations in order to develop a patient data base to support the company's application for approval from the Food and Drug Administration ("FDA") to distribute the pharmaceutical in the United States. The company acquired an investigational new drug ("IND") authorization from the FDA and contracted with five physicians, of which Freeman was one, to conduct studies using this new substance. That was the project on which plaintiff served under defendant for several years since 1977. In the past three to four years, scientists have almost exhausted their investigations of this agent, and most researchers who have been involved in this area have moved to other areas of interest.

In addition to the required authorization (IND) from the FDA, very specific approval to perform studies with this agent had to be obtained from two committees at Montefiore: (i) the Institutional Review Board and (ii) the Committee for Human Isotope Usage, which dealt with the administration of radioactive material to human beings.

The principal investigator identified and authorized by the FDA and the Montefiore committees with regard to the IDA agent was Freeman. Because of the FDA and Montefiore approvals granted in his name, Freeman was an essential element in all IDA work done at Montefiore, at least until 1982 when one agent was licensed by the FDA for use other than on an experimental basis. The FDA authorized Freeman's use of the IDA analog initially under the Merck-Frosst IND authorization and thereafter under his own IND. Freeman was subsequently authorized by the FDA to use other IDA derivatives, including agents manufactured by New England Nuclear Corporation and Squibb.

Later, Weissmann was authorized to use one particular IDA analog, that manufactured by Amersham Corporation. However, even that analog was used under the Montefiore approvals given to Freeman.

In addition, Montefiore approved an informed consent form, to be signed by patients before being subject to IDA use; the form ran in favor of "Dr. L. Freeman and associates."

Freeman's role as principal investigator with respect to the IDA analogs meant, in Weissmann's own words, that the "buck stops" with Freeman. Articles jointly published in both Freeman's and Weissmann's names based on 90- and 323-patient studies included patients whose case histories were reported back to the pharmaceutical houses with respect to whose IDA agents Freeman was the principal investigator.

The investigations using IDA derivatives at Montefiore were initiated due to Freeman's reputation in the field of nuclear imaging. He possessed the IND authorizations and the Montefiore approvals to administer the drug, and the patients, who signed informed consent forms bearing Freeman's name, were referred to the department over which he presided and for which he was ultimately responsible.

C. *The Evolution of Plaintiff's Exhibit 1 ("P-1")*

The parties began collaborating on and pursuing a common design of investigating the use of IDA derivatives while Weissmann was a fourth-year resident. They published their first jointly authored article concerning IDA scanning, or scintigraphy, in January 1979. A series of journal articles followed over the next several years on the use of IDA scanning in diagnosing biliary diseases, published in the names of Weissmann, Freeman and other investigators.

The allegedly infringed syllabus ("P-1") originated as a result of this collaboration between the plaintiff and the defendant. The work in which plaintiff claims a copyright is a syllabus—a review paper providing an overview of the potential and of the current state of the art of specific research being done in the particular field, in this case hepatobiliary imaging techniques. Syllabi are papers that accompany lectures and are distributed to attendees of refresher courses and other educational meetings. Medical residents, for example, use such review course syllabi to study for specialty boards. As opposed to journal articles, a syllabus usually does not report original research.

Beginning in about April 1980, Freeman and Weissmann together prepared a syllabus to submit to the sponsors of refresher courses at various medical centers.

Plaintiff testified, in substance, that from the very beginning when she started as a resident, Dr. Freeman had made it clear to her that there are different kinds of articles that "we" write; as to journal articles, for example, plaintiff said that it was clear Freeman expected his name to be added to them when done and submitted by any physician in his division. Plaintiff acquiesced in that procedure; she testified that "he was responsible for what I was saying, but I really was doing the primary research."

Weissmann and Freeman spent their professional association in offices in close proximity to each other, with frequent consultations between them throughout the day. She "would get input from him as to his opinions and directions, based on his experience. Mentioning his name lent authority" to what the plaintiff was doing. Plaintiff did all of her writing pertinent to this lawsuit while she was affiliated with Montefiore in defendant's

department. Of the writings that are reported in her curriculum vitae, and those that are not, plaintiff did almost all of the writing, but she submitted drafts to Dr. Freeman before publication. She would always make sure to leave a copy of a manuscript on his desk if he was not in town or busy with other commitments; she did not always get the articles back, but often she did. Taking the list of articles on her curriculum vitae, plaintiff testified that Dr. Freeman was co-author on not all but most of the articles.

The plaintiff admitted that her activity with Freeman involving IDA biliary imaging agents was collaborative on some occasions. It was pointed out to her that in her vitae, 30 of the 34 journal articles appear in the names of Freeman and Weissman, either together or with others, 32 of the 33 abstracts bear her name and Freeman's, either together or with others, and 5 of the 9 book chapters identify Weissman and Freeman as co-authors together or with others. Plaintiff admitted that there was no peer-reviewed paper or abstract of which the plaintiff was the author or co-author that is not listed in her vitae. Significantly, there is no review course syllabus listed in her vitae.

P-1 is a 1985 update of a continually evolving stock piece of a syllabus used by the parties and continuously styled in the same general format to accompany many of their review course lectures commencing in April 1980; as indicated previously, exhibit P-1 did not report anything of substance that was new in the field.

The stock piece was first prepared for use at a forthcoming April 1980 nuclear medicine review course sponsored by Harvard Medical School. Freeman testified that it was he who was invited to lecture on hepatobiliary imaging at this review course, and he secured an invitation for Weissmann to participate with him. Although Weissmann initially claimed to have had a direct invitation to lecture at Harvard in 1980, Weissmann later conceded that she might have been invited to participate as lecturer through Freeman and could not really remember. Freeman's testimony gives the more believable version. Weissmann and Freeman jointly prepared the syllabus to be handed out at the 1980 Harvard course. Attached as the first annex to the Harvard 1980 course syllabus is a 1979 paper in

which Freeman's input was an integral part. Weissmann relied quite heavily upon Freeman to put a manuscript together and teach her how to construct a paper compiling the data that had been gathered.

A few weeks prior to the lecture at the Harvard 1980 review course, a nuclear medicine review course was conducted at Einstein at which Weissmann lectured and for which plaintiff submitted a syllabus by-lined in her name alone. Freeman credibly testified that Weissmann did not have a syllabus ready for submission to that Einstein course as the submission deadline approached, so Freeman suggested that she look at the syllabus they together had already prepared for the Harvard course, which had an earlier submission deadline, and make minor revisions to it. The Einstein 1980 review course paper was actually prepared after the paper for the Harvard 1980 review course.

The Einstein 1980 paper is virtually identical with the Harvard 1980 paper of which Freeman was a co-author; there are minor changes in word order and two or three additional sentences in the Einstein syllabus. Freeman was co-author of the Einstein 1980 paper as well. Freeman was a co-director of the Einstein 1980 review course and Weissmann necessarily acted under Freeman's aegis when she submitted the paper there under her name alone. This is some indication of a practice that, rather than designating the authorship, the by-line name appearing on such review course material was utilized as an identification of the reviewer or lecturer who was to appear before the audience.

The standard piece continued to be used by the parties as review course syllabi in succeeding years. Not all subsequent versions of the paper were received in evidence, but the Court did receive the paper as submitted for the following nuclear medicine review courses: Harvard 1982, Einstein 1983, Harvard 1984 and Mount Sinai 1984. There are minor variations in the syllabi preceding the 1984 papers. The Harvard 1982 syllabus uses figures, which appear in the Einstein 1983 syllabus also. The main thrust of the Harvard 1984 syllabus, which is by-lined with Freeman's name alone, is a new section on so-called "false positive" studies composed by Freeman alone. That paper omits several other sections previously used and appears to be a

somewhat abbreviated hand-out. The Mount Sinai 1984 syllabus, which lists Weissmann in the byline, contains all sections used in prior versions of the paper including the new false positive section but omits figures. The latter two syllabi are in a slightly different format than their predecessors.

Substantial portions of P-1 were taken verbatim from prior review course syllabi and other jointly authored works of the parties. The Einstein 1983 and Mount Sinai 1984 review course papers are copied virtually verbatim almost in their entirety in P-1. The "Chronic Cholecystitis" and "Cholestasis" sections of P-1 are in fact taken virtually verbatim from both the Harvard 1980 paper and the parties' jointly authored chapter in a book edited by one, Serafini. Neither of the parties felt it necessary to obtain permission for such use from the publisher-copyright holder of the Serafini book before submitting the educational paper P-1 to the RSNA.

In describing the recommended technique of administering the radiopharmaceutical, P-1 expressly attributes the recommendation to "we," *i.e.*, clearly a reference to Weissman and to her collaborator. Weissman was not alone in creating this work or its predecessors, but received the active participation of her mentor and colleague in what was a collaborative effort to research and report the state of the art in hepatobiliary imaging.

D. *Joint Authorship*

The parties had agreed, at least impliedly if not overtly, that the stock piece could be used as a handout by either of them, in their individual or joint names, to accompany the teaching review course lecture in which the individual was the assigned lecturer.

Weissman and Freeman unquestionably were collaborators in their investigation of the various IDA analogs they used at Montefiore and joint authors of the syllabi and of many of their journal articles, abstracts and book chapters concerning hepatobiliary scintigraphy using technetium-labelled IDA analogs.

Freeman's participation is strikingly illustrated by inclusion in P-1 of the section entitled "False-Positive Studies for Acute Cholecystitis," which unquestionably he composed. His

authorship thereof was unequivocally established at the trial. In May 1983, Freeman had been invited to speak at Harvard's review course to be held the following year. Several articles had begun to appear in the literature criticizing the use of IDA imaging procedures and reporting "false positive" results in studies using these procedures. A "false positive" occurs when a test result indicates that a patient has a particular condition (acute cholecystitis) but is later found in fact not to have that condition. In accepting the invitation to speak at Harvard in 1984, Freeman told the sponsors of the course that he would address the issue of IDA scanning, its interrelationship with other imaging procedures and the reported false positive results.

Freeman had already planned to address that topic of reported false positives, or hepatobiliary "pitfalls," at a presentation to be given in October 1983 at Case Western Research School of Medicine to the Cleveland Radiological Society. Freeman wrote his choice of a lecture topic in a letter dated February 24, 1983 to a Dr. LiPuma at Case Western. Freeman prepared a set of "false positive" slides, representing the most current state of hepatobiliary scintigraphy, as an accompaniment to the Cleveland lecture, to be given in October 1983. He further testified that he kept two copies of those slides and gave one copy to Weissmann for her use.

Freeman had a long-standing interest in false positive studies, illustrated by his February 24, 1983 letter referring to "pitfalls" and his letter to a Dr. Berk dated September 6, 1983 on that very subject. The compelling proof of his having prepared the "false positive" slides was buttressed by his use of them on October 18, 1983 at the New York Hilton, even before the Cleveland lecture, portrayed in a videotaped debate with Dr. Laing, produced in evidence as Defendant's Exhibit 48. A review of the videotape of Freeman's performance at the Freeman/Laing debate substantiates even further a finding that it was Freeman who was actively involved in the creation of these slides.

Subsequently, with Freeman's lecture at the 1984 Harvard review course approaching, Freeman authored as an accompaniment to his appearance a submission for the course which dis-

cussed the reported false positive IDA studies, incorporating material from the slides he had used in Cleveland. Freeman individually was the author of the "false positive" matter contained in the Harvard 1984 syllabus, which was submitted with Freeman's name alone for his lecture there.

Weissmann also spoke on the subject of reported false positives, using slides; however, the earliest such occasion was in November 1983, subsequent to Freeman's lecture in Cleveland. Weissmann had no response to the graphic evidence in defendant's Exhibit 48 and failed to contradict with credible evidence the conclusive proof in favor of defendant's claim of authorship of the slides used and of the lengthy section in P-1 of the false positive discussion.

Indicating the mutual use of the collaborative efforts, Weissmann lectured at the Mount Sinai nuclear medicine review course in 1984, and in connection with the lecture she submitted a hand-out entitled "Hepatobiliary Imaging." Although this paper by-lined only her own name, it incorporated Freeman's "false positive" section verbatim from the Harvard 1984 paper as well as all of the other sections created earlier by the collaborative effort and used in the syllabi for prior review courses.

E. *New Matter*

Plaintiff contends that the questioned article contains new matter and non-trivial originality; that it has variations which are sufficient to render it meaningfully distinguishable from the prior forms of the work from which it was drawn. It is not the proper function of this Court to consider whether the alleged new work is a qualitative improvement over the prior work in determining the scope of copyright protection. 1 *Nimmer* on Copyright § 3.03 at 3-10 [hereinafter "Nimmer"]. "It would be a dangerous undertaking" for the Court to constitute itself the final judge of the "worth" of the work. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). The Court addresses originality, not novelty. *L. Batlin & Son v. Snyder*, 536 F.2d 486, 490 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976). However, the Court was provided with the best qualified expert opinion on the appearance or absence of new matter and of

non-trivial originality, that of the defendant, the acknowledged outstanding expert in the field. The plaintiff merely echoed legal language found in the reported cases in asserting that she had presented some new and additional expression in P-1. P-1 was portrayed by the plaintiff as the product of a month's effort and the review of more than 100 works in the literature. However, only four new references were added: two citing the illustrations reproduced with permission, both of which were originally prepared by Freeman, one citing to a work jointly authored by the parties, and one citing to a work that reported a procedure disfavored by the parties.

The defendant testified that there was nothing new expressed. Only trivial variations were stated in P-1, adding nothing, and the paper was only the old stock piece updated. Certainly there was nothing sufficiently substantial in its originality to merit protection under the Copyright Act. Significantly, by 1985, interest in IDA had already peaked: "most of everything that has had to be done with this agent has become established and most investigators who have been involved in this area have moved on to other areas." P-1 was just the "most recent version of the piece that Dr. Weissmann and [Dr. Freeman] had been using since 1980 with various minor revisions and update and cutting and pasting that had been done in its use over a seven-year period."

No corroboration from any independent qualified source was supplied by the plaintiff for her contrary assertions. After defendant's convincing rebuttal of the presumption of originality of the allegedly infringed work, the plaintiff then had the burden of going forward on the issue; that she failed to do. The matter was not self-proving.

F. *Mount Sinai 1987*

Weissmann was on sabbatical leave from her employment at Montefiore in 1987. Freeman was invited in that year to lecture at a review or teaching course at Mount Sinai. Freeman instructed his secretary to prepare P-1 for use in the 1987 Mount Sinai review course, to place his name on the handout syllabus in place of Weissman's name used on the 1985 RSNA

handout and expand the title by adding three words. Freeman justified this "copying" with the belief that he was using the jointly prepared stock piece for a syllabus handout at an educational review course lecture which he alone was scheduled to give.

Fifty copies of the 1987 review course syllabus were run off; nine copies were distributed to Mount Sinai staff physicians; all of these were retrieved and not used. Plaintiff, learning of the lecture and of the proposed handout, protested the omission of her name through counsel. Plainly, to raise a legal question of that kind at the last moment before the lecture was necessarily to disrupt the arrangements for the lecture. To avoid controversy with plaintiff at that moment, Freeman promptly directed the withdrawal of the proposed syllabus and proceeded to lecture without a syllabus handout. The only extant copy of the course booklet containing the form in which Weissmann's name was omitted was the copy that came into the possession of Weissmann.

G. *Credibility*

On the many issues to be resolved in determining this action, the testimony of the parties was squarely in contradiction. These issues include: the extent to which Freeman had participated in the investigation of IDA as a diagnostic tool; the extent to which Freeman had participated in the preparation of papers and other works published in the names of both parties, as coauthors, on the subject of hepatobiliary imaging; the preparation and content of the various review course syllabi and the modifications from time to time thereof as well as the repetition of the content prior to Weissmann's submission of the paper allegedly infringed; whether Freeman's name appeared on these numerous prior publications because he, as Weissmann's "chief" and mentor, had requested that he be listed as an author even though he had not contributed to the work, or, because he had in fact collaborated as an author; and whether Weissmann had ever previously exacted from Freeman any conditions upon his use of "her" work. These and other controverted matters were raised and considered.

Shortly before the end of the trial the Court asked the plaintiff directly whether she claimed that defendant had any participation at all in the content of the syllabus. The colloquy was as follows:

Q: Is there anything recited in plaintiff's Exhibit 1 which were the words and work of Dr. Freeman on a prior occasion?
A: None at all. This is my words, my work, my expression. Dr. Freeman had no participation in it.
Q: Are there sections, paragraphs, sentences in there, which were the words and work of Freeman on a prior occasion?
A: Not a single word.

The physical evidence and the credible testimonial proof were all to the contrary of those flat denials.

The Court had the opportunity, during the four days of trial, to consider the proofs and observe the demeanor of the parties as witnesses. Based upon the parties' testimony and demeanor, illumined by the documentary evidence and the testimony of non-party witnesses, the Court resolves the issues of credibility in favor of defendant, and against the plaintiff. At the point of the trial when the slides dealing with the false positive issue were demonstrated, the Court was expressly constrained to find on the record after the physical demonstration made of the slides on a projector that the only credible explanation of authorship was that of Freeman. This necessarily stamped as Freeman's the type-script from which the slides shown in Cleveland and at the Hilton Hotel were made and which furnished the text in the Harvard 1984 syllabus and eventually Exhibit P-1.

The Court finds, based upon all of the facts and circumstances in evidence, that there was no violative use of Exhibit P-1 by the defendant.

During the course of Weissmann's direct examination, the Court overruled a defense objection with a statement of its desire to find out why this controversy had come to court. Judging by the hostility evident in Weissmann's demeanor and testimony, the answer appears to be that this action was

brought for personal reasons—be they grievances against Freeman himself or against Montefiore, for reappointing her on a probationary basis and then failing to rehire her at all—that go beyond and are outside of a claim of copyright infringement.

The defendant had recognized the outstanding abilities of his student and junior associate and had created every opportunity possible to promote Dr. Weissmann professionally, enabling her to advance her career significantly in a relatively short period of time.

There is no question as to plaintiff's stature, ability or reputation as a remarkable researcher and specialist in the area of hepatobiliary imaging. But, in short, it was the defendant who opened the doors for Dr. Weissmann, making all of her research and writing possible and professionally recognized. The defendant was the one who had acquired the radiopharmaceutical from the manufacturer as a result of his renown in the medical community and his interest in staying on the cutting edge of medical technology. Even when the plaintiff was able to obtain a radiopharmaceutical in her own name, the defendant was ultimately responsible for the use of the drugs, as the person with whom "the buck stops." The plaintiff obtained and made use of the drug only as a result of her association and collaboration with the defendant. The plaintiff admitted that even after she became an instructor, the defendant had ultimate responsibility for the research activities taking place in his department.

It is unfortunate that two such accomplished scientists could not preserve their esteemed positions by resolving their differences in another forum.

III. *The Applicable Law*

A. *Prima Facie Case*

Introduction into evidence of a certificate of registration from the Copyright Office is prima facie proof of ownership. 17 U.S.C. § 410(c); *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980). Valid copyright protection subsists only in *original* works of authorship. 17 U.S.C. § 102(a); *Durham Indus.*, 630 F.2d at 908-09. A certificate of registration thus

constitutes prima facie evidence of the author's originality. 3 Nimmer § 12.11[A] at12-78.

The presumption of the registration's validity is a rebuttabie one, and the burden shifts to the defendant to disprove vaiidity. *Hasbro Bradley, Inc. v. Sparkle Toys, Inc.*, 780 F.2d 189, 192 (2d Cir. 1985); 3 Nimmer § 12.11[A] at 12-80. Once the plaintiff presents a certificate of registration, he or she is relieved of proving "the multitude of facts" upon which issuance of the copyright is based, "unless the defendant, by effectively challenging them, shifts the burden of doing so to the plaintiff." *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985) (quoting H.R. Rep. No. 1476, 94th Cong., 2d Sess. at 157, *reprinted in* 1976 U.S. Code Cong. & Admin. News 5659, 5773). Judicial deference is given to the expertise of the Copyright Office—the agency charged with administering the copyright laws—unless "the Copyright Office had no opportunity to pass on plaintiff's claim accurately presented." *Russ Berrie & Co. v. Jerry Elsner Co.*, 482 F. Supp. 980, 988 (S.D.N.Y. 1980). Plainly, there was nothing before the Copyright Office when plaintiff submitted her application for registration of P-1 to enable it to pass accurately on plaintiff's claim.

B. *Joint Authorship*

Section 201(a) of Title 17 U.S.C. provides: "Copyright in a work protected under [the Copyright Act] vests initially in the author or coauthors of the work." The product of joint authorship is a "joint work," in which "each contributor automatically acquires an undivided ownership in the entire work, including all of the contributions contained therein." 1 Nimmer 6.06[A] at 6-14. Even if the respective contributions to the joint work are not equal, each joint author shares equally in the ownership of the work in the absence of an agreement to the contrary. *Id.* § 6.08 at 6-20.

A joint work is one "prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." 17 U.S.C. § 101. The essence of a joint work is "a joint laboring in fur-

therance of a preconcerted common design." 1 Nimmer on Copyright § 6.03 at 6-6; *see also Picture Music, Inc. v. Bourne, Inc.*, 314 F. Supp. 640, 645 (S.D.N.Y. 1970) (Pollack, J.) ("When two or more authors pursuing a common design together create a single work, they become joint owners of the work . . . ."), *aff'd on other grounds*, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997 (1972).

As stated in *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429 (S.D.N.Y. 1974):

> Although traditionally creation of a joint work required a common design which existed before the elements of the work were produced, that requirement has been considerably eroded. Nimmer on Copyright § 69. In [*Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266 (2d Cir. 1944)], the Court of Appeals for this Circuit held that a joint work can result from the labors of persons who are strangers to each other and who work at different times, if each contributor contemplates that his work will form part of a whole to which someone else will also contribute. Subsequently, the preconcerted design standard for joint authorship was further relaxed in Shapiro, Bernstein & Co., Inc. v. Jerry Vogel Music Co., Inc. ("*12th Street Rag*"), 221 F.2d 569, modified on rehearing, 223 F.2d 252 (2d Cir. 1955). *12th Street Rag* held that, even if at the time one element of a joint work is created no intent to contribute to a joint work exists, if at any time thereafter the author or his assignee conceives and carries out such an intention, the resulting combination will be joint work.

374 F. Supp. at 430. The continued validity of the *12th Street Rag* doctrine is unclear, and the current Copyright Act, which defines joint ownership, has been said to reject the *12th Street Rag* doctrine. *See* 1 Nimmer § 6.03 at 6-8-9.

The respective contributions of several authors to a single work need not be equal either quantitatively or qualitatively in order to constitute such contributors as joint authors. *Maurel v. Smith*, 271 F. 211 (2d Cir. 1921). However, "each such contri-

bution must, in any event, be more than *de minimis*." 1 Nimmer § 6.07 at 6-18 (citing *Picture Music*, 314 F. Supp. 640).

A joint owner cannot be liable to a co-owner for copyright infringement, since a copyright owner cannot infringe his own copyright. *Donna v. Dodd, Mead & Co.*, 374 F. Supp. at 430. One joint owner may license the work without the other's consent, "subject only to a duty to account." *Id.* at 430-31. Likewise, each joint owner may make revisions and publish the original or the revised work. *Weinstein v. University of Illinois*, 811 F.2d 1091, 1095 (7th Cir. 1987).

As joint author of the 1985 RSNA paper, Freeman can not be liable for copyright infringement. He was entitled to submit the jointly owned product for the August 1987 Mount Sinai review course without Weissman's consent and was merely required to account to Weissman, the joint owner, for any profits derived from use of the work. Freeman received the honorarium, $250, from Mount Sinai for his lecture even without the use of the syllabus in question; he earned no profit at all and has nothing for which to account.

C. *Derivative Works*

The allegedly infringed work does not constitute a "derivative work" either.

17 U.S.C. § 101 defines a derivative work as one "based upon one or more preexisting works." While derivative works are specifically included in the Copyright Act as being copyrightable, 17 U.S.C. § 103, "to support a copyright the original aspects of a derivative work must be more than trivial . . . [and] the scope of protection afforded a derivative work must reflect the degree to which it relies on preexisting material." *Durham Indus. v. Tomy Corp.*, 630 F.2d at 909. This analysis is based upon the premise that " 'the one pervading element prerequisite to copyright protection regardless of the form of the work' is the requirement of originality—that the work be the original product of the claimant." *L. Batlin & Son v. Snyder*, 536 F.2d at 489-90 (quoting 1 Nimmer on Copyright § 10 (1975)); *see* 1 Nimmer § 2.01 at 2-5. This requirement has been interpreted to mean a copyrightable work must contain "some

substantial'' and ''not merely a trivial'' variation. *See Durham Indus.*, 630 F.2d at 910; *L. Batlin*, 536 F.2d at 491. Thus, only non-trivial, original features contributed by the author or creator of a derivative work are entitled to copyright protection. *Id.*

The 1985 RSNA syllabus was merely the ''latest version of the collaborative work'' that had been evolving since 1980. The paper ''was essentially in good part [Freeman's] own work in terms of the false positive section. It had a lot of other collaborative work that [the parties] had evolved as the document appeared and periodically was updated and changed from 1980 on.'' The few sentences and ''paragraph or two'' that Freeman concedes Weissmann may have added to the prior jointly authored works amount to ''only a 'miniscule variation,' demonstrating no more than 'trivial' originality.'' *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435 (S.D.N.Y. 1986) (quoting *Durham Indus.*, 630 F.2d at 910). Only a minimal amount of originality is necessary to warrant copyright protection; however, in the light of the testimony which the Court accepts as credible, Weissmann's contributions updating the prior stock piece jointly authored by Weissmann and Freeman and used by both Weissmann and Freeman for educational review courses constitute '' 'merely trivial' variation[s].'' *Russ Berrie & Co.*, 482 F. Supp at 989 (quoting *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951)).

Often, the subjective selection and arrangement of data can merit copyright protection. *See Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984). However, the identical sections were used in prior papers jointly authored in virtually verbatim fashion and the update was done as part of the evolution of the stock piece; plaintiff's modifications of pre-existing joint works therefore do not warrant protection under the copyright laws.

The prima facie case established by plaintiff's submission of the federal copyright registration has been successfully rebutted by the credible evidence that plaintiff's 1985 RSNA paper itself was prepared from prior works jointly authored by plaintiff and defendant and was an evolutionary stock piece. *See Russ Berrie Co.*, 482 F. Supp. at 987. The plaintiff's modifications to

the prior works are not of sufficient originality to support copyright protection.

D. *Fair Use*

Even if Freeman were not a joint author of the allegedly infringed work, his anticipated use of a copy of P-1 was a fair use.

Section 107 of Title 17 places a limitation on the exclusive right in copyrighted works, stating:

> [T]he fair use of a copyrighted work, including such use by reproduction in copies . . . , for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

Four factors are to be considered in determining fair use:

> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107.

These enumerated factors "are not meant to be exclusive: '[S]ince the doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts.' " *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 560 (1985) (quoting H.R. Rep. No. 1476, 94th Cong., at 65 (1976)).

With respect to the first factor, "the crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price." *Id.* at 562. The propriety of the defendant's

conduct is also relevant to the character of the use. *Id.* "[F]air use presupposes that the defendant has acted fairly and in good faith." *Marcus v. Rowley*, 695 F.2d 1171, 1175 (9th Cir. 1983); *Time Inc. v. Bernard Geis Assoc.*, 293 F. Supp. 130, 146 (S.D.N.Y. 1968).

Here, Freeman's contemplated use was entirely non-commercial and for ~~nonprofit~~ educational purposes. Freeman neither profited from the paper's use—he received the promised $250 honorarium even without using the handout—nor stood to profit had he included the syllabus in the course materials. Weissmann's stipulation to limit her damages to Freeman's economic gain, which could not have exceeded $250, indicates that there is no market value attached to P-1. Indeed, no evidence was proffered to prove otherwise. In addition, Freeman believed in good faith that he was entitled to use the stock piece for the non-profit review course.

As for the second factor, "[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy." *Harper & Row*, 471 U.S. at 563. Moreover, "[t]he fact that a work is unpublished is a critical element of its 'nature.' " *Id.* at 564. *Accord Salinger v. Random House Inc.*, 811 F.2d 90, 97 (2d Cir.), *cert. denied*, 108 S. Ct. 213 (1987). This factor weighs heavily in favor of Freeman. The syllabus here is factual and scientific in nature and it was disseminated by Weissmann herself and published in the 1985 RSNA booklet.

Under the third factor, the general rule is that the use "may not constitute a fair use if the entire work is reproduced." 3 Nimmer § 13.05[A] at 13-79; § 13.05[D] at 13-90.10-13-90.11. Although Freeman copied all of P-1, the content virtually in its entirety had been published in the name of both parties as joint authors, reducing to *de minimis* the very slight additions to the work as already indicated.

The fourth factor "is undoubtedly the single most important element of fair use." *Harper & Row*, 471 U.S. at 566. " 'Fair use is limited to copying by others which does not materially impair the marketability of the work which is copied.' " *Id.* at 566-67 (quoting 1 Nimmer § 1.10[D] at 1-87). Freeman's contemplated use of P-1 would not impair its market value at all, if

any exists, and dissemination of the results of the research being done at Montefiore would in all likelihood only increase the "marketability" of a paper emanating from that department.

On balance, Freeman's was a fair intended use.

IV. *Defendant's Attorney's Fees*

Defendant, in addition to demanding declaratory relief and a dismissal, seeks costs and reasonable attorney's fees pursuant to 17 U.S.C. § 505, based on plaintiff's allegedly meritless claims.

> Fees to a prevailing defendant should not be awarded when the plaintiff's claim is colorable since such awards would diminish the intended incentive to bring such claims. When the plaintiff's claims are objectively without arguable merit, however a prevailing defendant may recover attorney's fees under Section 505.

Diamond v. Am-Law Publishing Corp., 745 F.2d 142, 148 (2d Cir. 1984).

In order to award attorneys' fees to a defendant, a court must find plaintiff's suit to be "baseless, frivolous, unreasonable, or brought in bad faith." *Grosset & Dunlap, Inc. v. Gulf & Western Corp.*, 534 F. Supp. 606, 610 (S.D.N.Y. 1982); *Gardner v. Nizer*, 396 F. Supp. 63, 64 (S.D.N.Y. 1975). "[A] finding of subjective bad faith is not necessary . . . ." *Diamond*, 745 F.2d at 148. Attorneys' fees to a prevailing defendant are to be awarded circumspectly, particularly since they serve the purpose of "penalizing the losing party." *Roth v. Pritikin*, 787 F.2d 54, 57 (2d Cir. 1986). An award of attorneys' fees is within the sound discretion of the Court. *See Diamond*, 745 F.2d at 149; *Warner Bros. Inc. v. American Broadcasting Cos.*, 720 F.2d 231, 248 (2d Cir. 1983).

Plaintiff brought this litigation precipitately and perhaps unnecessarily. She sought to bolster her claims by short-sighted and untrue denials of the collaborative and sometimes personal authorship of the defendant of the stock piece—denials that went so far as to state that Freeman did not participate at all and, in answer to a question from the Court, that not a word,

sentence or thought in P-1 was that of Freeman. Plainly the overbroad position she took resulted in a grave insult to her mentor and professional colleague. Dr. Freeman had neither motive nor need to plagiarize, considering his preeminent grasp of the subject.

Withal, taking into account all of the facts and circumstances shown in the record, the Court believes that the plaintiff's resort to the courts was misguided ego and not essentially to impair the reputation and standing of the defendant. The plaintiff did stipulate that no actual damage resulted and limited her claim to defendant's economic gain from the alleged infringement. *See Grosset & Dunlap*, 534 F. Supp. at 611. It will serve no useful purpose to perpetuate her feuding by imposing attorney's fees, and in an endeavor to lay the emotions here involved to rest, the Court will treat the claims as an unfortunate lapse of judgment not requiring a penalty award of attorney's fees to defendant.

The Second Circuit has stated (Pratt, J.), in a case also filled with sharply conflicting testimony:

> A factfinder's decision that one party's version of the events is more credible than the other party's is, without more, insufficient to justify an award of attorneys' fees to a prevailing defendant under the Copyright Act.

Roth v. Pritikin, 787 F.2d at 58.

The defendant here is amply vindicated as a professional matter by exposure of the facts.

Conclusion

Accordingly, for the reasons stated herein, plaintiff's request for injunctive relief is denied and her claims are dismissed on the merits, with costs to be taxed by the Clerk.

The foregoing shall constitute the findings of fact and conclusions of law required by Rule 52(a), Fed. R. Civ. P.

Submit judgment accordingly in conformity with Rule 54, Fed. R. Civ. P.

So Ordered.

Dated: May 3, 1988
New York, New York

/s/ MILTON POLLACK
Milton Pollack
Senior United States District Judge

Appendix C

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

Docket Number 88-7435, 88-7465

At a stated term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse, in the City of New York, on the fourteenth day of April, one thousand nine hundred and eighty nine.

HEIDI S. WEISSMANN, M.D.,

Plaintiff-Appellant,
Cross-Appellee,

—V.—

LEONARD M. FREEMAN, M.D.,

Defendant-Appellee,
Cross-Appellant.

A petition for rehearing containing a suggestion that action be reheard in banc having been filed herein by Appellee-Cross-Appellant Leonard M. Freeman, M.D.

Upon consideration by the panel that heard the appeal, it is

Ordered that said petition for rehearing is DENIED.

It is further noted that the suggestion for rehearing in banc has been transmitted to the judges of the court in regular active service and to any other judge that heard the appeal and that no such judge has requested that a vote be taken thereon.

/s/ ELAINE B. GOLDSMITH
Elaine B. Goldsmith
Clerk

Supreme Court, U.S.
FILED
AUG 10 1989
JOSEPH F. SPANIOL, JR.
CLERK

No. 89-114

IN THE

Supreme Court of the United States

OCTOBER TERM, 1989

LEONARD M. FREEMAN, M.D.,

Petitioner,

—v.—

HEIDI S. WEISSMANN, M.D.,

Respondent.

BRIEF IN OPPOSITION TO A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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EDITOR'S NOTE:

THE FOLLOWING PAGES WERE POOR HARD COPY AT THE TIME OF FILMING. IF AND WHEN A BETTER COPY CAN BE OBTAINED, A NEW FICHE WILL BE ISSUED.

QUESTIONS PRESENTED

Sections 101 (definitions of "created," "derivative work," and "joint work"), 103(b), 201(a) and 107 of the Copyright Act and the case law consistently interpreting them furnish the controlling law on the three key questions: (i) whether a new version of an earlier work contains sufficient newly added "expression" to qualify as a copyrightable derivative work (ii) whether such new material is a "joint work" and (iii) whether an unlicensed use of it meets the criteria for the "fair use" defense.

The Court of Appeals held (i) that P-1, the medical article at issue, contained sufficient new expression to meet the test for copyright protection, (ii) that petitioner was not a "joint author" of the new matter in P-1, because it was conceded that he did not participate in its creation and (iii) that petitioner's verbatim copying of P-1 and misrepresentation of himself as its sole author was not a "fair use".

The questions presented are:

1. Whether petitioner can claim before this Court to have authored the new material in P-1 when he has conceded below that he did not participate in its creation and that his claim of joint authorship of P-1 was only based on having participated in the creation of earlier versions of P-1?

2. Whether by requiring an actual authorship contribution by each would-be joint author, as mandated by the explicit statutory definition of a "joint work" in 17 U.S.C. § 101, the Court of Appeals is encouraging or stifling the creative efforts the Copyright Act is designed to foster?

3. With respect to whether P-1 was a "joint work,"

(a) whether the Court of Appeals properly determined that under Sections 101 and 103(b) of the Copyright Act the copyright ownership of P-1 must be assessed on the basis of the parties' respective contributions to and intentions regarding P-1, as distinguished from their actions regarding earlier versions of P-1, and

(b) whether the Court of Appeals correctly decided that P-1 was not jointly authored: where petitioner conceded that he did not participate in P-1's creation and that his claim of co-ownership was based upon joint authorship of the works from which P-1 was derived; where he failed to offer any evidence of a mutual intent, at the time P-1 was created for its new material to be jointly owned; and where the District Court had made none of the specific findings required by the statute respecting the 1985 creation of P-1, as distinguished from earlier versions of P-1?

4. Whether the Court of Appeals, which made a thorough review of the works themselves, correctly concluded that the new matter in P-1 is copyrightable and that the District Court's contrary conclusion was based upon "clearly erroneous" findings?

5. Whether the Court of Appeals correctly reversed the District Court's holding that verbatim copying of P-1 in its entirety by a professional colleague and competitor, who removed respondent's name and misrepresented his own authorship of it, was a fair use under Section 107 of the Copyright Act?

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JUDGMENT BELOW

The Judgment of the United States District Court for the Southern District of New York (Pollack, D.J.) entered pursuant to the opinion herein of the Court of Appeals for the Second Circuit is reprinted in the Appendix hereto, A-1-2, *infra*.

STATUTES INVOLVED

Section 101 of the Copyright Revision Act of 1976, 17 U.S.C. § 101 (hereinafter the "U.S. Copyright Act"), provides in pertinent part:

> As used in this title, the following terms and their variant forms mean the following:
>
> * * *
>
> A work is "created" when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.
>
> A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a "derivative work."
>
> * * *
>
> A "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

Section 103(b) of the U.S. Copyright Act, 17 U.S.C. § 103(b), provides:

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such works is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

Section 107 of the U.S. Copyright Act, 17 U.S.C. § 107, provides:

> Notwithstanding the provisions of section 106, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include —
>
> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

Section 201(a) of the U.S. Copyright Act, 17 U.S.C. § 201(a), provides:

> Initial Ownership - Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are co-owners of copyright in the work.

No. 89-114

IN THE

Supreme Court of the United States

OCTOBER TERM, 1989

LEONARD M. FREEMAN, M.D.,

Petitioner,

—v.—

HEIDI S. WEISSMANN, M.D.,

Respondent.

BRIEF IN OPPOSITION TO A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Petitioner Leonard M. Freeman, M.D. has requested this Court to issue a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Second Circuit entered on February 23, 1989. Because the decision of the Second Circuit is correct and does not raise any questions that are worthy of review by this Court, the Petition should be denied.

STATEMENT OF THE CASE

Introduction

Respondent sued petitioner for copyright infringement. The parties are each leaders in the field of nuclear medicine where publisning and credit for authorship are essential for professional advancement and economic reward.

It was undisputed that without permission, petitioner photocopied respondent's 1985 copyrighted article, P-1, changed its title and substituted his name instead of hers as its sole author. Petitioner's motive was to supply the copy for distribution in a course book for which he was required to furnish his own up-to-date submission. Petitioner conceded he was not a collaborator in preparing the new material in this article, although the parties had been co-authors of certain earlier works on the subject treated in respondent's article. The Court of Appeals concluded that petitioner's copying of the article was a copyright infringement and that the District Court's conclusion to the contrary was based upon a clearly erroneous application of the Copyright Act.

Facts

Respondent is a widely honored researcher and author in the field of nuclear medicine (Pet. App. B-6, 7)[1] and at all relevant times was Associate Professor in the Department of Nuclear Medicine and Radiology, Albert Einstein College of Medicine and Adjunct Attending Physician at Montefiore Medical Center (Pet. App. B-5). In 1985 respondent prepared P-1, an article entitled "Hepatobiliary Imaging" reporting on the state of the art of a diagnostic imaging technique for liver and biliary disorders employing the radioactive analogs of the agent IDA. P-1 was published as a chapter to the Radiological Society of North America's ("RSNA") book entitled "Syllabus: A Categorical Course in Nuclear Medicine". (P-1; E-1).

P-1 was derived from various earlier works, including articles and chapters of medical texts, that the District Court found had been jointly authored from 1979 to 1984. The preparation of P-1 took over a month, including the review of over one-hundred works in the literature and the study of and selection from over

---

[1] References to "A- " are to the Joint Appendix in the Second Circuit followed by the page number, to "T- " to the Trial Transcript Volume in the Second Circuit and "E" to the Trial Exhibits Volume in the Second Circuit followed by the page number. References to "P- " and "D- " are to plaintiff-respondent's and defendant-petitioner's trial exhibits, respectively. References to "Pet." are to the Petition for Certiorari and to "Pet. App." are to the Appendix to the Petition for Certiorari.

400 illustrations compiled by respondent (Pet. App. B-15; T-37). The highlighting[2] in plaintiff's Trial Exhibit 13 (Appendix 2 hereto), a copy of P-1, spotlights much of the material in P-1 not present in any of its earlier versions, but does not demonstrate every new copyrightable element such as rearrangement or new combination of earlier material.[3]

Petitioner made no claim to having participated in creating any aspect of P-1 but conceded the contrary throughout the case: at the preliminary injunction hearing petitioner conceded that "the article in question before this court [P-1] was not a jointly authored article" (A-13). At that hearing the District Court "ascertain[ed] that in fact the questioned article [was] authored solely by plaintiff" (A-16). Petitioner's defense was that P-1, while not itself jointly authored, was derived "virtually verbatim" from "prior joint collaborative works" (A-17).

At trial, petitioner's counsel objected to evidence on the "preparation process" for P-1, explaining that "we don't claim, as I told the court in proceedings on August 21st last year, that Dr. Freeman participated in the preparation of the manuscript for this particular piece [P-1], our claim is of joint authorship from the works from which this is derived" (T-56; same T-267). Respondent's following direct testimony was uncontradicted:

Q Did Dr. Freeman have any participation in writing the article?
A Not one word.
Q Did he edit it before it went to the RSNA?
A No, he did not.
Q Did he see a draft before it went to the RSNA?
A No, he did not.

---

[2] P-13 as admitted in evidence had this highlighting in red. However, the printer of respondent's Brief could only reproduce the highlighting in yellow in the Appendix hereto. A true copy of P-13 is also being lodged with the Clerk of the Supreme Court.

[3] Other trial exhibits of respondent demonstrated separately the differences between P-1 and each of its predecessors and the new selection and combination in P-1 of pre-existing material by tracing back all of P-1's sections to their different sources. (P-46, P-16 and P-16a).

Q Did he read the gallies?
A No, he did not.[4]

(T-38)

On appeal, petitioner did not question either the fact of these concessions or the accuracy of their content.[5]

Petitioner Freeman is Professor of Nuclear Medicine and Radiology at Einstein and Attending Physician at Montefiore where at relevant times he served over plaintiff as Chief of the Division of Nuclear Medicine. (Pet. App. B-5; D-14 and D-15; T-338). In August 1987, petitioner, without permission (T-102), photocopied P-1, whited out respondent's name and replaced it with his as sole author (T-561-62), added three words to its title and then submitted the article to the Mount Sinai School of Medicine for reproduction and distribution as part of the book for a nuclear medicine conference ("P-2").[6] (Pet. App. B-2; B-15-16).

The District Court Decision

On the facts, the District Court found that Petitioner had copied P-1 as claimed, but made no mention of the key concession that petitioner did not participate at all in the creation of P-1 and gave no separate consideration to the facts relating to P-1's creation. With respect to the earlier works of the parties, the trial court found that "plaintiff [respondent] did almost all

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[4] Petitioner himself also testified that he had nothing to do with the "order in which the sections and information" appeared in P-1 (T-498). When asked whether he claimed to have written "a single word expressly for P-1" apart from "those pieces that you say derive from collaborative work," petitioner also testified that "Aside from what has been demonstrated to be collaborative work, I did not write any additional words for this piece." (T-499).

[5] In answer to respondent's argument that petitioner could not be a joint author where he did not participate in creating the new work, petitioner stated: "It is thus irrelevant that Weissman alone penned the new matter in P-1." (Brief of Def't Appellee, Point I, p. 16).

[6] The trial evidence also included another, retyped copy of P-1's text published under petitioner's name alone in the bound conference book for a symposium held in December 1986 in Taiwan where petitioner guest lectured. (P-34, admitted without objection, T-464). Respondent was not aware of this use at the time, and it was not disclosed in pre-trial discovery (T-456-58).

of the writing", that she routinely submitted "drafts" of these to petitioner "before publication", (Pet. App.B- 10) and that "[s]he [respondent] would always make sure to leave a copy of a manuscript on his desk if he [petitioner] was not in town or busy with other commitments; she did not always get comments back, but she often did." (*Id.*) Although the District Court found that the preexisting works of the parties were created in this manner, no such findings were made with respect to P-1.

On the law, the District Court held that petitioner was a "joint author" and co-owner of P-1 (Pet. App. B-12, B-16 and 17) and then that its "new matter" was too trivial to qualify it for copyright protection as a derivative work because it did not report any "new studies" (Pet. App. B-5). It also explained the latter holding by evaluating the popularity of P-1's subject matter ("by 1985 interest in IDA [P-1's subject matter] had already peaked." Pet. App. B-15). The trial court justified these conclusions by finding that petitioner was an expert "on the appearance or absence of new matter of non-trivial originality" (Pet. App. B-14 - 15), accepting as "credible" his arguments that P-1 reported "nothing new" (Pet. App. B-15) and holding that its copyrightability was "not self proving" by examination of the documents. (*Id.*) The District Court alternatively ruled that petitioner's copying would be "fair use" because it involved a small, $250 honorarium, was done for non-profit, educational purposes and it would help the marketability of P-1 (Pet. App. B-24-25).

The Court of Appeals Opinion

The Court of Appeals reversed the trial court's conclusions on the ownership of P-1, its copyrightability and fair use, holding that (a) the new matter added to P-1 qualified for copyright protection (Pet. App. A-19-20); (b) petitioner was not and could not be a joint owner of the new matter because he had conceded that he had made no contribution and there was no mutual intent in 1985 to collaborate in its authorship (*id.* at 8-15, concurring op. A 31-32)) and (c) the verbatim copying of P-1 by a professional colleague who sought to pass it off as his own was not a fair use when the obvious effect was to deny to the author and rightful owner the only real economic benefit of such an

effort in the academic setting, namely, professional recognition for a scholarly achievement (*id.* at 21-28).

The Court of Appeals specifically identified the District Court's clear errors of law as follows: treating P-1 as part of one "evolutionary" ongoing work in disregard of the Copyright Act's explicit requirements in Sections 101 and 103(b) that the ownership and copyright protection for works prepared in successive versions be determined for each version on a separate basis (Pet. App. A-8-10, 14); failing to consider, as required by the definition of "joint work" in Section 101, petitioner's conceded lack of any role in creating P-1 and the absence at that time of a mutual intent to collaborate by both parties (Pet. App. A-8, 11; 10-14; *see* concurring opinion A-31); failing to properly assess P-1's new matter, including new text, selection and rearrangement,in light of the governing modest legal standard for copyright protection (Pet. App. A-19) and, in its fair use evaluation, disregarding the combined facts of petitioner's wholesale appropriation and attempt to "pass off" the work in question as his own (Pet. App. A-24), while focusing only "upon sales or dollars received, rather than upon the realities of promotion and tenure in an academic setting" in evaluating the real econonic effect and other aspects of the kind of conduct involved. (Pet. App. A-25-28).

The Court of Appeals identified the District Court's clearly erroneous findings of fact as including: that petitioner was a joint author of P-1, even though he conceded that he contributed nothing to its new matter (Pet. App. A-9, 11 and 15); that the parties both intended to collaborate on the creation of P-1, even though there was no evidence to support this (Pet. App. A-13, 14 and 15; *see* A-31 concurring opinion); that respondent's only additions to P-1 consisted of adding "four sources" and repeating verbatim portions of the prior works, with no new selection and rearrangement of material, even though the documents showed this to be untrue (Pet. App. A-19-20) and that the amount and substantiality of material copied by petitioner was "*de minimis*," even though he copied all of P-1's newly-added material. (Pet. App. A-26).

REASONS FOR DENYING THE PETITION

Preliminary Statement

Petitioner, having made no contribution to the medical article at issue, took off respondent's name, substituted his own, and authorized its publication and distribution at a medical conference where he guest lectured. The Second Circuit, following the rules specifically required by the Copyright Act and its long line of precedents, held that respondent, the only author of the material newly added to this version of the work, exclusively owned the new matter and that petitioner had infringed the copyright in this new material. Petitioner could lawfully have used, or "updated" on his own, any of the earlier versions of which he was a joint author by virtue of his contributions to those versions. But having chosen instead simply to copy and publish respondent's new material, when petitioner played no role in its creation, he has infringed respondent's copyright. There is nothing novel or unfair about this result.

The Constitutional purpose of our copyright laws is to encourage authorship by rewarding authors for their creative endeavors.[7] In faithfully applying the Copyright Act, the decision of the Second Circuit demonstrates the wisdom of the Congressional scheme enacted to stimulate the production of works for the public benefit – the rewards of copyright ownership, whether granted to one or more authors, are given in return for actual participation in the creative process. Petitioner is misguided in urging a contrary rule, which would only create a disincentive by rewarding someone for not participating.

Petitioner's case must fail because he made no contribution of any kind to the work at issue. Throughout this case petitioner has repeatedly conceded that he did not participate in the creation of P-1 in any way and also repeatedly represented that his only basis for claiming the right to copy it is the fact that he was a joint author of the earlier versions from which P-1 was derived. Because Sections 103(b), 101 and 201(a) of the Copyright Act, and case law thereunder, unequivocally provide that a

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[7] U.S. Const., Art. I, Sec. 8, Cl. 8.

person cannot be a joint owner solely because he contributes to an earlier version, by his own admission and concessions below, petitioner, who is not an author of any of the new material, cannot meet this standard.

In view of petitioner's numerous and repeated concessions below that he did not participate in the creation of P-1, as noted by the Court of Appeals (Pet. App. A-5,8,11 and 14), the Petition, which contains numerous unsupported, misleading and false statements to the contrary (Pet. 2, 3, 4, 5 and 7), is based upon a supposed factual issue and legal contention not made or raised in the District Court or the Court of Appeals. Such an approach, absent a showing of extraordinary circumstances not present here, is impermissible before this Court.

Finally, Supreme Court Rule 17 requires "special and important reasons" before a writ of certiorari will issue. The Petition offers no reason why this Court should exercise jurisdiction beyond petitioner's disappointment with the result reached below, which was required by the application of well established law to the particular facts of this case. It would thus serve no purpose to re-review the Court of Appeals' appellate review and analysis of the complex trial record, when there is no dispute about the controlling provisions of the Copyright Act and when petitioner does not claim a conflict between Circuits or any unsettled, new or novel question of federal law having general importance and needing to be resolved by the Supreme Court. Nor, as shown below, does petitioner put forth any other basis calling for the Supreme Court's exercise of its discretionary jurisdiction or powers of supervision.

I.

THE FACTUAL AND LEGAL BASIS FOR THE PETITION IS DESTROYED BY PETITIONER'S CONCESSION BELOW THAT HE DID NOT PARTICIPATE IN THE PREPARATION OF THE NEW MATTER IN P-1 AND THAT HIS CLAIM OF JOINT AUTHORSHIP IS INSTEAD ON THE BASIS OF THE WORKS FROM WHICH P-1 WAS DERIVED

This Court's ordinary rule is not to consider issues not raised or litigated in the Court of Appeals. *See Adickes v. S.H. Kress*

& Co., 398 U.S. 144, 147, *n.* 2 (1970). This is especially so where a party is seeking to contest a fact conceded below or to change the legal position it represented to the lower courts. *See, e.g., United States v. Ortiz*, 422 U.S. 891, 898 (1975).

Petitioner has inappropriately maintained before the Supreme Court that his "authorship appears substantially in the work in question" (Pet. 3), that there is newly added material in P-1 "some of which itself was jointly authored" (Pet. 2), "[t]hat with respect to any matters newly added to P-1, petitioner was an active participant in researching and reporting" the same (Pet. 4, citing this as a finding by the District Court), that P-1's "new matter was in substantial part the product of petitioner" (Pet. 5), and that "even the new matter in P-1 had in substantial part originated with petitioner's participation" (Pet. 7, again citing this as a finding by the District Court).

No citations are made to the record beyond the opinions to support these extraordinary statements or any other contention in the Petition. The only mention of petitioner's numerous concessions that he did not participate in P-1 appears at page 14 of the Petition, not in his discussion of the law of joint authorship, but where petitioner boldly and unjustly accuses the Court of Appeals of "concluding out of whole cloth that the District court . . . surprisingly found P-1 to be a joint work 'despite [petitioner's] concession that he had no hand in P-1's preparation.'" (Pet. 14).

In certain instances the Petition mistates outright the authorship of P-1's new material, while in others it attempts to rewrite the record by repeatedly blurring and disregarding the distinction that must be made under Section 103(b) of the Copyright Act between the preexisting and newly added material in a "derivative work," i.e., one based upon a previous version. *See* 17 U.S.C. §101 definitions of "derivative work" and "created."[8]

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[8] Remarkably, the Petition, like the reversed District Court opinion makes *no mention whatsoever* of the above-quoted Section 103(b) and of the Section 101 definitions of "created" and "derivative work" in its entire discussions of the law of joint authorship and the copyrightability of P-1 (Pet., Reasons I and II pp. 1-10). The only mention of the pivotal statutory provision of

(Footnote continued)

By ignoring this key distinction, the Petition over and over again makes misleading statements and contentions, such as those quoted above, never raised in either the District Court or Court of Appeals to the effect that the newly added material "originated" with or was the "product" of petitioner when he did no writing, reviewing, discussing or consulting about any aspect of it. Petitioner never made such claims because from the outset of the litigation, petitioner conceded factually that the contrary was the truth and conceded and clearly represented legally that his claimed right to copy P-1 was based on his participation in the creation of P-1's earlier versions, *not* P-1. Neither the occurrence nor substance of such concessions was challenged in the Court of Appeals.

II.

THE SECOND CIRCUIT'S DECISION CORRECTLY CARRIES OUT THE CONGRESSIONAL SCHEME FOR THE PROMOTION OF WORKS OF AUTHORSHIP: ANY RULING TO THE CONTRARY WOULD NOT ONLY DISREGARD THE STATUTE BUT BE A DISINCENTIVE TO CREATION

Petitioner's argument that the decision below "will have a chilling effect on scientific research" has no merit. The Second Circuit's entirely correct application of the Copyright Act, *see* points III-V *infra*, as envisioned by the Congress, will productively serve to encourage scientific authorship. As explained by the Court of Appeals:

> Encouraging authors to use their talents by holding out a promise of reward for their efforts is the surest way to advance the public welfare. In this case it is necessary to keep in mind the danger that allowing wholesale appropriation of scientific works presents. The personal gain sought by Dr. Weissmann [respondent] may not

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Section 103(b) at all is at page 12 where petitioner aggressively seeks to invoke the statutory distinction between the preexisting material in P-1, which he and respondent were of course both free to use, and the new material, in a disingenuous attempt to minimize the fact that his unlicensed photocopying of P-1, included all of P-1's newly added material, as well.

> be directly related to immediate financial gain, but the copyright protection extended to her work nevertheless provides her with an incentive to continue research -- an endeavor that, if successful, would and has led to professional and monetary benefits.

(Pet. App. A-26) (citations omitted)

Thus, the essence of the Congressional copyright scheme is that the rewards for authorship efforts go to those who actually participate in and contribute to the creation of the copyrightable work.[9] Consistent with this intent, the definition of a "joint work" requires "contributions" by both would-be joint authors. 17 U.S.C. § 101. Petitioner, who seeks a copyright in a work he did not create, is therefore urging upon this Court a policy and rule which flies in the face of the statute literally and which would be a disincentive to the authorship effort that the Constitution authorizes Congress to stimulate in our copyright laws.

The rule petitioner would like, so as to win for himself one case, would completely reverse the statutory scheme, thereby destroying the consistent, historic intent of Congress since 1790 to encourage works of authorship by inducing their creation and then revision through the grant of exclusive rights for limited times. *See* 17 U.S.C. §106. The 1976 Copyright Act has done this by continuing the time-honored rule making joint authors "tenants in common". *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess. ("House Report") at 121. This means that in the absence of an agreement that would "transfer" away all of a joint author's usual rights to license or use the work, which would have to be in writing, *see* Section 204, each joint author by statute has an "independent right to use or license" and exploit the work on a non-exclusive basis.[10] House Report at 121; *see* 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* (1988), §6.10; *accord*

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[9] This accords with petitioner's professed "philosophy. . . shared by. . . colleagues . . . that no one's name gets put on for being a total non-contributor." (T-440).

[10] The Petition's statement that under the Court of Appeals decision respondent's use of material from the earlier jointly owned works "necessarily infringed" these "along the way to creating P-1" is indicative of the lengths to which it has gone to deceive the Court about the governing law.

District Court, Pet. App. B 19-20. Each author's right includes the right to prepare his own derivative work based upon the work, provided only that he accounts to his joint author for an appropriate share of the profits therefrom. *Id.* The joint ownership rules are specifically reflected in the Judgment now entered in this case by the District Court. (Appendix hereto at A-1 *infra*, ¶ 3)

Petitioner's charge that the Second Circuit's decision would enable one contributing joint author, such as "Mr. Funk", to sue another contributing author, such as "Mr. Wagnall", for publishing their 48th edition because one of them registered the copyright in only one of their names (Pet. 10) totally ignores the facts in this case and has no basis in the law governing the rights of joint authors. Factually, what distinguishes P-1 from petitioner's example of the 48th edition of Funk & Wagnall is that petitioner has *not* participated in creating P-1. Legally, as noted above, in the absence of a collaboration or partnership agreement, where both authors have continued to write together, their work remains a joint one and neither can stop the publication of it by the other or register the copyright solely in his name.

But where, as here, "Mr. Wagnall" has not participated in creating the new dictionary, he is not entitled to publish it without "Mr. Funk's" permission, even though he has the right to create and publish his own 48th edition based upon its predecessors, as petitioner was free to do here. *See Weinstein v. University of Illinois*, 811 F.2d 1091, 1093 (7th Cir. 1987); 1 M. Nimmer, *supra* § 6.06 [B] at 6-15; *accord* District Court Opinion, Pet. App. B and 19-20; and Brief of Def't Appellee [petitioner] in Second Circuit, p. 20. What petitioner was not entitled to do under the statute was to engage in wholesale appropriation of respondent's derivative work, thus necessarily infringing its copyright by copying the protectible new elements added solely by respondent. 1 M. Nimmer, *supra*, § 3.05, at 3-21.

Petitioner's dissatisfaction is therefore not with the meaning of the copyright statute and how it applies but rather with the Copyright Act itself. However, it is obvious that in the absence of an unconstitutional legislative enactment, the Judiciary will not disregard the will of the Congress.

The Congressional scheme, in any event, is not ill-advised or unfair to individuals or would-be collaborators and has not worked an unproductive and equitable result in this case. Each co-owner of a joint work, including petitioner here, is and was encouraged by the statute to bring forward, update and revise scientific works whether or not he has a collaborator.[11] The statute does not discourage continued joint efforts but rather encourages them by the prospects of an efficient sharing of the burdens of preparing a new work so as to do so more easily or quickly than working alone.[12] And where there is not a renewed agreement to work together anymore, the continued revision, development and refinement of the preexisting joint work is still encouraged on an individual basis for the benefit of the public.

In the present case the statute has worked well, as intended: when admittedly petitioner lost interest in what he termed a no longer popular subject (Pet. App. B-15, quoting petitioner, "most investigators . . . moved on to other areas") and did not participate in creating a revision, the respondent was still encouraged to do so on her own. Respondent has thus made available to the public, the most up-to-date, state-of-the-art study on the utility and effectiveness of a technique for diagnosing liver and bile disorders utilizing analogues of the radioactive agent IDA. Without respondent's efforts, there would have been no revision at all.

In sum, even apart from the Petition's disregard of the controlling statutory purpose and rules, *see* III-V, *infra*, petitioner has urged a rule that would be a disincentive by perpetuating a continuing property interest of an inactive ex-co-author

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[11] The District Court's and petitioner's repeated efforts to denigrate P-1 as a mere "update" of "stock" material (Pet. App. B 10 and 15), misses the point that such revision is exactly the kind of authorship effort the copyright laws are designed to stimulate for works of this kind. As conceded by petitioner himself at trial, the value of such works depends upon their containing the most updated material and that was why he chose to copy P-1 when he did (T 489-90).

[12] The one thing that would obviously discourage collaboration would be to have joint authorship result in an inability to be free of its consequences, even after a former collaborator ceases to contribute, thereby undercutting the reward for the one who goes on alone.

without regard to his total lack of participation in creating the kind of work the statute seeks to encourage. To reward one for sitting back and making no contribution would not be in the public interest and would pervert the Constitutional basis for the copyright monopoly.

III.

THE SECOND CIRCUIT CORRECTLY HELD THAT THE NEW MATTER IN P-1, CONCEDEDLY AUTHORED SOLELY BY RESPONDENT, SATISFIED THE MODEST STANDARD OF ORIGINALITY REQUIRED FOR A COPYRIGHTABLE DERIVATIVE WORK

Petitioner does not dispute the legal standard utilized by the Second Circuit on the question of P-1's copyrightability as a derivative work.[13] Rather, Petitioner challenges the application of that standard to the specific facts of this case. As a general rule, lower court decisions turning upon an analysis of the particular facts involved do not merit Supreme Court review. *See United States v. Johnston*, 268 U.S. 220, 227 (1925); *see also Texas v. Mead*, 465 U.S. 1041 (1984).

In any event, the Second Circuit's analysis of the relevant facts here was thorough and accurate. As its opinion notes, the documents show on their face that the District Court erred by ignoring the following new copyrightable elements in P-1:

> (1) a selection and arrangement of photo illustrations and associated captions; (2) references to recent reports in the pertinent literature; (3) selection, condensation, and description of additional source material; (4) several new textual additions; (5) substantial rearrangement of the manner and order of presentation of

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[13] To establish copyright infringement, a plaintiff must prove ownership of a valid copyright and copying by the defendant. 3 M. Nimmer, *supra* §13.01 at 13-3 and 13-4. Since the making of one copy, or authorizing copying, by itself constitutes infringement, *id.* at §8.01[c] at 8-25 & 26 and House Report at 60, and was admitted by petitioner, it was not an issue here.

material contained in the parties' prior joint works; and (6) the addition of a section on "congenital disorders," a revised treatment of "chronic cholecystitis," and the incorporation of Dr. Freeman's "false positive" studies.

(Pet. App. A-19-20). In a work of this kind it is the expression in presenting the material that is protected by copyright. As explained by the Second Circuit in an earlier case,

> [I]n considering the copyright protections due a report of news events or factual developments, it is important to differentiate between the substance of the information contained in the report . . . and "the particular form or collocation of words in which the writer has communicated it." What is protected is the manner of expression, *the author's analysis or interpretation* of events, *the way he structures his material and marshals facts, his choice of words, and the emphasis he gives* to particular developments.

Wainwright Securities Inc. v. Wall Street Transcript Corp., 558 F.2d 91, 95-96 (2nd Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978) (citations omitted) (emphasis added).

The "new textual" material, including illustration captions, constituted approximately 33 percent of the total work. (1168 words out of 3496; *see* P-13, Appendix 2 hereto). To these are added the newly provided elements of selection, rearrangement and emphasis noted above. Petitioner himself admitted that P-1's ordering of text and "particular combination of figures" had not appeared before (TR 496). Plainly, these additions, alone or together, meet the modest requirement for copyright protection accepted universally in all Circuit Courts of the country. *See, e.g., M. Kramer Mfg. Co., Inc. v. Andrews*, 783 F.2d 421, 438 (4th Cir. 1986); *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.*, 697 F.2d 27, 34-35 (2d Cir. 1982); *Original Appalachian Artworks, Inc. v. Toy Loft*, 684 F.2d 821, 824 (11th Cir. 1982); *Kamar International, Inc. v. Russ Berrie and Co.*, 657 F.2d 1059,

1061 (9th Cir. 1981); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951).[14]

Thus, the Court of Appeals correctly reversed the District Court's clear error in denying copyright protection to P-1 on the basis of qualitative judgments as to the novelty or scientific worth of respondent's work (Pet. App. B-14), which this Court has long considered legally inappropriate under the Copyright Act. *See Baker v. Selden*, 101 U.S. 99, 102-03 (1880) ("novelty. . . has nothing to do with . . . copyright") and *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252 (1903) (it would be a "dangerous undertaking" for judges to decide on the "worth" of works in determining the scope of copyright protection); *see also* 1 M. Nimmer, *supra* § 3.03, at 3-10.[15]

The Court of Appeals was also clearly correct in relying on its own assessment of the new matter in P-1 from the documents themselves in finding copyrightable subject matter. Since the District Court had used the wrong legal standard on

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[14] Petitioner's claim that "all illustrations" in P-1 "were of petitioner's authorship" (Pet. 9) in order to suggest that he played any role in the new selection and arrangment of P-1's figures is still another demonstrably false and misleading statement. The District Court's assertion that two of P-1's new references were to figures "both of which were originally prepared by Freeman" (Pet. App. B-15) is similarly inaccurate and irrelevant. P-13's highlighting of P-1's new matter does not include the photo-illustrations themselves, as distinguished from their selection and combination. P-1 itself also shows that the source for each and every "Figure" is a work authored or co-authored by respondent Weissmann, including references 32 and 33 apparently referred to by the District Court. *See* A-12-13 *infra*. That petitoner may also have been one of the co-authors of an earlier illustration source has nothing to do with the newness of P-1's added selection and rearrangement of the illustrations and of related explanatory text and has nothing to do with petitioner's lack of participation in creating this new expression.

[15] The District Court held that P-1 was not copyrightable because it "did not report anything of substance that was new in the field" (Pet. App. B-10) and only included material that "updated" an "old stock piece" (Pet. App. B-15) and because by 1985 "interest in IDA [the medical subject] had already peaked" (Pet. App. B-15). Thus, the District Court's own reasoning shows that it was erroneously guided by an improper search for "novelty" or a "new discovery" that runs counter to the most basic tenets of copyright law.

copyrightability, its credibility assessments on the presence of such copyrightable subject matter were clearly irrelevant, as the Second Circuit properly perceived:

> Credibility . . . is scarcely pertinent to determining whether . . . the newly-added matter satisfies the statutory requirements for protectability. Research has not revealed a single case in which credibility has been deemed significant — let alone dispositive — on the question of whether there is a sufficient level of originality in a given work to render it copyrightable.

(Pet. App. A-19). *Accord*, 1 M. Nimmer, *supra*, §2.01 at 2-11 (quantum of originality presents "legal question" requiring "judicial line drawing"). The trial judge cannot insulate such erroneous legal conclusions from appellate review simply by labeling them as credibility determinations. *See Anderson v. City of Bessemer*, 470 U.S. 564, 575 (1985).[16]

Further, appellate courts often overturn trial court findings of fact without a violation of the principles of Rule 52(a) or Supreme Court precedents requiring adherence to that rule. As these precedents make clear, the Supreme Court's admonition that the "clearly erroneous" rule of Rule 52(a) be applied to all findings of fact is not meant to imply criticism of appellate courts

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[16] Findings employing code-words and labels, for example, that petitioner was "chief", "mentor" and "principal investigator" for a drug company and contentions that respondent was "junior" (Pet. App., Questions Presented, No. 1) are therefore totally irrelevant. In addition, although not the basis for respondent's appeal, the District Court decision is replete with innumerable, clear factual mistakes and distorted findings showing not only an erroneous portrayal of the issues as ones of credibility but a lack of care which pervades its opinion. These include portraying plaintiff as a neophyte instead of an Associate Professor and award winning author who graduated from medical school 15 years ago; stating that plaintiff sued even though defendant had already agreed to withdraw the infringement (Pet. App. B-2; *compare* with temporary restraining order hearing transcript A-16, 17); stating with respect to the prior versions of plaintiff's article that the Einstein 1980 (D-5) and Harvard 1980 papers (D-1) are "virtually identical" with only "two or three additional sentences" in D-5 and that D-1 preceded D-5 (Pet. App. B-11), which is disproved by the documents themselves (E-357 and E-435), and that the Harvard 1982 article uses figures (Pet. App. B-11), again, disproved by looking at D-45 (E-488).

for rejecting findings of fact which leave them "with a definite and firm conviction that a mistake has been committed," as was done here. (Pet. App. A-21). *See, e.g., Bose Corp. v. Consumers Union of United States, Inc.*, 466 U.S. 485, 499 (1984); *McAllister v. United States*, 348 U.S. 19, 20 (1954); *United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948).

Finally, petitioner's claims that P-1's new matter, included his solely authored discussion of "false positives" (Pet., *e.g.*, 4 & 9) are belied by the record as well as irrelevant. The documents establish that P-1's "false positives" section was not newly added to P-1 but appeared earlier in the jointly owned Harvard 1984 and in the Mount Sinai 1984 papers[17] (*compare* P-1, E 12-14, also in the Appendix hereto at A-7-9, *infra.*, with D-34 at E 484-486 and with D-4 at E 427-29). It is consequently not highlighted in P-13 (Appendix A-7-9, *infra.*). The District Court itself therefore found such material to be part of P-1's jointly owned "standard" predecessors (Pet. App. B-11) and subject to "mutual use" as one of P-1's prior "collaborative efforts" (Pet. App. B-14), to which use petitioner stated he had "no objection" (petitioner at T-491 and 92).[18] Thus, the false positive section was preexisting material and has no relevance to whether P-1's new matter is copyrightable or jointly authored.

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[17] Petitioner has consistently claimed that P-1 was part of one jointly owned "evolutionary" work which included all of P-1's predecessors, including the Harvard 1984 paper and P-1's most immediate predecessor, the Mount Sinai 1984 paper. Petitioner's main Brief in the Court of Appeals also stated with respect to the Mount Sinai 1984 paper: "It incorporated all sections previously used, including Freeman's 'false positive' section [A-200]" citing the District Court at Pet. App. B-11). Brief of Def't Appellee p. 12

[18] Also, contrary to the petition's suggestions that P-1's illustrations consisted of the certain "accompanying false positive slides", (*e.g.*, Pet. 4), P-1's false positive discussion, *see* Appendix hereto, at A-7-9, *infra*, does not even include reference to illustrations and these slides were not utilized for P-1. The District Court did not find any use of false positive slides in P-1, either; it only found that petitioner had earlier in 1983 used such slides in his lecturing (Pet. App. B 13-14). All of the illustrations ("Figures") appearing in P-1 are, in any event, identified as originating in earlier works co-authored by respondent Weissmann and apart from their selection and rearrangement in P-1, do not form part of P-1's new matter. *See* note 14 *supra*.

IV.

THE SECOND CIRCUIT CORRECTLY HELD THAT PETITIONER'S "JOINT WORK" DEFENSE FAILED, WHERE HE CONCEDEDLY DID NOT PARTICIPATE IN THE CREATION OF ANY OF THE NEW COPYRIGHTABLE MATTER IN P-1 AND WHERE HE CLAIMED JOINT OWNERSHIP ONLY ON THE BASIS OF EVIDENCE RELATING TO THE PARTIES' CO-OWNERSHIP AND INTENTIONS WITH RESPECT TO PRIOR WORKS

Petitioner had to meet each of the following statutory criteria for P-1 to be a "joint work" (i) under Section 101, each would-be joint author must be a contributing party; (ii) under Section 101, the intention to contribute to a joint work must be found at the time one's contribution is made; and (iii) by reason of Section 103(b), one's intention (or even agreements) with respect to other earlier works (including ones from which new works are derived) cannot be the basis for an ownership determination of a derivative work.

Petitioner's attempt to transform the routine application of these rules into an issue qualifying for Supreme Court consideration by inaccurately portraying the basis for the Second Circuit decision as disagreement with the trial court's findings of fact (Pet. 7) will not stand up. The Second Circuit was not bound by, and was proper in rejecting, those District Court findings which were predicated on an erroneous legal standard. (A-8, citing *United States v. Parke, Davis & Co.*, 362 U.S. 29, 44 (1960)).

The Court of Appeals specifically identified a comprehensive series of errors of law that infected the District Court's entire opinion on joint ownership. First, under the Copyright Act, protection is afforded to each work at the moment of its creation. In the case of works prepared in different versions, "the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work."

17 U.S.C. §101 (definition of "created"). Accordingly, the Petition's attack on the Court of Appeals for rejecting the District Court's attempt to lump P-1 and the prior collaborative works of the parties together as a single "evolutionary" work disregards the plain language of the Copyright Act which prohibits such treatment.[19]

This error of law led to a further error in failing to consider the effect of Petitioner's concessions concerning his lack of participation in creating P-1, plainly vitiating the District Court's purported findings of fact and legal conclusions with respect to copyright ownership. Under such circumstances, the Second Circuit quite properly held that the District Court's findings of fact were not binding on it. See 5A J. Moore, *Moore's Federal Practice* (2d ed. 1988) ¶52.03[2], at 52-79; C. Wright & A. Miller, *Federal Practice and Procedure* (1971) ¶2585, at 734. *See also United States v. Parke, Davis & Co.*, 362 U.S. 29 (1960).

Finally, the Second Circuit held that the District Court had totally failed to grasp the combined effect on P-1's ownership of the statutory rules applicable to a "joint work" under Section 101 and to a "derivative work" under Section 103(b).[20] Under Section 101, each purported joint author must actually "contribute" to what is "prepared" to comprise the work in question, *and* must intend to make a contribution to a joint work at the time the contribution is made. *See* House Report at 120; 1 M. Nimmer, *supra*, § 6.05 at 6-12. Section 103(b) provides that

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[19] The Petition's effort to avoid the statute has gone so far as to decline even to set forth the text of these provisions in a "Statutes Involved" section or Appendix.

[20] Petitioner's argument is erroneous in maintaining that such a work must be *either* joint *or* derivative. (Pet. 9; Questions Presented No. 2(b)) The issue of "ownership," dealt with in Chapter Two of the Copyright Act ("Copyright Ownership and Transfer") has nothing to do with the issue of copyrightability of a work, whether or not a derivative work, governed by Chapter One ("Subject Matter and Scope of Copyright"). Thus, a work based upon any prior work may be a copyrightable derivative work if it meets the standard of embodying more than trivial originality. *See* III *supra*. If it meets this standard, then the ownership of the new work and whether it is singly or jointly owned, is a separate question.

the copyright protection and ownership for derivative works "is independent of" ownership of "any copyright protection in the preexisting material." Accordingly, the Second Circuit properly ruled that "an intent to contribute or an actual contribution to previous works does not serve as proof of ownership in the derivative work."[21] (Pet. App. A-9, citing House Rep. at 103, 120). Thus, all of the District Court's discussion of the parties' intentions to collaborate and merge their efforts, including the passages cited by petitioner, relate only to the predecessors of P-1 (before 1985) when the parties were found to have been "unquestionably collaborators" (Pet. App. B-12), *not* P-1.[22]

Petitioner's attempt to reargue the joint ownership point simply disregards entirely the contribution requirement. Petitioner reads out of Section 101 the words "contributions" and "prepared," reads out of its own quotation from the *Marks* case (Pet. 7) the words "their contributions" and similarly reads out of every other authority on joint authorship the requirement of that each would-be joint author make a contribution by actually engaging in the "joint laboring" identified by the District

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[21] This is specifically explained in the House Report at 120 and considered basic copyright doctrine. *See* 1 M. Nimmer, *supra*, §6.05 at 6-12; (Pet. App. A-10 and authorities there cited).

[22] For example, the reference to a "common design" (Pet. App. B-9) was to years ago when plaintiff was "a fourth year resident" (*id.*), *i.e.*, in 1977 (*see* Pet App. B-6). This also identifies no authorship of any particular work at any specific date. The statement that the parties impliedly "had agreed" that either could use "the stock piece" (Pet. App. B-12) was, similarly, made with reference to the period before petitioner conceded he played no role, not to 1985 when P-1 was created. Moreover, the parties Joint Pretrial Order stipulates that petitioner "did not request nor receive permission" from respondent to use P-1. (A-62). The District Court's statement that P-1 "originated as the result of this collaboration" and that "[b]eginning in about April 1980" the parties prepared a syllabus to use for various courses (Pet. App. B-9 and 10), again, does not relate to P-1 in 1985 - *all* derivative works "originate" as the result of their predecessors, but this did not alter their status as separate works. *See* 17 U.S.C. §§101 (def. of "created") and 103(b). In the same category is the District Court's reference to P-1's use of the term "we" which comes from P-1's predecessors, not its new material. *See infra*, p. 24.

Court itself as "the essence of a joint work." (Pet. App. B-19 and 20).[23]

It is basic that petitioner's co-ownership rights in the prior joint works provide him with no property rights in the new derivative work, P-1. *See, e.g., Weinstein v. University of Illinois*, 811 F.2d 1091, 1093 (7th Cir. 1987); *Dynamic Solutions, Inc. v. Planning and Controls, Inc.*, 646 F. Supp. 1329, 1338-39 (S.D.N.Y. 1986); *MCA, Inc. v. Wilson*, 425 F.Supp. 443, 455 (S.D.N.Y. 1976), *aff'd*, 677 F.2d 180 (2d Cir. 1981). Any contrary rule would, as the Second Circuit indicated, "convert all derivative works based upon jointly authored works into joint works, regardless of whether there had been any joint labor on the subsequent version." (Pet. App. A-8).

The Petition's distorted focus on petitioner's intent similarly misses the point that "it takes two to tango", i.e., that the requisite intent must be joint, not unilateral, and that the mutual intent must be to merge joint "contributions."[24] Instead of addressing the need for mutuality, petitioner contends that P-1 should be a joint work because respondent, allegedly, failed to communicate to petitioner that he was no longer collaborating with her. (Pet. 6, 8). However, as noted by the concurring opinion, it was petitioner's burden, not respondent's, to demonstrate that respondent intended P-1 to be a joint work, and the District Court committed a clear error by reversing that burden.[25] (Pet. App. A 31-32).

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[23] As explained by the Court of Appeals in discussing the *Marks* decision, *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266 (2nd Cir. 1944) (L. Hand, J.), the fact that a songwriter and lyricist do not know each other does not eliminate the requirement for a "joint work" that (a) both contribute to the song and (b) both have an understanding and intent to have their contributions merged. (Pet. A-12)

[24] There is no disagreement in the Second Circuit majority on this point (Pet. App. A-9; concurring op. Pet. App. A-31).

[25] Petitioner's contention would, in effect improperly place on each joint author, who by statute has the right to prepare alone a derivative work, the burden of having to make an arrangement for non-collaboration, failing which the non-participating party would continue to be rewarded irrespective of his failure to participate in the work. Such a result would nullify the Congressional scheme.

Every piece of hard evidence refutes petitioner's attempt to challenge respondent's intent to reserve her authorship rights to herself. First, as petitioner concedes, respondent did not seek petitioner's assistance in doing any of the work. Second, respondent's curriculum vitae excluded P-1 from those specifically identified works which the parties had co-authored. (Pet. App. A 13-14). *Inclusio unius est exclusio alterius*. Petitioner's argument that this evidences co-authorship of P-1 (Pet. 5) is completely illogical,[26] only underscoring the absence of any proof that respondent intended P-1 to be a joint work. (Pet. App., concurring op., A 31-32). Third, respondent used only her own name as author. When she publicly presented and distributed P-1 at the same 1985 RSNA meeting where both appeared and submitted chapters on different subjects, petitioner made no objections. (E-6; Pet App. A 13-14).[27]

In the face of such material and uncontroverted facts, the absence of any trial testimony or other evidence to carry petitioner's burden of overcoming his own concessions and the above-noted evidence is fatal to establishing a joint work defense. (*Id.* at A-13-14). There is also no finding in the District Court opinion that petitioner did not know that respondent was preparing P-1 without him or that this was not communicated to him. The Court of Appeals, including the opinions of both Judges Cardemone and Pierce, therefore correctly

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[26] The significance of this exclusion was further confirmed by petitioner's testimony that he "never" asked that his name be utilized when he did not "contribute as an author," that he declined to have his name included when, "for whatever the reason . . . I did not feel I had the time to allot to her and to allot to that particular project." (T-360 and 61).

[27] Petitioner's charge that "under the majority's convolution . . . either contributor" to a joint work could years later "surreptitiously" register alone and sue the other (Pet. 5) is ridiculous and has no relation to this case. Petitioner here conceded he was not a contributor. If he had been, of course, he could not be sued for using a joint work. *See* pp. 11-12, *supra*. Nor was respondent's creation and publication of P-1 at the 1985 RSNA conference attended by petitioner "surreptitious." It was only after *his* surreptitious infringement that the work was registered so that respondent could sue. (Pet. App. A-6).

agreed that petitioner had "failed to produce any evidence to rebut" the above showings. (Pet. App. A-14; *see* Pet. App. A-31 concurring op.).[28]

In still another inaccurate statement, petitioner desperately attempts to conjure up evidence of mutual intent for P-1 to be a joint work in the article's use of the institutional "we" in recommending a technique. But "we" appears not in P-1's new matter highlighted in P-13, but in its preexisting jointly authored material. (P-13, Appendix hereto at A-4, *infra*.). The record confirms the accuracy of P-13's highlighting by showing the prior use of such language in the 1984 Mount Sinai paper (D-4; *see* "Technique" at E-425).

Finally, the Court of Appeals has already evaluated, and then rejected, petitioner's contention that the record shows the existence of a practice evidencing respondent's intent for P-1 to be a joint work. The Court of Appeals was clearly correct in concluding from the fact that P-1 "was the only work with respect to which it was repeatedly conceded he [petitioner] has played no role," (Pet. App. A-14), that any prior "practice" respecting earlier jointly authored works, even if it existed, would have been inapplicable to P-1.[29] Petitioner's effort to reargue the practice point totally disregards the key differences between the creation

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[28] Furthermore, at the time P-1's predecessors were prepared, petitioner's intent was arguably to be an author of a particular article for particular publications. P-1 and other future versions did not exist and were at most possible expectations. Accordingly, he could have had no specific intention at that point to merge his prior efforts into unspecified future works in which he had no role.

[29] The Petition also flatly misstates the District Court's text as a finding of a "long standing practice" (Pet. 8). The trial court only stated there was "some indication of a practice" of using individual by-lines with respect to P-1's predecessors in instances where only one of the parties "was to appear before the audience" (Pet. App. B-11) The manner in which P-1 was presented and published would not fit into any supposed practice of this kind, in any event, because *both* of the parties appeared "before the audience" at the 1985 RSNA conference where P-1 was distributed under respondent's name.

of P-1 and its predecessors, treating them all as one "evolutionary" work. This is not only inconsistent with the facts differentiating P-1's creation and ownership from its predecessors' but also ignores the requirements of Sections 101 (definition of "created") and 103(b) that determinations of ownership be made on a separate basis for each work. Petitioner did not establish the existence of such a practice in any case.[30]

V.

THE SECOND CIRCUIT CORRECTLY HELD THAT PETITIONER'S UNAUTHORIZED REPRODUCTION OF RESPONDENT'S WORK IN ITS ENTIRETY WAS NOT A "FAIR USE"

Petitioner next seeks to invoke this Court's jurisdiction by arguing that the Second Circuit misapplied the fair use doctrine. Evaluation of the fair use defense requires that the particular facts of each case be individually examined. *See Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 549 (1985). In attempting to engage this Court in an additional review of the particular facts on which the fair use issue was decided by the Second Circuit, petitioner once again misperceives the nature of the Supreme Court's supervisory role in our judicial system. *See* p. 14 *supra*.

As the Second Circuit recognized here, the fair use doctrine turns not upon application of inflexible rules, but rather upon

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[30] The record concerning the petitioner's omission of respondent's name from the parties' joint Harvard 1984 paper actually contradicts the existence of the claimed practice because respondent had no knowledge of petitioner's actions. Apart from the undisputed fact that, unlike P-1, this was one of the parties' jointly authored works, *see* Reason III, *supra*; Pet. App. B-14; T 491-92 and D-4, plaintiff's testimony on direct and cross was that when she complained to defendant in 1984 about his intended omission of her name, he told her it was an oversight that he would rectify (T-102-04; 180, 225). Plaintiff did not learn until 1987 after bringing this action that defendant had failed to take the promised corrective action (T-102). Defendant did not deny this and the District Court decision contains no finding rejecting this uncontradicted testimony.

a fact specific "equitable rule of reason" analysis. (Pet. App. A-22, citing *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 448 (1984); House Report at 65). Where, as here, the trial decision on fair use was based on erroneous legal standards or erroneous findings of fact, the Court of Appeals was properly free to overrule the lower court. *See, e.g., Financial Information, Inc. v. Moody's Investors Service, Inc.*, 751 F.2d 501, 508 (2nd Cir. 1984).

There is in any event no basis for finding any error on the part of the Second Circuit holding that petitioner's obliteration of respondent's name from P-1 and distribution of verbatim copies under his own name could not be embraced within the equitable doctrine of fair use, which above all else "presupposes 'good faith and fair dealing.' " *See Time, Inc. v. Bernard Geis Associates*, 293 F. Supp. 130, 146 (S.D.N.Y. 1968). The Second Circuit could not find a single case sustaining a fair use defense where the copying was wholesale and involved a denial and substitution of authorship credit (Pet. App. A-23).

Petitioner's attempt to justify the District Court's complete disregard of petitioner's attempt to pass off P-1 as his own work is not overcome by his contention that there was "an uncontravened finding that the parties routinely attached one of the others' by line to syllabi containing the work of both of them." (Pet. 10). As noted above, the new matter in P-1 did not contain "the work of both of them". On the contrary, P-1 was the only instance in which it was agreed that petitioner made no contribution so that there is no precedent that can be drawn from P-1's predecessors which were jointly authored works. *See* pp. 24-25 *supra*.

Petitioner's arguments with respect to the specifically enumerated statutory factors under section 107 of the Copyright Act fare no better. As Judge Cardamone explained, both petitioner and the district court improperly limited their field of vision to the immediate dollars received from petitioner's copying (a $250 honorarium for a lecture) in assessing the first statutory factor, the purpose and character of the defendant's use (Pet. App. A-24). For authors of scientific studies like P-1,

a fact specific "equitable rule of reason" analysis. (Pet. App. A-22, citing *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 448 (1984); House Report at 65). Where, as here, the trial 57 U.S.L.W. 3812 (1989). Petitioner "stood to gain recognition among his peers in the profession and authorship credit with his attempted use of [respondent's] article" without "paying the usual price" of authorship effort. (Pet. App. A-24). The small size or even absence of an honorarium is beside the point.

With regard to the second factor, the nature of the copyrighted work, the District Court blindly concluded that scientific fact-based works should be accorded a limited scope of protection without ever addressing the real economic incentive copyright protection provides to the creation of such works. *See, e.g., Mazer v. Stein*, 347 U.S. 201, 219 (1954). In so doing, it committed an another error of law that rendered its factual conclusion clearly erroneous (Pet. App. A-25-266).

In evaluating the third factor, the amount and substantiality of the use, the District Court simply disregarded the fact that petitioner appropriated P-1 in its entirety (Pet. App. A-26-27). Petitioner's emphasis that P-1 embodied some material from prior works of which he was a joint author (Pet. 12) is wholly beside the point. By engaging in wholesale appropriation of a derivative work, petitioner has copied not simply underlying material of which he is entitled to make use, but *all* of the protectible new elements as well. 1 M. Nimmer, *supra*, § 3.05, at 3-21. *See* Point III *supra*. In fair use determinations, the copying of entire works is considered a significant negative factor. *See, e.g., Rosemont Enterprises, Inc. v. Random House*, 366 F.2d 303, 306 (2nd Cir. 1966) cert. denied 385 U.S. 1009 (1967); *Withol v. Crow*, 309 F.2d 777, 780 (8th Cir. 1962); *Walt Disney Productions v. Mature Pictures Corp.*, 389 F.Supp. 1397, 1398-99 (S.D.N.Y. 1975). *See also* 3 M. Nimmer, *supra*, § 13.05[A] at 13-79; § 13.05[D], at 13-90.10 to 13-90.11.

Finally, on the fourth factor, the effect on the market for or value of the work, the Second Circuit properly corrected the clear error of the District Court in ignoring the economic realities for authors in the academic world. In any realistic sense these

include promotion and advancement based on one's publications and scientific achievements (A-27-28). It would severely disrupt the market for works of scientific research and serve as a disincentive for the creation of these works were the fair use doctrine applied in such a way as to focus only on minimal lecture honorariums and sales figures without regard to more important economic considerations of "promotion and tenure" (*Id.*).

In sum, the Second Circuit properly corrected the clear errors of law made in the district court and applied the fair use doctrine to the particular factual circumstances of this case, taking into account the specific context of scholarly scientific research.

CONCLUSION

For the foregoing reasons, the Petition for Certiorari should be denied.

August 11, 1989

Respectfully submitted,

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Of Counsel

APPENDIX

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

HEIDI S. WEISSMAN, M.D.,

Plaintiff,

— against —

87 Civ. 6069 (MP)

LEONARD M. FREEMAN, M.D.,

Defendant.

JUDGMENT

In accordance with the Order of the Court of Appeals filed February 23, 1989 and issued as a mandate April 24, 1989 ordering, adjudging and decreeing that the Judgment previously entered herein May 11, 1988 be affirmed in part, reversed in part and remanded for further proceedings in accordance with the Opinion of the Court of Appeals dated February 23, 1989, it is

ORDERED, ADJUDGED and DECREED:

1. That the article entitled "Hepatobiliary Imaging," (plaintiff's Exhibit 1 or P-1) is a copyrightable derivative work owned by the plaintiff, Heidi S. Weissman, M.D., as registered on November 9, 1987, in the Office of the Register of Copyrights under Entry No. TX:2-172-705;

2. That defendant Freeman's use of plaintiff's aforesaid article (P-1), complained of by plaintiff, was not a fair use of it and therefore constituted copyright infringement;

3. That defendant be and hereby is permanently enjoined from reproducing copies of, or otherwise using in violation of plaintiff's exclusive rights therein under the Copyright Act, copyrighted material contributed by the plaintiff to the aforesaid article (P-1), excluding material previously incorporated in the parties' joint-work syllabi, material authored or created in whole or in part by the defendant and material not authored or created in whole or in part by plaintiff.

4. That the defendant's application for an award of attorneys' fees pursuant to 17 U.S.C. § 505 and Rule 11, Fed.R. Civ.P., is denied; and

5. That the plaintiff, Heidi S. Weissman, M.D., residing at 29 West Church Road, Saddle River, New Jersey 07458 recover of the defendant Leonard M. Freeman, M.D., residing at 11 Verity Lane, Roslyn, New York 11576 the costs and disbursements of this action incurred in this Court, to be taxed and entered herein by the Clerk and have execution therefor.

Dated: New York, New York
July 11, 1989

/s/ Milton Pollack
Milton Pollack
Senior United States District Judge

JUDGMENT ENTERED:

/s/ Raymond F. Burghardt
Clerk

The role of nuclear medicine in evaluation of hepatobiliary disease has been drastically altered by the advent of the technetium 99m iminodiacetic acid (Tc-99m IDA) derivatives (1, 2). Cholescintigraphy has a primary role in the diagnosis of acute cholecystitis because of its ability to accurately depict cystic duct patency. The sensitivity, specificity, and overall accuracy in the acute clinical setting have been documented by numerous large series of patients to exceed 95% (3–7). In addition, its ability to detect acute acalculous cholecystitis (8), gallbladder perforation, and acute common duct obstruction extremely early in the clinical course, before positive results with other imaging techniques (e.g., ultrasonography [US]), has made cholescintigraphy an essential imaging procedure for evaluation of the acutely ill patient. The use of Tc-99m IDA cholescintigraphy for the detection of biliary leakage (9) (e.g., posttraumatic, postsurgical, spontaneous) and evaluation of complications associated with cholecystectomy, cholangiointestinal, and gastrointestinal anastomoses also has become well established (10, 11). Other indications include elucidation of defects on Tc-99m sulfur colloid liver scans, cholestasis (12), and selected cases of chronic right upper quadrant pain.

In order to appropriately utilize cholescintigraphy and US, an understanding of their relative strengths and weaknesses is essential. The information obtained from each is complementary. Technetium 99m IDA is an imaging agent that sensitively demonstrates every site where bile is forming and flowing, as well as functional changes that often precede anatomic responses in the development of biliary diseases. The major advantage of US is its exquisite anatomic resolution without the need for administration of contrast material.

Cholescintigraphy has the following advantages: (1) It is the best available examination for assessing cystic duct patency or occlusion, even in hyperbilirubinemia. (2) It is the most sensitive and specific imaging technique for the diagnosis of acute acalculous and calculous cholecystitis. (3) It can demonstrate gallbladder perforation: acute, subacute, chronic. (4) It can show surrounding anatomic structures and nonbiliary pathology. (5) It can demonstrate functional common bile duct obstruction before ductal dilatation occurs. (6) It is less dependent on technique than is sonography.

However, cholescintigraphy has certain limitations: (1) Its spatial resolution is inferior to that of sonography

From the Department of Nuclear Medicine, Montefiore Medical Center, Albert Einstein College of Medicine, Bronx, N.Y.

Plaintiff's
Exhibit 13

NEW MATERIAL WRITTEN AND

FIGURES SELECTED FOR RSNA - 1985

Hepatobiliary Imaging[1]

Heidi S. Weissmann, M.D.

sonographic findings.) (3) Occasionally cases of parenchymal liver disease (e.g., alcoholic hepatitis) or total parenteral nutrition may affect gallbladder filling. (4) Severe hepatic failure or sepsis may rarely interfere with hepatobiliary excretion of IDA compounds.

Advantages of US include the following. (1) It is the best available examination for detecting gallstones. (2) It can demonstrate gallbladder anatomy (e.g., size, wall thickness, pericholecystic fluid). (3) It can demonstrate surrounding anatomic structures without contrast media.

However, US has certain limitations: (1) It cannot provide functional information (e.g., cystic duct patency or occlusion). (2) Stones in cystic duct region are generally difficult to see. (3) US images are very dependent on technique (e.g., operator and equipment).

Technique

Patients should fast for 4–6 hours before intravenous injection of 1–5 mCi of Tc-99m IDA. This eliminates the possibility of interference with normal gallbladder filling by physiologic, postprandial gallbladder contraction. The usual dose is between 3 and 5 mCi. As little as 1 mCi has been successfully used in anicteric adults, and doses larger than 5 mCi may be helpful in cases of severe hyperbilirubinemia. A large field-of-view scintillation camera is preferable but not absolutely necessary. The camera should be positioned so that the

While the exact imaging sequence may vary from one institution to the next, there are two general principles to keep in mind when selecting a protocol. First, the procedure should be monitored as it is progressing, since cholescintigraphy is a dynamic study of hepatobiliary function. If a question arises, the answer may be lost if it is not worked out immediately, as labeled bile flows away from the area of concern or the region of interest becomes obscured by other structures that subsequently come into view. Thus, in the interest of greatest accuracy and reliability, the images should be examined as they are obtained. Second, it is most helpful if scintiphotos are obtained in the first 30–45 minutes with sufficient frequency to indicate how structures are filling and emptying. Hence, we prefer to obtain a scintiphoto at 1 minute for the blood pool phase, followed by views every 5 minutes for the first half hour. We then obtain a scintiphoto at 45 minutes and one at 60 minutes. At the end of 1–1½ hours, in a normal individual, the entire biliary system and duodenum should be visualized. If, for any reason, any of these structures are not identified, delayed views at 1½, 2, and 4 hours are obtained. The study may be terminated earlier if there is no significant persistence of hepatic activity when the intestinal activity is excluded from the field of view by a lead shield. Delayed views up to 24 hours may be useful in clinical situations known to promote biliary stasis, for example, prolonged fasting, hyperalimentation, alcoholism. Pharmacologic intervention with cholecystokinin or morphine administration has been suggested as a way to shorten the exam (14, 15).

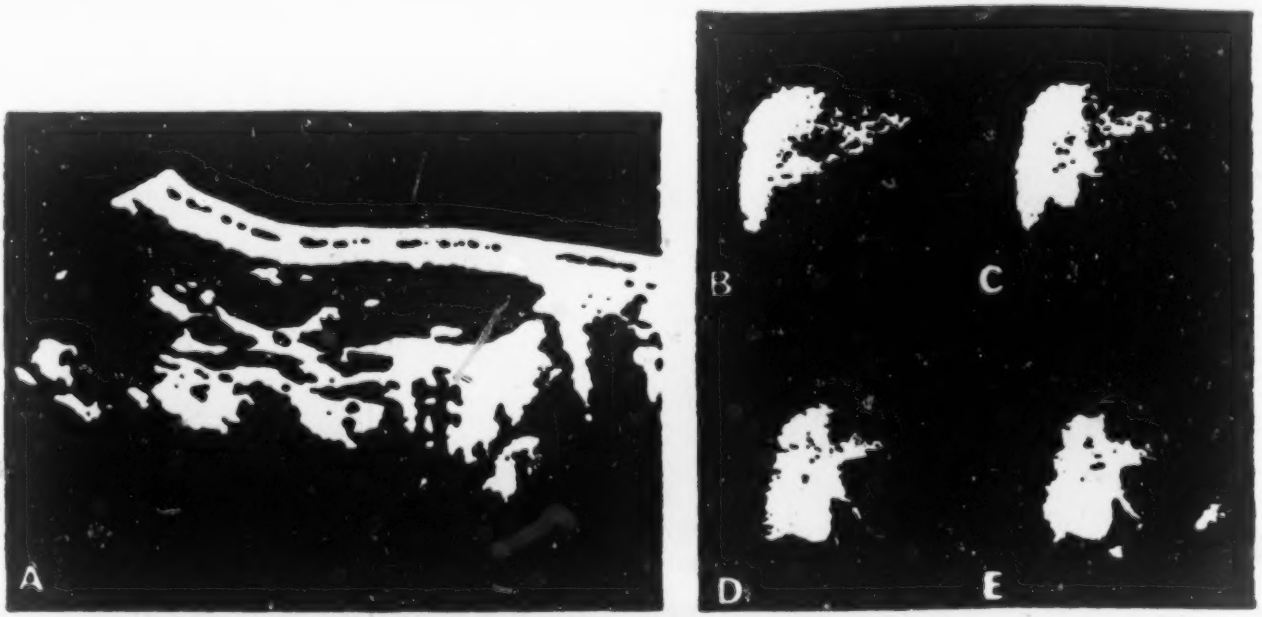


Figure 1. Cholelithiasis without acute cholecystitis (A) Longitudinal sonogram shows a calculus in the gallbladder with acoustic shadowing (B–E) Normal sequential series of IDA images in same patient, thereby ruling out cystic duct obstruction. (Reprinted, with permission, from reference 13.)

(e.g., generally does not reveal calculi). (2) Occasionally, a case of chronic cholecystitis may be associated with absent gallbladder visualization, even on delayed views. (However, this is a far less frequent cause of false-positive diagnosis for acute cholecystitis than with

liver, common bile duct, gallbladder, duodenum, and jejunum are included in the field of view. The anterior view is routinely obtained with each scintiphoto consisting of 500,000 counts. Additional views are obtained as the clinical situation dictates (13).

Figure 2. Nonvisualization of the gallbladder on an IDA cholescintigram in a patient with acute cholecystitis. Sequential scintigraphs at 5 minutes (A), 25 minutes (B), 45 minutes (C), and 90 minutes (D) show prompt hepatic uptake, excellent ductal visualization, and normal excretion into the intestine. Lack of gallbladder visualization, including a 4-hour follow-up view (not shown), indicates cystic duct obstruction. (E) Normal US examination, same patient. (Reprinted, with permission, from reference 16.)

Acute Cholecystitis

At many institutions technetium 99m IDA cholescintigraphy has become the diagnostic procedure of choice when acute cholecystitis is suspected because it is the most sensitive, accurate test available to answer the key diagnostic imaging question, Is the cystic duct patent (Fig. 1) or obstructed (Fig. 2) (3, 5–8)? Cystic duct obstruction is the most significant imaging finding because more than 95% of cases of acute cholecystitis are associated with such obstruction at some point in the development of the disease (Fig. 2). Cholelithiasis, on the other hand, is not a sine qua non for acute cholecystitis in view of its prevalence in the United States (20 million Americans). Hence, documenting cholelithiasis in a patient presenting with acute abdominal pain is insufficient evidence that the stones are the cause of the patient's acute clinical presentation (16, 17). Cholelithiasis has been an incidental finding in up to 50% of patients, particularly elderly patients, presenting with

A
B
C
D

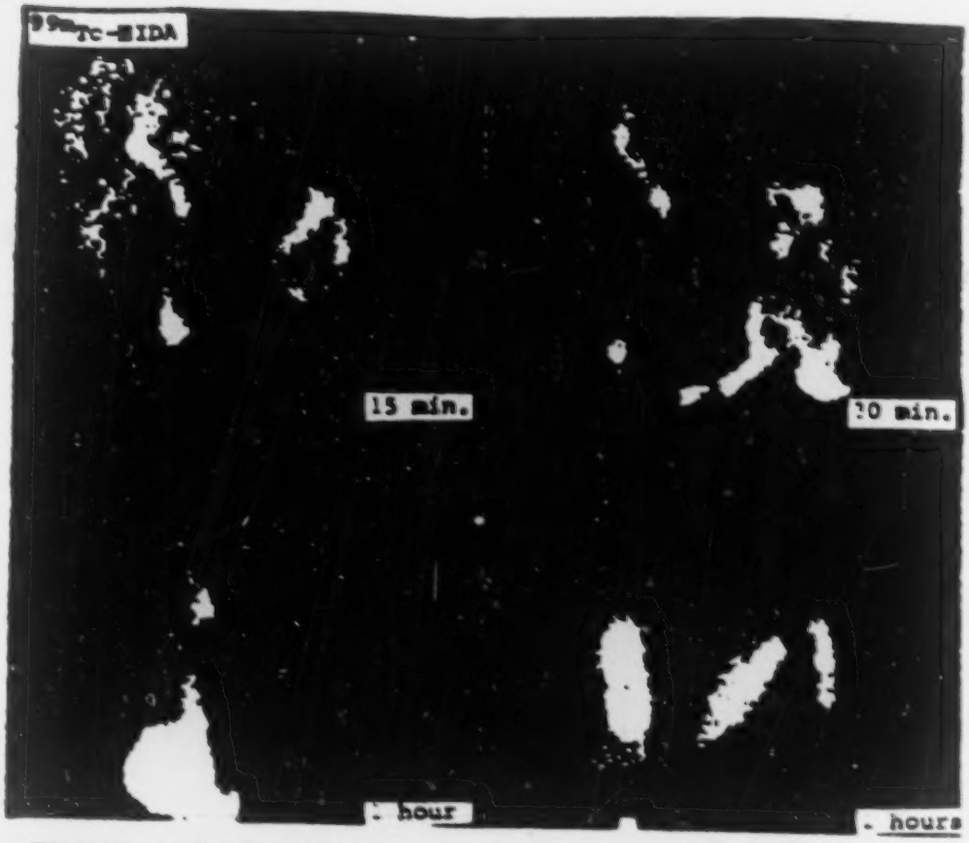


Figure 3. Delayed gallbladder visualization in chronic cholecystitis. Sequential scintiphotos through 1 hour show good filling of the common bile duct and prompt excretion into the intestine. The 1½-hour study (not shown) also failed to demonstrate gallbladder visualization. The gallbladder finally fills at 2 hours. (Reprinted, with permission, from reference 15.)

symptoms suspicious for acute cholecystitis (Fig. 1). The incidence of asymptomatic cholelithiasis has been shown to increase with increasing age in autopsy series.

Technetium 99m IDA imaging has many advantages that make it the procedure of choice for suspected acute cholecystitis. It is a rapid, safe, and simple procedure that provides functional as well as anatomic information. There are no absolute contraindications, and the only relative contraindication is pregnancy. Cholescintigraphy has proved to be more accurate and reliable than other modalities previously and currently in use. For example, evaluation of 323 consecutive patients revealed an overall accuracy of 97.6%; the false-positive rate was 0.58% and the false-negative rate, 4.8% (4).

The primary diagnostic criterion is the presence or absence of gallbladder visualization, corresponding to cystic duct patency and obstruction, respectively. A normal cholescintigram effectively excludes the possibility of acute cholecystitis (Fig. 1), whereas persistent nonvisualization of the gallbladder (up to 4 hours) despite prompt hepatic uptake and excretion (Fig. 2) has proved diagnostic in the acute clinical setting. When gallbladder visualization is delayed (between 1 and 4 hours), chronic cholecystitis is considered much more likely (Fig. 3). However, the possibility of acute inflammatory disease is not definitely excluded, because about 3.5% of patients with acute cholecystitis exhibit delayed gallbladder visualization.

Additional cholescintigraphic advantages in the acute clinical setting include the ability to detect other causes of significant biliary pathology that can mimic the acute clinical presentation of acute cholecystitis, such as gallbladder perforation (Fig. 4) and acute common duct obstruction (Fig. 5). In numerous instances, cholescintigraphy shows these abnormalities very early in their pathophysiologic development, frequently before sonography and occasionally even before the liver function tests are abnormal. If a persistent hepatocyte phase without biliary visualization is obtained in an acutely ill patient, common duct obstruction is the most likely cause. Although this scintigraphic pattern is not pathognomonic, in this clinical setting it strongly suggests a significant common duct obstruction (positive predictive value greater than 95%). Typically, sonography is falsely negative in these cases (70%) (13). This is probably due to the fact that the ducts have not yet dilated in response to the obstruction, or that choledocholithiasis can result in transient and intermittent obstruction, of the "ball-valve" type, such that the ducts may never dilate to be sonographically detectable. Therefore, sonography is only helpful in these instances if it is positive. If the US study is negative for biliary obstruction, further evaluation with endoscopic retrograde pancreaticoduodenography or percutaneous transhepatic cholangiography is warranted.

A-6
E-47

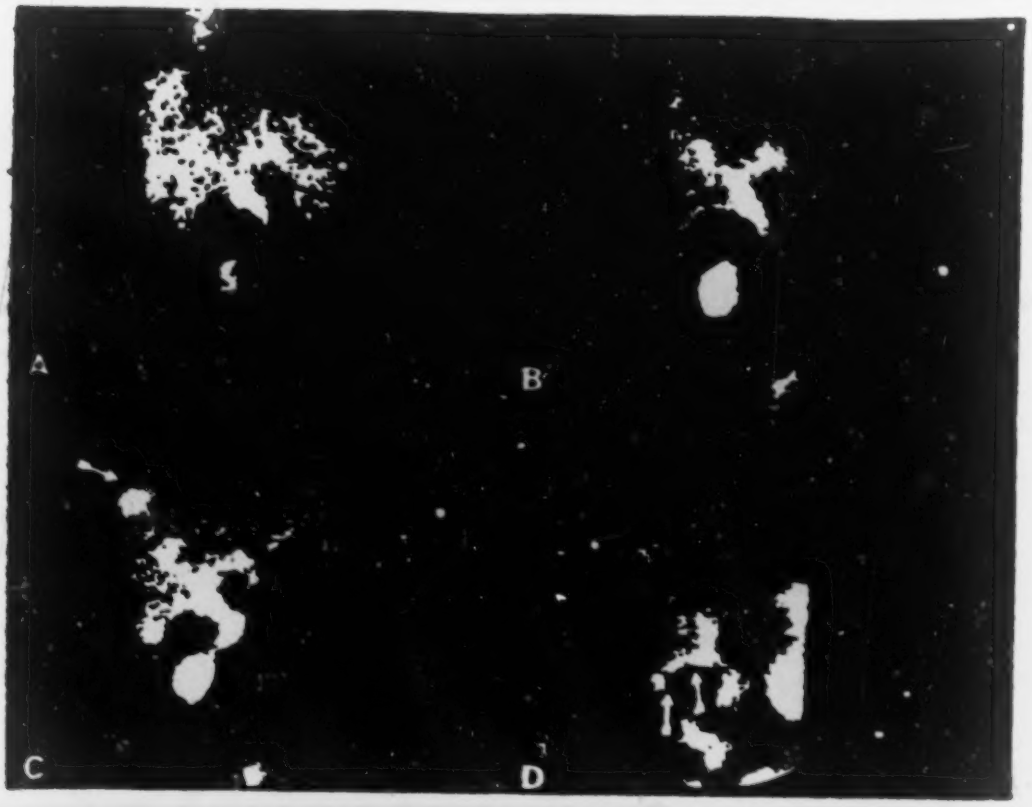


Figure 4. Acute acalculous cholecystitis with perforation. This 77-year-old woman had had an acute myocardial infarction several days earlier. She had severe right upper quadrant pain for 24 hours. At 15 (A) and 30 minutes (B), the common bile duct and intestine are visualized. At 1 hour (C), a hot spot appears at the dome of the right lobe (arrow). A minimal amount of activity along the right lower liver margin also appears at 1 hour and persists at 2 hours (D) (arrows), as does the hot spot. This represents delayed visualization of a subtotally obstructed cystic duct and gallbladder. The hot spot represents leakage. Sonography showed "sludge" only. Because of patient's poor clinical condition, a laparotomy was performed under local anesthesia. A coin-sized area of ischemic necrosis of the gallbladder fundus with bile leakage was identified and resected. A cholecystostomy tube was inserted. Vascular insufficiency was thought to be the most likely cause of the acalculous cholecystitis. (Reprinted, with permission, from reference 13.)

A-7

E-48

False-Positive Studies for Acute Cholecystitis

Several causes of false positive IDA studies have been reported. These are as follows.

Chronic cholecystitis.—There are several possible explanations for this finding. As shown by Freitas et al. (18), the most important problem lies in pathologic classification as to what histologically constitutes acute cholecystitis. It is much more appropriate to utilize liberal criteria (cystic duct stone, focal changes, etc.) rather than strict criteria (transmural inflammatory changes).

Other problems include (1) difference in statistical criteria used; (2) defining nature of disorder being studied, for example, acute cholecystitis versus "gallbladder disease"; (3) symptoms of patient population selected, for example, acute, subacute, chronic; and (4) delayed views, failure to perform, or misinterpretation of significance.

Acute pancreatitis.—Edlund et al. (19) reported that five of seven cases of acute pancreatitis failed to show "normal IDA visualization." The studies were terminated at 1 hour, therefore, the possibility of delayed gallbladder visualization was ignored. This is particularly important to assess in this clinical context because of the strong possibility of biliary pancreatitis. Additionally, the cases were not well documented, and this study has been refuted by five separate reports (20–24) that showed no false-positive results in a total of 152 patients studied. Most important, the IDA study was found in these studies to be a superb means of distinguishing between biliary and nonbiliary causes of pancreatitis.

Alcohol abuse (e.g., hepatitis and cirrhosis).—Shuman et al. (25) reported nonvisualization or delayed visualization of the gallbladder in 20 of 41 alcoholics. Nine of the 20 presumably had false-positive results. Twenty-nine alcoholic patients in three separate series with nonbiliary acute pancreatitis had normal studies. In the series of Serafini et al. (20), six alcoholic patients with biliary pancreatitis had abnormal studies, correctly predicting that biliary disease and not alcohol was the culprit.

Total parenteral nutrition.—Shuman et al. (25) encountered great difficulty in this area, which is also associated with prolonged fasting. Although our prob-

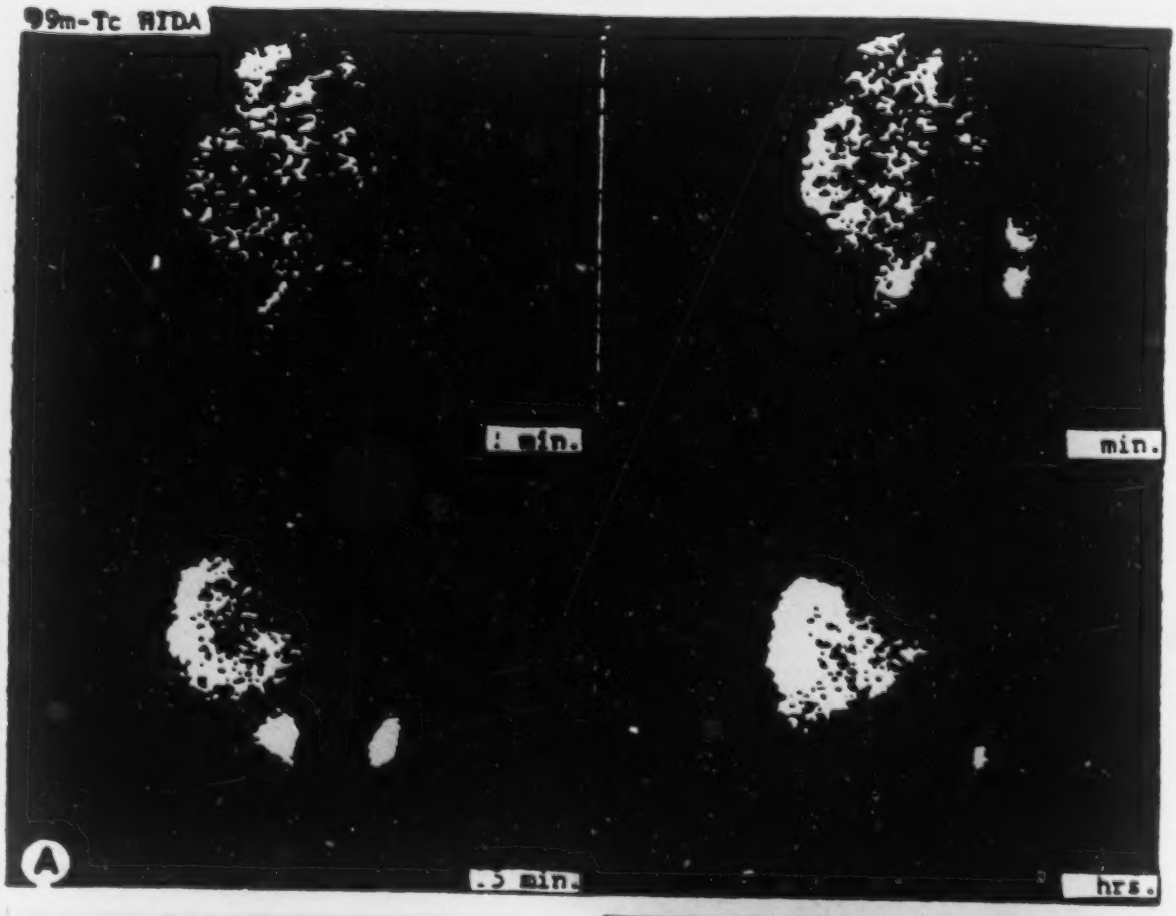
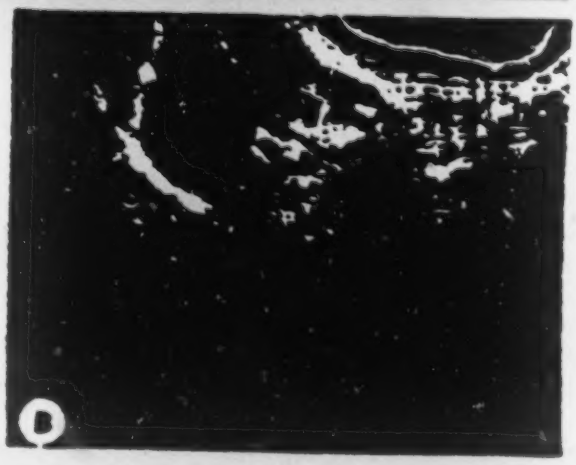


Figure 5. Complete obstruction of the common bile duct. (A) Sequential Tc-99m dimethyl IDA images over 3 hours show initially slow hepatic uptake with subsequent good peaking of activity at 15 minutes. Enhanced renal excretion is also apparent up to this point. At 3 hours, there is still total retention of the radiotracer in the liver. (B) US examination 1 hour later shows a normal-sized common hepatic duct (arrow). The intrahepatic and common bile ducts (not shown) also appeared normal. Common bile duct calculi were found at laparotomy. (Reprinted, with permission, from reference 13.)



lems in this area have been minimal, it warrants further study. Since this population is definitely more susceptible to acalculous cholecystitis, nonvisualization of the gallbladder may be of prognostic significance. Identification of this altered physiologic state may be identifying those patients who would benefit from routine cholecystokinin therapy to keep the gallbladder active and counteract bile stasis.

Prolonged fasting.—Larsen et al. (26) and Kalff et al. (27) have presented case reports suggesting problems in this area, but a well-controlled study of a series of patients is necessary to evaluate the effect of prolonged fasting and to determine if and when optimal fasting (see below) becomes "prolonged" fasting.

Inadequate fasting.—Using normal volunteers, Klingensmith et al. (28) reported that seven of 11 gallbladders were not visible when studies were commenced 15–30 minutes after a meal (64% false-positive results). All 11 cases had visualized normally following an overnight fast. Baker et al. (29) had shown earlier similar results with Tc-99m PG (pyridoxylidene glutamate).

Overall, in regard to the controversies that have existed concerning cholescintigraphy and US in evaluating patients with acute cholecystitis, it is essential that we keep the proper perspective concerning patient care. The situation was beautifully summed up by James Caldwell (30), a gastroenterologist at Ohio State: "I believe that the choice of diagnostic procedure depends on what the clinician needs to know, and how rapidly he needs the answer. If the patient has a truly acute illness with supporting physical findings, a positive scintiscan will end the workup for the majority of otherwise healthy patients. If the patient has chronic biliary colic,

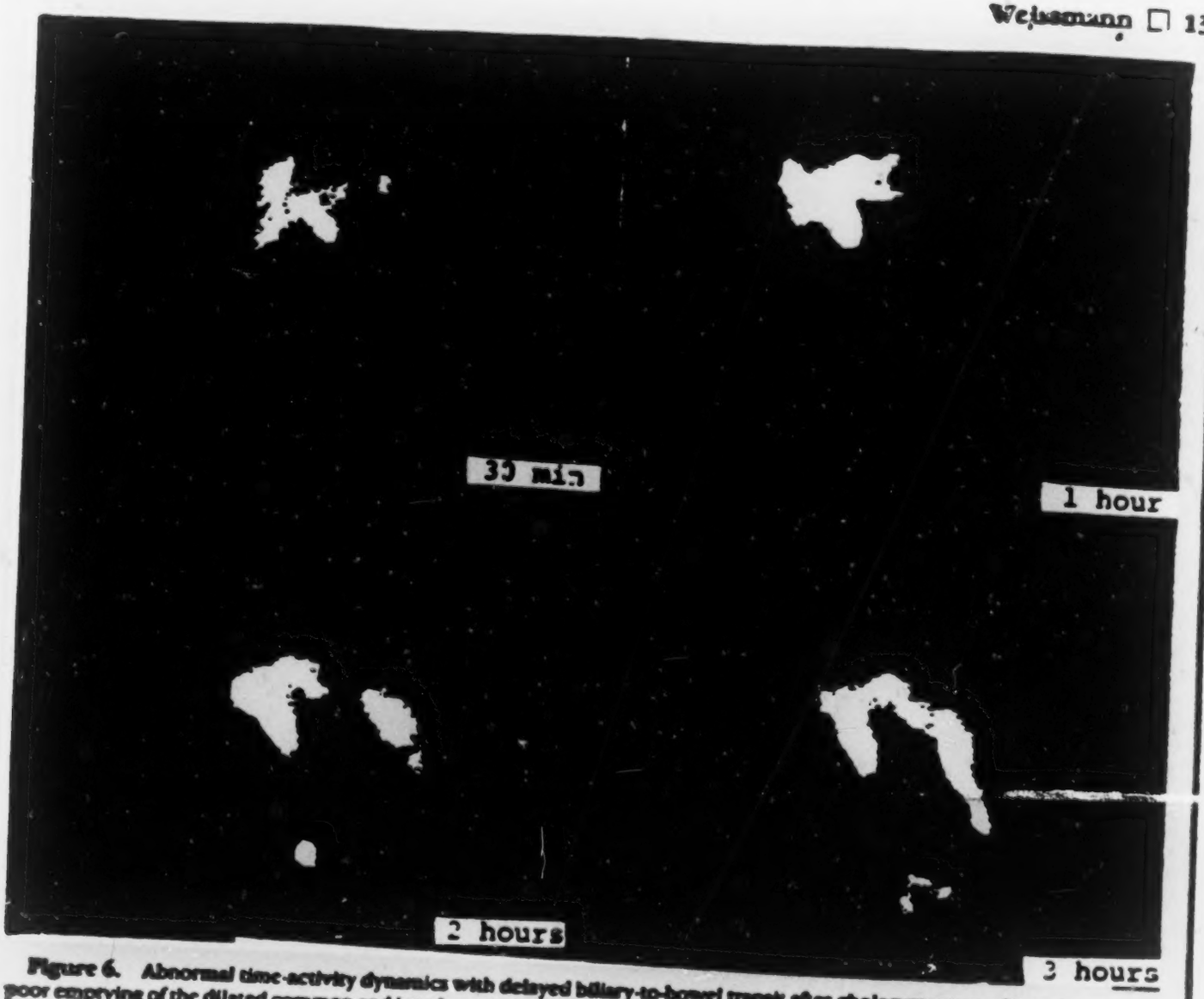


Figure 6. Abnormal time-activity dynamics with delayed biliary-to-bowel transit after cholecystectomy. Note the very poor emptying of the dilated common and intrahepatic ducts. The amount of ductal activity at 2 and 3 hours does not significantly change from the 1-hour study. (Reprinted, with permission, from reference 11.)

and is not acutely ill, ultrasound may be positive for stones while scintiscanning may be negative."

Caldwell concludes his article by saying, "We should not labor in a clinical vacuum, and our tests should not be disembodied images unconnected to the total clinical problem. When diagnostic uncertainty exists, consultation among all involved physicians is in order. Understanding by clinicians of differences in techniques, equipment, technical support, imaging agents and experience should resolve conflicts in the patient's interest."

Serendipitous Detection of Nonbiliary Pathology

Clearly, cholescintigraphy is performed to evaluate the biliary system. However, important additional information can be obtained by examining the four nonbiliary phases of this study: blood pool, hepatocyte, renal excretory, and intestinal. In 9.5% of cases, the serendipitous detection of previously unsuspected nonbiliary pathology correctly directed the patient's work-up away from the erroneously suspected acute cholecystitis and toward the true source of the patient's acute symptoms (31).

Chronic Cholecystitis

The clinical utility of cholescintigraphy in chronic cholecystitis is limited by three major factors:

1. Since chronic cholecystitis is most commonly associated with cholelithiasis, the key question to be answered by imaging is, Are gallstones present? Cholescintigraphy does not have the anatomic resolution to demonstrate stones directly; therefore, US and oral cholecystography must be considered the diagnostic mainstays in chronic cholecystitis.

2. A patient with chronic cholecystitis usually has a functionally patent biliary system; therefore, normal re-

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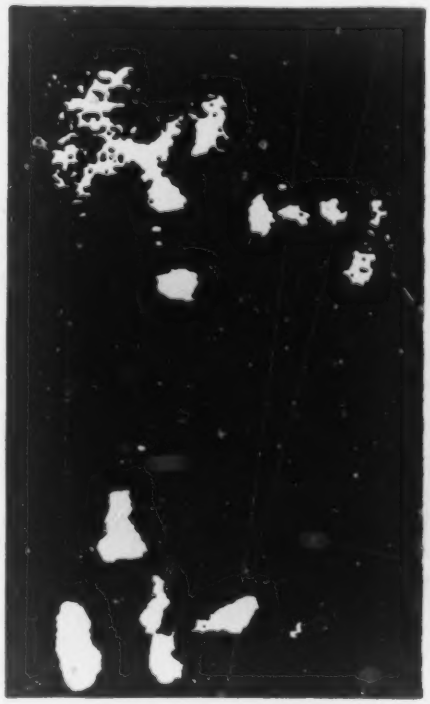

Figure 7. Patent biliary-enteric anastomoses. Free flow of Tc-99m IDA through a choledochoduodenostomy in one patient (a) and a choledochojejunostomy in another patient (b) is clearly demonstrated. (Reprinted, with permission, from reference 11.)

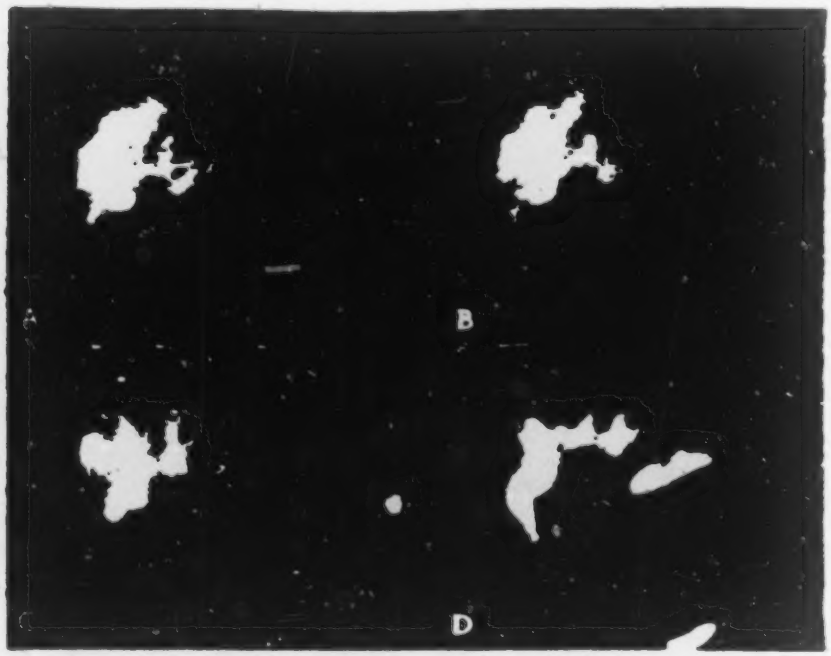

Figure 8. Patent choledochoduodenostomy. Dilated biliary radicles with free flow of Tc-99m IDA. Scintiphotographs obtained at 10 (A), 15 (B), and 25 (C) minutes show the dilated biliary tree with progression of labeled bile through the choledochoduodenostomy anastomosis. At the end of the first hour (D), most of the Tc-99m IDA had been excreted from the liver into the biliary tree and through the anastomosis into the intestine. Most intestinal activity was shielded by a lead apron to better visualize the dilated intrahepatic biliary radicles. The bypass was performed for obstructing choledocholithiasis. Despite the success of the surgery in relieving the obstruction, the biliary tree remained ectatic. This case illustrates that a dilated biliary system is not necessarily an obstructed system. (Reprinted, with permission, from reference 32.)

sults on a cholescintigram do not exclude the possibility of chronic cholecystitis.

3. Individuals with chronic cholecystitis exhibit a wide spectrum of cholescintigraphic patterns, depending on whether the cystic or common bile ducts are partially or completely obstructed by stones or sludge. While some of these patterns are highly suggestive—for example, delayed visualization of the gallbladder (Fig. 3)—none is truly pathognomonic for chronic cholecystitis. Nevertheless, in specific cases of chronic cholecystitis, IDA imaging has proved particularly useful, for example, in helping the clinician determine whether a patient with known chronic cholecystitis (usually documented by a previous OCG or sonogram) has acute symptoms because of a superimposed acute exacerbation of the known gallbladder disease. IDA imaging is also helpful in identifying the occasional false-negative OCG and sonogram in cases where clinical suspicion of chronic cholecystitis remains high despite a "normal" OCG or sonogram.

Postoperative Evaluation

Cholescintigraphy is extremely useful in evaluating patients postoperatively. For instance, in the symptomatic postcholecystectomy patient, visualization of a normal-sized duct that empties within 1 hour rules out significant pathology with a high degree of accuracy (97%). A spectrum of abnormal findings has been identified (11). Cholescintigraphy has also proved useful in detecting common duct obstruction (Fig. 6), cystic duct remnants, and bile leaks.

Patients who have undergone biliary enteric bypass surgery can be evaluated for patency of the anastomosis by cholescintigraphy, regardless of the level of the anastomoses, including hepatoduodenostomy, choledochoduodenostomy, choledochojejunostomy, etc. (Fig. 7). Unlike attempts at opacification with the iodinated contrast agents, the use of Tc-99m IDA allows routine visualization of the ducts and anastomosis without the need for a competent sphincter of Oddi (Fig. 8). In addition, it is a "physiologic" procedure that can clearly document the presence and preferential route of flow of an anastomotic bile leak (Fig. 9), as opposed to the nonphysiologic T-tube study, percutaneous cholangiography, and upper gastrointestinal series.

Detection of Biliary Leakage

Cholescintigraphy is useful in evaluating nonsurgical as well as surgical trauma. It is particularly well suited to the evaluation of patients with blunt abdomi-

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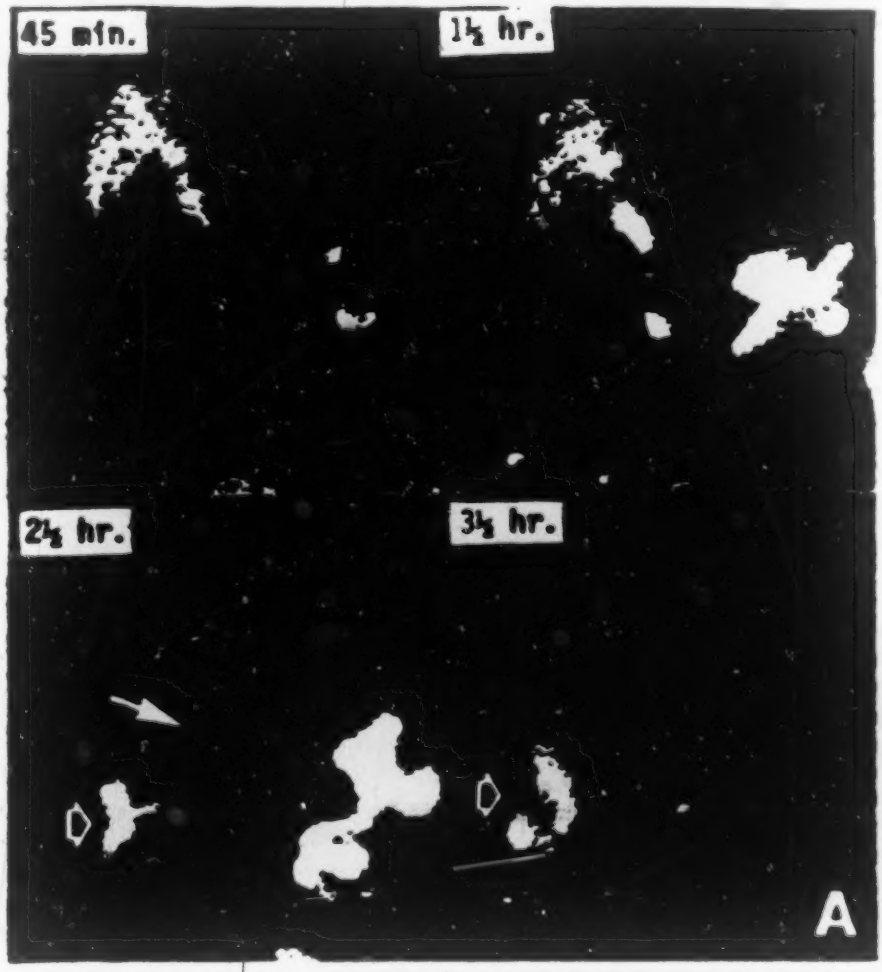

Figure 9. Anastomotic leak. (A) First postoperative Tc-99m IDA cholescintigrams (s/p cholecystectomy and choledochoduodenostomy). Radiotracer flows normally into the bowel on a 45-minute study. The 1½-hour image began to show a very faint tract of abnormal tracer activity in the anastomotic region, 2½-hour and 3½-hour images clearly demonstrate abnormal bile flow. Without the delayed (more than 1 hour) images, the anastomotic leak would have gone undetected. (Fig. 9 continued on next page.)

nal injuries because it does not require a communicating tract with the skin surface. It has also been found useful to obtain serial studies in cases of biliary leakage to evaluate the response to therapy, such as external drainage (Fig. 9) or the results of surgical intervention.

Cholestasis

The role of scintigraphy in cholestasis is limited by its poorer anatomic resolution, when compared with other procedures, such as US and CT. Nonetheless, it has proved useful as a screening procedure and in specific clinical situations, such as acute common bile duct obstruction and localized intrahepatic obstruction. Ideally, the best initial procedure in the evaluation of the jaundiced patient is sonography. Not only can it show ductal dilatation with a high degree of accuracy, but it also frequently demonstrates the level and cause of obstruction. However, since sonography requires greater technical expertise and physician participation, cholescintigraphy can be used as a screening procedure if US facilities are overburdened. The IDA derivatives allow visualization of the biliary tract in cases of hyperbilirubinemia. In particular, Tc-99m diisopropyl IDA (DISIDA) is well suited for imaging the nonobstructed biliary system and has enabled visualization of the patent biliary tree when the bilirubin level has been as high as 30 mg%. When a normal biliary tract is visualized in a jaundiced patient, no further workup for biliary obstruction need be pursued. On the other hand, when dilated, obstructed biliary radicles are seen and the level of obstruction is identified (Fig. 6), or a nondiagnostic study is obtained, further evaluation with the procedures that have better anatomic resolution should be done. In addition to its utility as a screening procedure, cholescintigraphy has at times been diagnostic of obstruction when other modalities such as sonography and transhepatic cholangiography have failed. These mainly include cases of acute common bile duct obstruction (where the functional abnormality of obstruction has been detected before the morphological change of dilation is present [Fig. 5] and occasionally even before the liver function tests have become abnormal) and areas of localized intrahepatic ductal obstruction.

Congenital Disorders

Technetium 99m IDA cholescintigraphy also has an important role to play in the diagnosis of congenital biliary disorders, such as differentiating between neonatal hepatitis and biliary atresia and evaluating neonatal hepatomegaly. Caroli disease, congenital hepatic fibrosis, and situs inversus (13).

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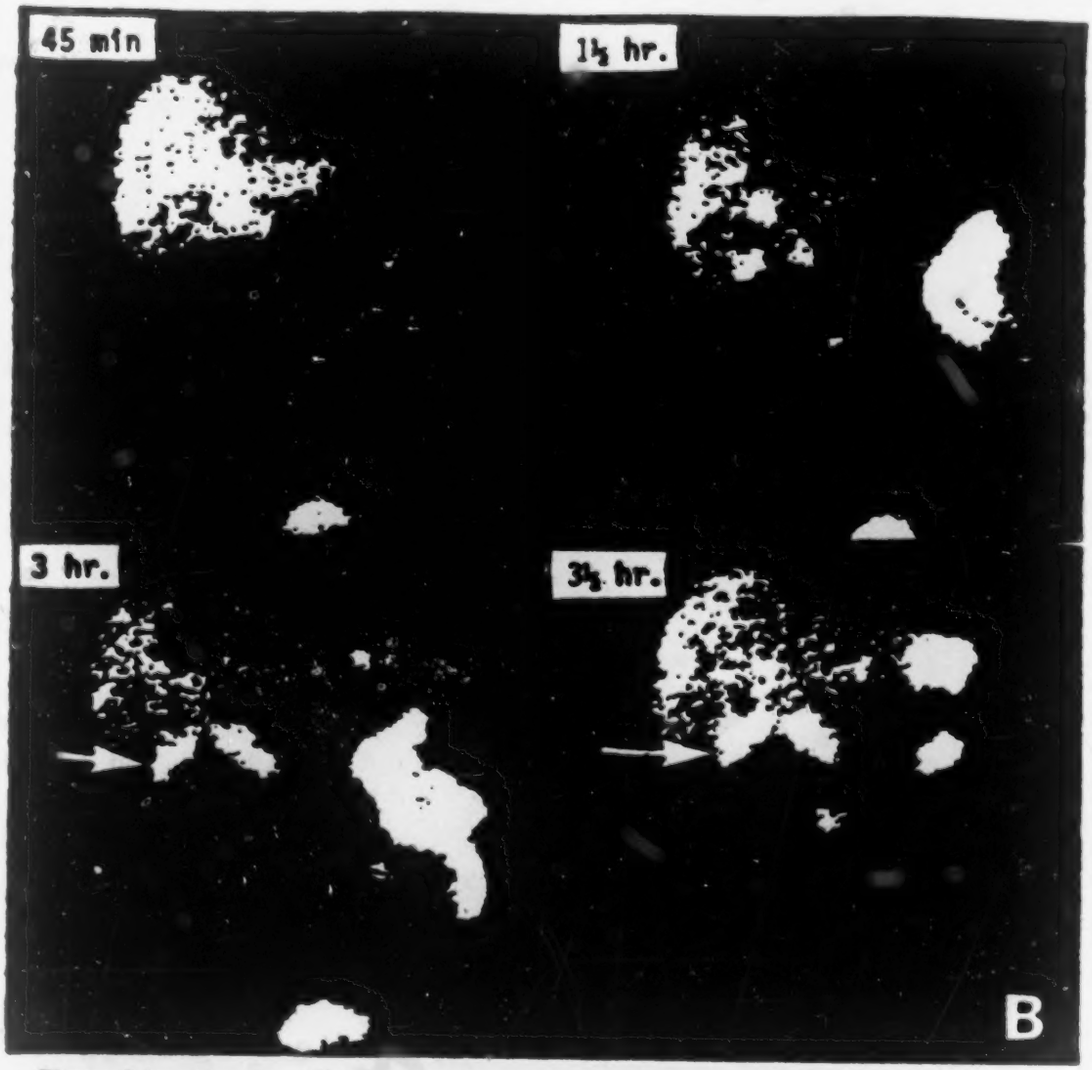

Figure 9 (*continued*). (B) Repeat Tc-99m IDA cholescintigrams 11 days after the first postoperative study and treatment with external drainage show significant improvement, with only small amount of activity in the cavity that had formed (arrows). (Reprinted, with permission, from reference 33.)

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References

1. Harvey E, Loberg M, Cooper M. Tc-99m-HIDA. A new radiopharmaceutical for hepatobiliary imaging (abstr.). J Nucl Med 1974; 16:533.
2. Loberg M, Cooper M, Harvey E, Callery P, Faith W. Development of a new radiopharmaceutical based on N-substitution of iminodiacetic acid. J Nucl Med 1976; 17:633–638.
3. Weissmann HS, Frank MS, Bernstein LH, Freeman LM. Rapid and accurate diagnosis of acute cholecystitis with ^{99m}Tc-HIDA cholescintigraphy. AJR 1979; 132:523–526.
4. Weissmann HS, Bedia J, Sugerman LA, Kluger L, Rosenblatt R, Freeman LM. Spectrum of 99m-Tc-IDA cholescintigraphic patterns in acute cholecystitis. Radiology 1981; 138:167–173.
5. Soyer CA, Block F, Bernstein D, Serafini A, Rodman G Jr, Zeppa R. The role of HIDA/PIPIDA scanning in diagnosing cystic duct obstruction. Ann Surg 1980; 191:591–596.
6. Freiman JE, Fink-Bennett DM, Thrall JH, et al. Efficacy of hepatobiliary imaging in acute abdominal pain. concise communication. J Nucl Med 1980; 21:919–924.
7. Inbibick RE, Cutto JA, Fink-Bennett D, Ventura V. Hepatobiliary scanning in the diagnosis of acute cholecystitis. Arch Surg 1980; 115:940–944.
8. Weissmann HS, Berkowitz D, Pon M, Rosenblatt R, Sugerman LA, Freeman LM. The role of technetium-99m-iminodiacetic acid (IDA) cholescintigraphy in acute acalculous cholecystitis. Radiology 1983; 146:177-180.
9. Weissmann HS, Byun KJC, Freeman LM. Role of Tc-99m IDA scintigraphy in the evaluation of hepatobiliary trauma. Semin Nucl Med 1983; 13:199–222.
10. Rosenthall L, Fonseca C, Arnoumanian A, Hernandez M, Greenberg D. ^{99m}Tc-IDA hepatobiliary imaging following upper abdominal surgery. Radiology 1979; 130:735–739.
11. Weissmann HS, Gliedman ML, Wilk PJ, et al. Evaluation of the postoperative patient with ^{99m}Tc-IDA cholescintigraphy. Semin Nucl Med 1982; 12:27–52.
12. Weissmann HS, Rosenblatt R, Sugerman LA, Freeman LM. The role of nuclear imaging in evaluating cholestasis. an update. Semin Ultrasound 1980; 1:134–142.
13. Weissmann HS, Freeman LM. Biliary tract. In: Freeman LM, ed. Freeman and Johnson's clinical radionuclide imaging. 3d ed. Orlando, Fla.: Grune & Stratton, 1984; 879–1049.
14. Choy D, Shi BC, McLean RG, Hoschl R, Murray IP, Ham JM. Cholescintigraphy in acute cholecystitis. use of intravenous morphine. Radiology 1984; 151:203–207.
15. Freeman LM, Sugerman LA, Weissmann HS. Role of cholecystokinetic agents in ^{99m}Tc-IDA cholescintigraphy. Semin Nucl Med 1981; 9:186–193.
16. Weissmann HS, Rosenblatt R, Sugerman LA, Freeman LM. An update in radionuclide imaging in the diagnosis of cholecystitis. JAMA 1981; 246:1354–1357.

17. Freitas JE, Markus SH, Fink-Bennett DM, et al. Suspected acute cholecystitis: comparison of hepatobiliary imaging versus ultrasonography. Clin Nucl Med 1982; 7:362–367.
18. Freitas JE, Coleman RE, Nagle CE, et al. Influence of scan and pathologic criteria in the specificity of cholescintigraphy. J Nucl Med 1983; 24:876.
19. Edlund G, Kempi V, van der Linden W. Transient nonvisualization of the gallbladder by Tc-99m HIDA cholescintigraphy in acute pancreatitis. J Nucl Med 1982; 23:117.
20. Ali A, Turner DA, Fordham EW. Tc-99m IDA cholescintigraphy in acute pancreatitis. J Nucl Med 1982; 23:857.
21. Serafini A, Al-Sheikh W, Barkin JS, et al. Biliary scintigraphy in acute pancreatitis. Radiology 1982; 144:591.
22. Fonseca C, Greenberg D, Rosenthall L, et al. ^{99m}Tc IDA imaging in the differential diagnosis of acute cholecystitis and acute pancreatitis. Radiology 1979; 130:525.
23. Glaser G, Murphy F, Claydes GS. Radionuclide biliary scanning in acute pancreatitis. Br J Surg 1981; 68:766.
24. Frank MS, Weissmann HS, Chun KJ, et al. Visualization of the biliary tract with Tc-99m HIDA in acute pancreatitis (abstr.). Gastroenterology 1980; 78:1167.
25. Shuman WP, Gibbs R, Rudd TG, et al. PIPIDA scintigraphy for cholecystitis: false positives in alcoholics and total parenteral nutrition. AJR 1982; 138:1.
26. Larsen MJ, Klingensmith WC, Kuni CC. Radionuclide hepatobiliary imaging: non-visualization of the gallbladder secondary to prolonged fasting. J Nucl Med 1982; 23:1003.
27. Kalff V, Froelich JW, Lloyd R, et al. Predictive value of an abnormal hepatobiliary scan in patients with severe intercurrent illness. Radiology 1983; 146:191.
28. Klingensmith WC, Spitzer VM, Pritzberg AR, et al. The normal fasting postpostprandial diisopropyl-IDA Tc-99m hepatobiliary study. Radiology 1981; 141:771.
29. Baker RJ, Marion MA. Scanning with Tc-99m pyridoxylidene-glutamate—the effect of food in normal subjects. J Nucl Med 1977; 18:793.
30. Caldwell JH. Ultrasound vs. radionuclide scan in evaluation of acute right upper quadrant abdominal pain: clinician's comments. J Clin Ultrasound 1983; 11:201.
31. Weissmann HS, Sugarman LA, Frank MS, Freeman LM. Serendipity in technetium-99m dimethyl iminodiacetic acid cholescintigraphy. Radiology 1980; 135:449–454.
32. Weissmann HS. Cholescintigraphy. In: Berk R, Perrucci J, Leopold G, eds. Radiology of the gallbladder and bile ducts. Philadelphia: Saunders, 1983.
33. Weissmann HS, Chun KJ, Frank M, et al. Demonstration of traumatic bile leakage with cholescintigraphy and ultrasonography. AJR 1979; 133:843.

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No. 89-114

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TABLE OF AUTHORITIES

Cases:	PAGE
Consumers Union of U.S., Inc. v. General Signal Corp., 724 F.2d 1044 (2d Cir. 1983), *cert. denied*, 469 U.S. 823 (1984)	11
Dow Jones & Co. v. Board of Trade, 546 F. Supp.113 (S.D.N.Y. 1982)	11
Eden Toys, Inc. v. Florelee Undergarment Co., 697 F.2d 27 (2d Cir. 1982)	9
Edward B. Marks Corp. v. Jerry Vogel Music Co., 140 F.2d 266 (2d Cir. 1944)	8
Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985)	11
Picture Music, Inc. v. Bourne, Inc., 314 F. Supp. 640 (S.D.N.Y. 1970), *aff'd on other grounds*, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997 (1972)	7
Rosemont Enters., Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967)	10
Shapiro, Bernstein & Co. v. Jerry Vogel Music Co., 161 F.2d 406 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947)	8
Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984)	10
Time Inc. v. Bernard Geis Associates, 293 F. Supp. 130 (S.D.N.Y. 1968)	11
Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 626 F.2d 1171 (5th Cir. 1980)	11

PAGE

Wainwright Securities Inc. v. Wall Street Transcript Corp., 558 F.2d 91 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978) 11

Weissmann v. Freeman, 868 F.2d 1313 (2d Cir. 1989) .. 6, 9

Williams & Wilkins Co. v. United States, 487 F.2d 1345 (Ct. Cl. 1973), *aff'd by an equally divided court*, 420 U.S. 376 (1975) 10

Statutes:

17 U.S.C. § 101 .....6, 7, 8, 9
17 U.S.C. § 107 10
17 U.S.C. § 201 8

Legislative Materials:

H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. (1976), *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659 8, 9

Other Authorities:

Ralph S. Brown, "The Widening Gyre: Are Derivative Works Getting Out of Hand?", *Cardozo Arts & Entertainment Law Journal* 1 (1984) 11

1 M. Nimmer, *Nimmer on Copyright* § 6.03 (1988) 7

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Cooperative work in science is now the norm rather than the exception. Without minimizing the contributions of the unique loner possessed of genius, it can fairly be said that advances in modern science are largely the result of collaborative effort. A glance at any scientific journal will show that the overwhelming majority of new advances are credited to teams, not to individuals.

Amici are physicians, scientists and professors of medicine from medical schools, hospitals and professional societies throughout the country. They file this brief in their personal capacities because the Second Circuit's decision regarding the interface of the definitions of "created," "joint work" and "derivative work" under the Copyright Act, and the applica-

tion of the "fair use" doctrine in the context of the relationship between a derivative work and its underlying joint work, gravely endangers collaborative research and writing.

Many physicians and professors routinely participate in collaborations of the type at issue in the instant case. These long-term joint efforts necessarily involve revisions, elaborations and updates of continually evolving scientific works. If, as the Second Circuit has held, one of the collaborators is able to appropriate the fruits of a lengthy collaboration by declaring (retroactively) that the most recent revision belongs to him or her alone, the bond of trust—an essential ingredient to such an endeavor—will be broken. As a result, American researchers and teachers will shun creative cooperation, and American science and society as a whole will suffer.

SUMMARY OF ARGUMENT

As the petition for certiorari points out, Dr. Weissmann took the product of four years of joint effort, revised it (as the parties had done, sometimes alone and sometimes together, for years) by adding a small amount of material, some of which was prepared by Dr. Freeman, and, *after* Dr. Freeman had used it in the accustomed manner, announced that the new revision was hers exclusively. The Second Circuit produced a strained and artificial interpretation of the Copyright Act to sanction this conduct, and ignored the obvious applicability to Dr. Freeman's actions of the fair use defense. Because of that decision's ominous implications for science, this Court should grant a writ of certiorari and reverse the decision below.

REASONS FOR GRANTING THE WRIT

I

WHEN A WORK DERIVED FROM THE PARTIES' PRIOR JOINTLY AUTHORED WORKS IS A JOINT DERIVATIVE WORK IS AN IMPORTANT QUESTION OF COPYRIGHT LAW WHICH HAS NOT BEEN, BUT SHOULD BE, SETTLED BY THIS COURT

The decision below insidiously undermines scientific teamwork in the United States. The Second Circuit has not only permitted respondent to appropriate the contributions of her colleague, mentor, and joint author, but has given her the weapon of copyright with which to defend her questionable act. Today a partner, tomorrow a competitor, enjoying the advantage of surprise and trading on the product of years of joint labor; this is the behavior the decision below rewards.

This is the first case since the enactment of the Copyright Act, 17 U.S.C. § 101 et seq., in which the interface of the definitions "created",[1] "joint work" and "derivative work" has been discussed by an appellate court. Because of the Act's definition of "created", the Second Circuit erroneously assumed that joint works and derivative works are mutually exclusive.[2] *Weissmann v. Freeman*, 868 F.2d 1313, 1315 (2d Cir. 1989). As hereinafter shown, this assumption runs contrary to the language of the Copyright Act and its legislative history.

---

1 Section 101 of the Copyright Act provides in relevant part:

> A work is "created" when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.

2 Specifically, the Second Circuit stated that this case presents "the novel question of whether a medical paper derived from the parties' prior jointly authored works is itself a joint work, or whether it is a copyrightable individual derivative work, the infringement of which gives rise to a cause of action under the Copyright Act . . ."

In addition, the Second Circuit's unsupported distinction between joint works and derivative works runs contrary to the longstanding expectations of innumerable scientists and medical researchers who continually work with one or more colleagues in creating and updating jointly authored works. Often, the authors alternate in updating these works with the reasonable assumption that copyright in the resulting derivative work will be jointly owned. In light of the widespread arrangements based on such expectations, it is imperative that the issue now be resolved by this Court.

Nothing in the Copyright Act or its legislative history compels the conclusion that a work of one author based on preexisting joint works of that author and another author cannot be a joint derivative work. Section 101 of the Copyright Act defines a "derivative work" as follows:

> A "derivative work" is a work based upon one or more pre-existing works, such as a translation, musical arrangement, dramatization, fictionalization, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work".

The term "joint work" is defined in § 101 of the Copyright Act as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." The essence of a joint work is a "joint laboring in furtherance of a preconcerted common design." 1 M. Nimmer, *Nimmer on Copyright* § 6.03 at 6-6 (1988). *See also Picture Music, Inc. v. Bourne, Inc.*, 314 F. Supp. 640, 645 (S.D.N.Y. 1970), *aff'd on other grounds*, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997 (1972) ("When two or more authors pursuing a common design together create a single work, they become joint owners of the work"). Thus, joint and derivative works are not mutually exclusive.

Joint authorship does not require the joint authors to make their respective contributions during the same period. *Nimmer*

at 6-7. *See Edward B. Marks Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266 (2d Cir. 1944). In *Marks*, a case decided under the 1909 Copyright Act (predecessor of the 1976 Copyright Act), a lyricist wrote the words for a song. Thereafter the lyricist's publisher procured a composer to write the music. In holding that the resulting song was a joint work, the court found it sufficient that the lyricist, at the time he wrote the words, intended them to be set to music, and that the composer, in writing the music, understood that it was for a particular set of lyrics. *Marks*, 140 F.2d at 266. The court stated:

> . . . it makes no difference whether the authors work in concert, or even whether they know each other; it is enough that they mean their contributions to be complimentary in that they are to be embodied in a single work to be performed as such.

Id. at 267. *See also Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947) (version of song "Melancholy Baby" held to be a joint work even though lyrics were substituted for those written earlier in personal collaboration with the composer).

The 1976 Copyright Act incorporates the *Marks* holding that an intention by the respective authors at the moment of their individual creations to merge the work with other works is sufficient to create a joint work upon such merger. Thus, the legislative history of § 201 states: "The touchstone [of a joint work] is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit." H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. at 120 (1976), *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5736.

It is possible, and indeed essential in the context of continually evolving scientific and medical research and writing, for the "created", "derivative work" and "joint work" provisions of the Copyright Act to protect the expectations of scientific collaborators. As each of two or more collaborators alternates in making editorial revisions, annotations, elaborations or other modifications, separate versions of the work are "created" pursuant to the definition set forth in § 101. When those

modifications rise to the level of original works of authorship, a derivative work is created. *See, e.g., Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 35 (2d Cir. 1982) (new contributions to pre-existing sketch of copyrighted fictional character were sufficiently original to create a derivative work); 17 U.S.C. § 101 (defining "derivative work"). If, as in the instant case, that derivative work was created by one or more of the collaborators of the pre-existing joint work with the intention that it be merged into the preexisting joint work, and if, as in the instant case, the collaborators of the preexisting joint work intended when they created the preexisting joint work that such a merger would occur, the new work is a joint, albeit derivative, work. As such, it is jointly owned by the authors of the preexisting work and the author of the modifications to that joint work.

In such a common enterprise, when one or more of the collaborators adds a new contribution to the preexisting joint work, it is hardly open to him or her to later claim that no merger was intended—a person is, of course, deemed to intend the obvious consequences of his actions. Because intent to merge, and *not* intent to create a derivative work or a joint work, is what governs under the Copyright Act (*see* 17 U.S.C. § 101 (defining "joint work"); H.R. Rep. at 120), later assertions as to intent are irrelevant. Thus, any claim by Dr. Weissmann that she did not intend to merge her new contribution into the parties' pre-existing joint works, as well as her assertion that she intended to create a derivative work in which she alone owned the copyright, must be disregarded. Her intent to create a joint derivative work was manifested by virtue of the merger itself.

The Second Circuit understood that joint authorship results where "each author intend[s] his or her contribution, at the time that it is created, to become part of a unitary work to which another will make *or already has made* a contribution" (emphasis added). *Weissmann*, 868 F.2d at 1319. In addition, the Second Circuit recognized that it is extremely common in scientific research for preexisting joint works to be continually evolving. *Id.* For the Court of Appeals to then hold that joint works and derivative works, as defined under the Copyright

Act, are mutually exclusive turns the copyright law on its head and sets a dangerous precedent for those involved in scientific and medical research. It confers upon a collaborator a unilateral right to change the joint author relationship without first putting the other co-authors on notice. If this decision is permitted to stand, the Copyright Act will become a trap for the unwary in the important, sensitive area of medical research, and serve as an impediment to collaboration.

II

THE EXTENT TO WHICH A JOINT AUTHOR OF PREEXISTING JOINT WORKS MAY FAIRLY USE A DERIVATIVE WORK BASED ON THE JOINT WORKS IS AN IMPORTANT QUESTION OF COPYRIGHT LAW WHICH HAS NOT BEEN, BUT SHOULD BE, SETTLED BY THIS COURT

Even assuming that Dr. Weissmann was entitled to appropriate the course syllabus to her own exclusive ownership, the doctrine of fair use should apply to protect her long-time collaborator's right to use the syllabus.

This Court has already recognized that copying an entire work can be fair use. *See Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 449-450 (1984) (in the case of off-the-air video taping "the fact that the entire work is reproduced . . . does not have its ordinary effect of militating against a finding of fair use"); *Williams & Wilkins Co. v. United States*, 487 F.2d 1345, 1361 (Ct. Cl. 1973), *aff'd by an equally divided court*, 420 U.S. 376 (1975) (photocopying of entire articles in medical journals by government medical research organization constituted fair use). However, this is the first time the issue has arisen in the context of a joint author's use of his co-author's derivative work incorporating preexisting joint works by the parties.

"Fair use" under § 107 of the Copyright Act codifies a limited privilege to use copyrighted material despite the lack of the copyright owner's consent. *See Rosemont Enters., Inc. v. Ran-*

dom House, Inc., 366 F.2d 303, 306 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967); Ralph S. Brown, "The Widening Gyre: Are Derivative Works Getting Out of Hand?", *Cardozo Arts & Entertainment Law Journal* 1, 23 (1984) ("[fair use] is a shield . . . it is a marvelous safety valve to relieve the pressures of literal insistence on rights.") The doctrine balances the exclusive rights of copyright owners against "the public's interest in dissemination of information affecting areas of universal concern such as art, science and industry." *Wainwright Securities Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978). The Second Circuit decision unjustifiably restricts the application of this "entirely equitable" doctrine. *See Time Inc. v. Bernard Geis Associates*, 293 F. Supp. 130, 144 (S.D.N.Y. 1968).

Equity requires that a joint author's use of his co-author's individual derivative work based upon the parties' preexisting joint works be deemed fair use. *Cf. Dow Jones & Co. v. Board of Trade*, 546 F. Supp. 113, 120 (S.D.N.Y. 1982) ("Authors of compilations . . . must be held to grant broader licenses for subsequent use than persons whose use is truly creative."). Here, the new elements of respondent's individual derivative work were merely additions to, and in fact could not have existed independent of, the parties' preexisting joint works. *See Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171, 1177 (5th Cir. 1980) (where the cover of a magazine constituted only part of a collective work, the fact that such part was itself the subject of a separate copyright was not found to be copying of an "entire" work). To deprive a joint author of the use, for teaching purposes, of a work derived from and wholly dependent upon his efforts is grossly unfair and defeats the equitable purpose of the fair use doctrine.

A finding of fair use by a joint author is particularly appropriate in the context of a factual work where copyright protection is narrower, and the corresponding application of the fair use defense greater, than in the case of works of fiction or fantasy. *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 563 (1985); *Consumers Union of U.S., Inc. v. General Signal Corp.*, 724 F.2d 1044, 1049 (2d Cir. 1983), *cert.*

denied, 469 U.S. 823 (1984) ("Since the risk of restraining the free flow of information is more significant with informational work, the scope of permissible fair use is greater."). To hold otherwise will result in instilling mutual mistrust in countless academic collaborators and promote a "race to update", to the detriment of American medical science and education.

CONCLUSION

For the foregoing reasons, a writ of certiorari should be granted and the decision of the Court of Appeals should be reversed.

August 14, 1989

Respectfully submitted,

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No. 89-114

IN THE

Supreme Court of the United States

OCTOBER TERM, 1989

LEONARD M. FREEMAN, M.D.,

Petitioner,

vs.

HEIDI WEISSMANN, M.D.,

Respondent.

OBJECTION AND BRIEF IN OPPOSITION TO MOTION FOR LEAVE TO FILE BRIEF AMICI CURIAE

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OBJECTION AND BRIEF IN OPPOSITION TO MOTION FOR LEAVE TO FILE BRIEF AMICI CURIAE

Respondent HEIDI S. WEISSMANN for the following reasons respectfully opposes the Motion to File a Brief Amici Curiae in support of the Petition proffered by Abass Alavi, M.D. et al. in their "personal capacities." (Amici Br. 4)[1]

[1] References to "Amici Br." are to the proffered Brief Amici Curiae followed by the page number. References to "Pet." and "Pet. App." are to the Petition for Certiorari and to the Appendix to the Petition for Certiorari, respectively. References to "Resp. Br." are to Respondent's Brief in Opposition to the Petition for Certiorari.

Preliminary Statement

Respondent did not consent to the filing of the Amici Brief for two reasons: first, counsel for the Amici, though requested to, did not advise respondent's counsel of the Amici's identities beyond indicating that they would be individual doctors; second, counsel for the Amici did not indicate the nature of the Amici's interest nor provide any reasons why they could add anything to the presentation of the Petition. As shown below, the disfavor for such briefs in support of a petition for certiorari, see Rule 36.1, has particular application here, in view of the failure of the Amici's Motion to specify their particular interests and reasons for believing that any questions involved in the Petition have not or cannot be adequately presented by the parties.

I.

THE AMICI ARE A NARROW GROUP OF INDIVIDUALS WHO ARE NOT REPRESENTATIVE OF THE COMMUNITIES FOR WHOM THEY PURPORT TO SPEAK

Petitioner's Amici are a narrow group of individual scientists, almost all medical doctors, specializing in the single field of nuclear medicine.[2] According to Respondent, a specialist in the same field, all of them are also long-time colleagues and personal friends of the petitioner. More significantly, not one of the Amici is a scientist or medical doctor in any other field and not one of them – including the eighteen (18) of the Amici who are department heads – has been able to interest any institution, professional society, hospital, publisher, drug or radiopharmaceutical company, writers' organization or any other representative body to join their attempt to suggest a basis for exercise of the Supreme Court's *certiorari* jurisdiction.

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[2] All of the Amici are also members of one society, of which petitioner is a past president, the Society of Nuclear Medicine, where various of them serve on committees with petitioner. Source: 1989 Membership Directory, Society of Nuclear Medicine.

If anything, the Amici's identities only demonstrate the total absence of any interest in the scientific and educational communities in participating in their effort. Thus, not one of the 74 existing organizations in the insular, specialty field in which both parties work as scientists, namely, radiology or nuclear medicine[3], has joined this effort, even though virtually every one of the Amici is a "Chief", "Chairman," "Director," or "Head" of his own institution's department of nuclear medicine (Amici Br. 4)[4] and even though many have served as head and/or president of various of these specialty organizations.[5] Particularly striking is the fact that not one of the institutions where 18 of the Amici serve as department heads has been willing to support their effort, including Montefiore Medical Center and the Albert Einstein College of Medicine where petitioner himself serves as Director of Nuclear Medicine and Vice Chairman of Nuclear Medicine, respectively. Finally worth noting is the absence of any other individual teacher or professional, let alone a department head, from petitioner's own places of professional activity in joining the Amici's effort.

II.

THE INDIVIDUAL AMICI ESPOUSE A VIEW THAT IS DISAPPROVED BY THEIR PROFESSION

The reason why the scientific, medical and research communities have shunned the Amici's efforts is their disapproval of the concept of "honorary authorship" which the Amici Brief

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[3] Source, "Organizations in Radiology 1989", published by American College of Radiology, 1891 Preston White Drive, Preston, Virginia 22091.

[4] Eighteen of the 21 amici appear to be in this category.

[5] The Amici cannot even speak for as narrow an organization as the Society of Nuclear Medicine, inasmuch as they form a distinctly minute group of 21 individuals out of 10,443 members. Source: "Organizations in Radiology 1989," *supra*, p. 70.

espouses.[6] The Amici, as department heads and very senior professionals, represent the interests of those who urge the creation of a legally privileged sanctuary for a practice that would require junior scientists to credit their superiors with copyright co-ownership on the basis of seniority, without regard to actual authorship efforts and without regard to the copyright laws which by statute apply equally in all fields to all kinds of works.

III.

INSTEAD OF SHOWING THAT THE PARTIES CANNOT ADEQUATELY PRESENT THE ISSUES, THE AMICI HAVE CONSTRUCTED A SERIES OF FALSE PREMISES AS THE BASIS FOR THEIR ARGUMENTS

The Motion of the Amici has omitted any showing of why the parties cannot adequately present the questions raised by the Petition. Not only have the parties adequately presented the issues, but their familiarity with the record and obligations to deal with it have required them, unlike the Amici, to address the key facts that the Amici Brief has chosen to disregard. Most significant here is the Amici's effort to build their argument upon the false factual premises that petitioner and respondent had been "alternat[ing]" in revising and preparing versions of the predecessor articles to the work at issue, P-1 (Amici Br. 8) and that "some" of the newly added material to P-1 "was prepared by Dr. Freeman" (*id.* 5). As respondent has demonstrated (Resp. Br. 3-4 and 10-14), petitioner conceded that he did not participate in

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[6] "Honorary authorship" is the term used to describe a procedure of requiring the addition of the names of chiefs, heads or other senior members of departments or laboratories on all research papers prepared by junior or less senior members. It has been generally condemned in the scientific community, including medicine in particular, because of the dangers it poses to the quality control and integrity of research, as well as its unfairness. *See, e.g.*, the "Guidelines for Investigators in Scientific Research" developed by the Harvard Medical School discussed in the *Journal of the American Medical Association*, October 1988, Vol. 260, No. 13, p. 1837; *see also* Vol. 241, July 29, 1988, p. 525, *Science* magazine, published by the American Association for the Advancement of Science.

creating any of P-1's new matter, and P-1's predecessors were *jointly* authored and owned.[7]

Because they are so divorced from the interests of the institutions, organizations and the authors, including less senior professionals, who finance and create scientific works, the Amici have also felt free to make assertions about the law having no basis in reality. Thus, without citation to any legislative or judicial authority, they boldly proclaim that when one of two joint authors adds a new contribution to an earlier joint work, he or she cannot claim any exclusive right in the newly added creation, *irrespective* of who participated in the new authorship of the paper and *irrespective* of the parties' intentions (at the time of the new writing) to have or not to have such individually-prepared new matter be part of a joint work. (Amici Br. 9) They similarly claim that the requisite mutual intention for a work like P-1 to be a joint work is automatically established or "manifested" by virtue of "the merger itself" of the new material (created by only one author) with the older pre-existing material (Amici 9). However, such an automatic rule would flow in all cases from any prior collaborative effort and continue forever in the absence of a "divorce" between once joint authors. This flies in the face of Section 103(b) of the Copyright Act and the specific explanation by the Congress in the legislative history that this is exactly the danger that has been eliminated by the way in which Section 103(b) works together with the definition of a "joint work"

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[7] Such inaccurate suggestions are accompanied by repeated statements about the usual "expectations" and "arrangements" supposedly made between collaborators who are both engaged in a continuing joint laboring (Amici Br. 7-8). But these have nothing to do with the work involved in this case, P-1, which was concededly not the result of a joint authorship effort. The Amici's additional portrayal of the Second Circuit as assuming that joint works and derivative works are mutually exclusive categories is belied by the very quotation from its opinion that the Amici set forth in footnote 2 ("joint work" versus "*individual* derivative work", Pet. App. A-3, [emphasis supplied]), as well as by the Court of Appeals' separate discussions of joint authorship and derivative works. These make it clear that the conclusion that P-1 is protectible as a derivative work played no role in the Second Circuit's separate evaluation of whether P-1 was a joint work. *See* Pet. App. A 7-21 and especially A-11.

in Section 101. *See* House Report at 120; Second Circuit opinion, Pet. App. A 8-9 & 10.[8]

The Amici's unrepresentative role as spokespersons for "honorary authorship" for senior professionals such as themselves has also led them astray in their fair use arguments. For example, they insist on an absolute fair use rule which, as they explain it, "requires that a joint author's use of his co-author's individual derivative work based upon the parties' preexisting joint works be deemed a fair use" (Amici Br. 11). This not only would nullify the statutory right of each co-author to use the joint work to prepare and own exclusively his own derivative work, *see* note 8 *supra*, but disregards the fact-specific nature of the fair use determination here, where petitioner sought to pass-off as entirely his own a work to which he made no authorship contribution. There can be no question that the unprecedented unfairness of such conduct is precisely the kind of fact, along with others, that authorizes an appellate court not to "remand for further fact finding" but to "conclude as a matter of law" that the challenged use does not qualify as a fair use, as occurred here. *See Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 560 (1985).[9]

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[8] Contrary to the endeavor to invent a new question worthy of Supreme Court review (Amici Br. 6), the statute and legislative history themselves are thus clear in showing how the finely calibrated provisions relating to joint and derivative works interrelate. *See also* House Report at 57. And the right of each joint author to prepare his own derivative work has been recognized by appellate and lower courts (*see* Resp. Br. 12; 1 M. Nimmer & D. Nimmer, Nimmer on Copyright (1988), §6.10 at 6-22) and is basic copyright doctrine (Resp. Br. 11).

[9] The Amici's claim that petitioner's use was fair because it was "for teaching purposes" (Amici Br. 11) similarly disregards the facts that the actual use here failed to comply with the three minimum fair use standards agreed upon between the major lobbying groups on the 1976 Copyright Act, and most notably with the requirement that the user properly give credit on the copied materials. *See* "Agreement on Guidelines for Classroom Copying in Not-For-Profit Educational Institutions," House Report at 68-70; *Marcus v. Rowley*, 695 F.2d 1171, 1178 (9th Cir. 1983) (holding these "minimum" standards even to qualify for consideration of fair use defense); *see also* 17 U.S.C. §108 similarly requiring use of copyright owner's copyright notice even on statutorily permitted photocopying by libraries. Petitioner, in any event, is not a not-for-profit educational institution.

Conclusion

In view of the foregoing, the Motion for Leave to File a Brief Amici Curiae herein should be denied.

August 23, 1989

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